

FEDERAL COURT

BETWEEN:

UNITED AIRLINES, INC.

Plaintiff

– and –

DR. JEREMY COOPERSTOCK

Defendant

**MOTION RECORD OF THE MOVING PARTY,
THE DEFENDANT**
(Pursuant to Rules 226, 227, and 235 of the *Federal Court Rules*)

Dated: October 31, 2014

DR. JEREMY COOPERSTOCK
392 Grosvenor Avenue
Westmount, Québec H3Z 2M2
Tel: (438) 808-6463

jcooperstock@gmail.com

Defendant / Moving Party

TO: **GOWLING LAFLEUR HENDERSON LLP**
1 Place Ville Marie, 37th Floor
Montreal, Quebec H3B 3P4

Me Hélène D'Iorio

Tel: 514-392-9564
Fax: 514-878-1450

Me Lee A. Johnson

Tel: 514-392-9502
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**Solicitor for the Plaintiff,
United Airlines, Inc.**

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Court File No.: T-2084-12

FEDERAL COURT

BETWEEN:

UNITED AIRLINES, INC.

Plaintiff

– and –

DR. JEREMY COOPERSTOCK

Defendant

NOTICE OF MOTION

TAKE NOTICE THAT Dr. Jeremy Cooperstock will make a motion in writing to the Court pursuant to Rule 369 of the *Federal Court Rules*, S.O.R./98-106.

THE MOTION IS FOR:

1. An Order pursuant to Rule 226 of the *Federal Court Rules*, S.O.R./98-106, requiring Plaintiff to update its affidavit of documents.
2. An Order pursuant to Rule 227 of the *Federal Court Rules*, S.O.R./98-106, requiring Mr. Scott Wilson, Plaintiff's representative, to re-attend, at the expense of Plaintiff, for cross-examination on the contents of its affidavit of documents.

3. An Order pursuant to Rule 235 of the *Federal Court Rules*, S.O.R./98-106, requiring Plaintiff's representative, either Mr. Scott Wilson, or another representative of Plaintiff with knowledge of Plaintiff's efforts to shut down Defendant's website, to re-attend, at the expense of Plaintiff, for examination on discovery to answer questions relevant to abuse of process, and in particular, efforts to shut down Defendant's website.
4. An Order awarding costs of this motion to Defendant.
5. Such further and other relief as this Honourable Court may deem just.

THE GROUNDS FOR THE MOTION ARE:

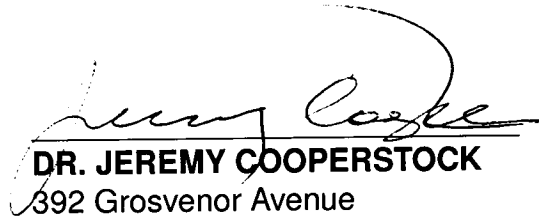
1. Defendant alleges in paragraphs 60 and 63 of the Amended Statement of Defence that the true purpose of the present action is to coerce Defendant to shut down his Untied.com website, and thus Plaintiff's action constitutes an abuse of process.
2. Abuse of process is a defence (*Levi Strauss & Co. v. Roadrunner Apparel Inc.*, 1997 CanLII 5596 (FCA)).
3. Plaintiff did not disclose during discoveries a document relevant to the defence of abuse of process. Specifically, the email from Mr. Jeff Wittig, senior in-house counsel for Plaintiff, dated June 16, 2012, in which he states in reference to Defendant's website that "We're working on shutting it down." was only disclosed on August 7, 2014, during an examination on discovery of Plaintiffs in a parallel action brought against Defendant before the Quebec Superior Court.

4. Plaintiff's failure to disclose the document in question deprived Defendant of the opportunity to conduct discoveries with respect to it, and furthermore raises serious doubts as to the adequacy of Plaintiff's affidavit of documents.
5. On September 11, 2014, Defendant filed a copy of Mr. Wittig's email with the Quebec Superior Court as an exhibit to his Statement of Defence in the parallel proceeding. As a result, implied undertaking ceased to apply to this document.
6. Since September 12, 2014, Defendant sent three letters to counsel for Plaintiff requesting that Plaintiff update its affidavit of documents; however, these requests were ignored by opposing counsel.
7. Rules 226, 227, 235, and 369 of the *Federal Court Rules*, S.O.R./98-106.
8. Such further and other grounds as this Honourable Court may permit.

THE FOLLOWING DOCUMENTARY EVIDENCE will be used for the motion:

1. Affidavit of Dr. Jeremy Cooperstock, affirmed on October 31, 2014.
2. Such further and other evidence as this Honourable Court may permit.

October 31, 2014



DR. JEREMY COOPERSTOCK
392 Grosvenor Avenue
Westmount, Québec H3Z 2M2
Tel: 438-808-6463

jcooperstock@gmail.com

Defendant / Moving Party

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Me Lee A. Johnson

Tel: 514-392-9502
Fax: 514-876-9502

**Solicitor for the Plaintiff,
United Airlines, Inc.**

Court File No. T-2084-12**FEDERAL COURT**

BETWEEN: UNITED AIR LINES AIRLINES, INC. and
— CONTINENTAL AIRLINES, INC.

Plaintiffs
Plaintiff

AND**JEREMY COOPERSTOCK****Defendant**

AMENDED STATEMENT OF CLAIM

TO THE DEFENDANT:

A LEGAL PROCEEDING HAS BEEN COMMENCED AGAINST YOU by the Plaintiffs. The claim made against you is set out in the following pages.

IF YOU WISH TO DEFEND THIS PROCEEDING, you or a solicitor acting for you are required to prepare a statement of defence in Form 171B prescribed by the *Federal Courts Rules*, serve it on the Plaintiff's solicitor or, where the Plaintiffs does not have a solicitor, serve it on the Plaintiffs, and file it, with proof of service, at a local office of this Court, WITHIN 30 DAYS after this statement of claim is served on you, if you are served within Canada.

If you are served in the United States of America, the period for serving and filing your statement of defence is forty days. If you are served outside Canada and the United States of America, the period for serving and filing your statement of defence is sixty days.

Copies of the *Federal Courts Rules*, information concerning the local offices of the Court and other necessary information may be obtained on request to the Administrator of this Court at Ottawa (telephone 613-992-4238) or at any local office.

IF YOU FAIL TO DEFEND THIS PROCEEDING, judgment may be given against you in your absence and without further notice to you.

Date: November 19, 2012
Amended April • , 2013

Issued by:

(Registry Officer)
 30 McGill Street
 Montreal, Quebec
 H2Y 3Z7

To: PROFESSOR JEREMY COOPERSTOCK
392 Grosvenor Street
Westmount
Quebec
H3Z 2M2

The Plaintiff, United Airlines, Inc. claims: ~~Plaintiffs, United Air Lines, Inc. (hereinafter called "United") and Continental Airlines Inc. (hereinafter called "Continental") (United and Continental hereinafter collectively called the "Plaintiffs")~~ claim,

- (a) a declaration that ~~Continental~~ the Plaintiff is the owner of the copyright in Canada in the graphic design elements, including layout, incorporated in the website corresponding with the internet domain name www.united.com (these graphic design elements and layout are hereinafter collectively called the "United Website");

- (b) a declaration that the ~~Plaintiffs are~~ Plaintiff is the ~~owners~~ owner of the copyright in Canada in the logo: **UNITED**

(hereinafter called the "United Logo");

- (c) a declaration that ~~Continental~~ the Plaintiff is the owner of the copyright in Canada in the logo:



(hereinafter called the "Globe Design");

- (d) a declaration that United the Plaintiff is the owner of the Canadian registered trade-marks UNITED, GLOBE DESIGN and UNITED AIRLINES bearing trade-mark registration nos. TMA204,456, TMA492,886 and TMA367,179, respectively (collectively hereinafter called the "United Trade-marks"); (e) ~~a declaration that Continental is the owner of the Canadian registered trade mark GLOBE DESIGN bearing trade mark registration no. TMA492,886 (this trade mark and the United Trade marks hereinafter collectively called the "Plaintiffs' Plaintiff's Trade-marks")~~;

- (f) a declaration that the Defendant, Professor Jeremy Cooperstock (hereinafter called the "Defendant"), has:
- (i) infringed the ~~Plaintiffs'~~ Plaintiff's copyrights in the United Website, in the United Logo and in the Globe Design;
 - (ii) directed public attention to his wares, services, and business in such a way as to cause or be likely to cause confusion in Canada between them and the wares, services and business of the ~~Plaintiffs~~ Plaintiff;
 - (iii) infringed the ~~Plaintiffs'~~ Plaintiff's rights in the ~~Plaintiffs'~~ Plaintiff's Trade-marks;
 - (iv) used the ~~Plaintiffs'~~ Plaintiff's Trade-marks in a manner that is likely to have the effect of depreciating the value of the goodwill attaching thereto; and
 - (v) caused confusion to the public and ongoing damage to the ~~Plaintiffs~~ Plaintiff, including depreciation of the ~~Plaintiffs'~~ Plaintiff's goodwill in the ~~Plaintiffs'~~ Plaintiff's Trade-marks;
- (g) an interim, interlocutory and permanent injunction restraining the Defendant from, either directly or indirectly, further infringing the ~~Plaintiffs'~~ Plaintiff's said copyrights and from further directing public attention to his wares, services and business in a confusing manner as set out above, and, in particular, from using or displaying, on the internet or in any other way, the ~~Plaintiffs'~~ Plaintiff's Trade-marks or any symbols, logos, words or indicia which cause or are likely to cause confusion with any of the ~~Plaintiffs'~~ Plaintiff's Trade-marks;
- (h) damages, profits and statutory damages, or whichever one or more of those that the ~~Plaintiffs~~ Plaintiff may elect after due inquiry; and
- (i) such further and other relief as to this Honourable Court shall seem just.

The ~~Plaintiffs are~~ Plaintiff is not seeking to prevent the Defendant from operating a website where individuals can express their views about ~~Plaintiffs~~ the Plaintiff. Rather, ~~Plaintiffs are~~ the Plaintiff is requesting the relief above in order to protect ~~their~~ its intellectual property rights and prevent consumer confusion over whether ~~Plaintiffs own~~

the Plaintiff owns and/or ~~spenser~~ sponsors Defendant's UNTIED.com website. As set out in paragraphs 19, 21, and 23 below, ~~Plaintiffs~~ the Plaintiff approached Defendant on multiple occasions with a request that Defendant modify his website so that it is not confusingly similar to the United Website. The Defendant refused to do so. Accordingly, ~~United~~ the Plaintiff is left with no reasonable option but seek relief from this Court.

The Parties

1. Plaintiff, ~~United Air Lines~~ Airlines, Inc., is a corporation incorporated and existing under the laws of the State of Delaware, one of the United States of America, having a principal place of business at ~~77 West~~ 233 South Wacker Dr., Chicago, Illinois ~~60601~~ 60606, U.S.A.
2. The Plaintiff, is the result of the merger of United Air Lines, Inc. ("United") and Continental Airlines, Inc., is a corporation incorporated and existing under the laws of the State of Delaware, one of the United States of America, having a principal place of business at 77 West Wacker Dr., Chicago, Illinois 60601, U.S.A. ("Continental"), which merger took effect on March 31, 2013.
3. The Plaintiffs operate Prior to the March 31, 2013 merger, United and Continental had operated commercial flights under a single operating certificate and ~~market~~ marketed such flights as "United".
4. For over eighty years, ~~United~~ the Plaintiff, together with its successors in interest, has been one of the largest commercial airline operators and transportation service providers in the world. Indeed, ~~United~~ the Plaintiff (together with United Express) operates an average of 5,557 flights a day to 378 airports on six continents. The Plaintiff ~~United~~ was rated the world's most admired airline on FORTUNE magazine's 2012 airline-industry list of the World's Most Admired Companies. In addition, readers of Global Traveler magazine have voted ~~United's~~ the Plaintiff's MileagePlus program the best frequent flyer program for eight consecutive years.

5. ~~The Plaintiff~~ United and its predecessors in interest have been offering airline related services in Canada for over 70 years. In 2011, ~~United~~ the Plaintiff operated more than 2 million flights and carried approximately 142 million passengers to destinations around the world. ~~United~~ the Plaintiff employs more than 85,000 people worldwide.
6. The Defendant is an individual having an office at McGill University, McConnell Engineering Building, Rm. 424, 3480 University Street, Montreal, Quebec, H3A 0E9, and residing at 392 Grosvenor Street, Westmount, Quebec, H3Z 2M2.
7. The Defendant owns and operates a website corresponding with the internet domain name www.untied.com (this website hereinafter called "UNTIED.com"). Defendant registered this domain name on April 24, 1997. The Defendant began operating said website on the following day.

The United Copyright Works

8. ~~Plaintiffs are~~ The Plaintiff is the owners owner of all rights, including copyright, in the United Website the United Logo, and the Globe Design.
9. ~~Plaintiffs~~ The Plaintiff's predecessors in title have obtained copyright registrations in Canada under the numbers 1099767, 1099766 and 1099765 for the United Website, the United Logo and the Globe Design, respectively. Appended as Schedule "A" to form an integral part of the present action is a copy of each registration.
10. The United Website was first published in Canada when it was launched in its current form on or about March 3, 2012. This launch was the result of a significant redesign of the previous version of the website www.united.com and is based upon the version of the website that existed at www.continental.com.

The United Trade-marks

11. ~~Plaintiffs~~ The Plaintiff and ~~their~~ its predecessors in interest have used the trade-marks UNITED and UNITED AIRLINES in Canada in association with, inter

alia, air transportation of passengers since at least as early as 1939. These two trade-marks have been registered with the Canadian Trade-marks Office under registration nos. TMA204,456 and TMA367,179, respectively.

12. ~~Plaintiffs~~ The Plaintiff and ~~their~~ its predecessors in interest have used the trade-mark GLOBE DESIGN in Canada in association with, inter alia, airline transportation services for passengers since at least as early as June 22, 1995. More specifically, ~~Plaintiff~~ Continental previously used the trade-mark GLOBE DESIGN in association with Continental-branded flights; ~~it~~ the Plaintiff now uses this trade-mark in association with United-branded flights. This trade-mark has been registered with the Canadian Trade-marks Office under registration no. TMA492,886. Appended as Schedule "B" to form integral part of the present action are copies of the ~~Plaintiffs'~~ Plaintiff's Trade-mark registrations 204,456, 367,179 and 492,886.
13. The ~~Plaintiffs~~ Plaintiff and ~~their~~ its predecessors in ~~title have~~ interest have used the ~~Plaintiffs'~~ Plaintiff's Trade-marks extensively in Canada, and the ~~Plaintiffs have~~ Plaintiff has established a very valuable reputation and goodwill in association with the ~~Plaintiffs'~~ Plaintiff's Trade-marks.
14. To enable ~~their~~ its customers, and the general public, to readily associate the United Website with ~~United~~ the Plaintiff, the ~~Plaintiffs~~ Plaintiff prominently display the ~~Plaintiffs'~~ Plaintiff's Trade-marks on the United Website.

The Defendant's Acts

15. At some time between March 3, 2012 and April 9, 2012, the Defendant caused UNTIED.com to be redesigned. The newly designed UNTIED.com site very closely resembles the recently redesigned United Website. Amongst other things, the colour scheme, font, general website layout, and prominent placement of the logo , which is confusingly similar with the United Logo and the Globe Design, are all nearly exactly the same on both the United Website and the new version of UNTIED.com. All of the ~~Plaintiffs'~~ Plaintiff's Trade-marks, and/or indicia

confusingly similar therewith, appear on the redesigned version of UNTIED.com. This results in UNTIED.com having an overall appearance which very closely resembles and is difficult to distinguish from that of the United Website.

16. UNTIED.com allows visitors to the site to submit complaints. For at least one visitor, the Defendant assigned an Untied.com complaint number to the visitor's complaint and instructed the visitor to use the complaint number in correspondence with United the Plaintiff. However, since United the Plaintiff does not operate UNTIED.com, it did not receive this visitor's complaint and did not assign a complaint number to the visitor. As a result, the visitor subsequently contacted United the Plaintiff, noted that he had registered an online complaint via UNTIED.com, but he had not received a response from United the Plaintiff. This example is one of many situations where customers have evidenced confusion between the United Website and UNTIED.com.

17. A link on the UNTIED.com website, which link was removed following the filing of the Plaintiff's November 19, 2012 Statement of Claim, also served to divert ~~diverts~~ users to the commercial website www.inweddingdress.com, which advertises and sells wedding dresses and related clothing and accessories. Additionally, the June 15, 2012 version of the UNTIED.com website was also linked to the commercial website www.uspassportnow.com, an online passport agency. A further link on UNTIED.com directs visitors to a page which offers users the opportunity to send money to the Defendant, either electronically, either electronically ~~to the account corresponding with the Defendant's personal university email address~~, or by cheque. At the time of filing of the Plaintiff's November 19, 2012 Statement of Claim, the Defendant had encouraged users to send money electronically to an account corresponding with the Defendant's personal university email address, which address has since been removed. Defendant expressly states on his website that donations "serve primarily as a means of encouragement."

18. During or about April of 2012, ~~Plaintiffs~~ the Plaintiff became aware of the strong resemblance between its recently launched United Website and the then-recently redesigned UNTIED.com.
19. On July 16, 2012, ~~United~~ the Plaintiff contacted the Defendant to request, among other things, that the appearance of UNTIED.com be altered so as to alleviate the possibility of confusion between UNTIED.com and the United Website.
20. On July 17, 2012, the Defendant acknowledged receipt of ~~United's~~ the Plaintiff's request, and stated that he would "study" ~~United's~~ the Plaintiff's concerns. At that time, and instead of addressing the specific requests made by ~~United~~ the Plaintiff, the Defendant also offered his services to ~~United~~ the Plaintiff "on a consultancy basis."
21. On September 10, 2012, ~~United~~ the Plaintiff again contacted the Defendant to reiterate its earlier request that the Defendant alter the appearance of UNTIED.com, and to formally put the Defendant on notice of ~~United-the~~ Plaintiff's rights. Appended as Schedule "C" is a copy of the September 10, 2012 letter. Specifically, ~~United~~ the Plaintiff stated:

Given the use of United Airlines' trade dress and its copyrighted and trademarked materials, and the intermingling of the untied.com and united.com websites caused by your linking to web pages within the united.com site, it is not surprising that we have received several reports of individuals who have accessed and used your untied.com website, believing that they were on a website owned and/or sponsored by United Airlines. Such individuals have submitted statements or complaints through your website, believing they were being submitted directly to United Airlines. As a result of the confusion caused by your website, the communications from these customers to United Airlines have been delayed, or sometimes even lost. In addition, the amount of time between when these customers thought they were communicating with United Airlines and the time when they actually began communicating with United Airlines has been delayed to their detriment.

22. On September 25, 2012, the Defendant responded to ~~United~~ the Plaintiff's September 10, 2012 letter but did not address ~~United~~ the Plaintiff's request that the Defendant alter the appearance of UNTIED.com.
23. On October 2, 2012, ~~United~~ the Plaintiff once again contacted the Defendant to reiterate its earlier request that the Defendant alter the appearance of UNTIED.com. Appended as Schedule "D" is a copy of the October 2, 2012 letter. Specifically, ~~United~~ the Plaintiff stated:

[T]he design of your untied.com site closely mimics the design of United Airlines' united.com website down to color, font, and location of active links. United Airlines' customers have experienced a great deal of confusion due to the very similar look and feel of your untied.com site and United Airlines' united.com site. Additionally, communications submitted by United Airlines' customers via untied.com are sometimes lost or not directed through the appropriate channels, thus impeding the communication flow between United Airlines and its customers. As a result, we remain concerned about your use of United Airlines' trade dress and copyrighted and trademarked materials on your site.
24. On October 12, 2012, the Defendant responded to ~~United's~~ the Plaintiff's October 2, 2012 letter but once again did not address ~~United's~~ the Plaintiff's request that the Defendant alter the appearance of UNTIED.com.
25. To date, the Defendant has not altered the overall visual appearance of UNTIED.com, or removed any of the indicia which are confusing with or identical to ~~Plaintiffs'~~ the Plaintiff's Trade-marks and the United Logo and Globe Design.
26. The Defendant's aforesaid acts were performed without the ~~Plaintiffs'~~ Plaintiff's authorization, consent, license, or acquiescence to same.

Copyright Infringement

27. By the actions set out in paragraphs 15 to 26, the Defendant has infringed the ~~Plaintiffs'~~ Plaintiff's copyrights in the United Website and the United Logo and Globe Design.
28. The Defendant, by reason of his aforesaid activities, has infringed the copyright in the works owned by the ~~Plaintiffs~~ Plaintiff in that he has produced or reproduced, caused to be produced or reproduced, or authorized the production, reproduction or adaptation of the ~~Plaintiffs'~~ Plaintiff's protected works, or a substantial part thereof, contrary to section 3 and 27 of the *Copyright Act*.

Trade-mark Infringement and Passing Off

29. The Defendant, by reason of his aforesaid activities, has infringed the ~~Plaintiffs'~~ Plaintiff's rights in the ~~Plaintiffs'~~ Plaintiff's Trade-marks, in a manner that has had, or is likely to have, the effect of depreciating the value of the goodwill attaching to the ~~Plaintiffs'~~ Plaintiff's Trade-marks, the whole contrary to sections 19, 20(1) and 22(1) of the *Trade-marks Act*. Also by these actions, the Defendant has directed public attention to his wares, services or business in such a way as to have caused, or to be likely to cause, confusion in Canada between his wares, services or business and the wares, services or business of the ~~Plaintiffs~~ Plaintiff, the whole contrary to section 7(b) of the *Trade-marks Act*.
30. The Defendant is likely to continue the aforesaid illegal and infringing acts, the whole to the prejudice of the ~~Plaintiffs~~ Plaintiff and the public, as aforesaid, unless restrained by Order of this Honourable Court.
31. By reason of the Defendant's aforesaid activities, the ~~Plaintiffs have~~ Plaintiff has suffered and ~~continue~~ continues to suffer considerable damages whereas the Defendant has made and continues to make illegal profits.
32. The present action is well founded in fact and law.

The ~~Plaintiffs propose~~ Plaintiff proposes that this action be tried in Montreal.

Montreal, this 19th day of November, 2012.

Amended April • , 2013

Gowling Lafleur Henderson LLP
Solicitors for the ~~Plaintiffs~~ Plaintiff
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Montreal, Québec, Canada, H3B 3P4

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Schedule "A"



Office de la propriété
intellectuelle
du Canada

Un organisme
d'Industrie Canada

Canadian
Intellectual Property
Office

An Agency of
Industry Canada

18

Certificate of Registration of

Copyright

Certificat d'enregistrement du

Droit d'auteur

This Certificate of Registration is issued pursuant to sections 49 and 53 of the Copyright Act. The copyright in the work described below was registered on the date of registration as follows:

Ce certificat d'enregistrement est émis conformément aux articles 49 et 53 de la Loi sur le droit d'auteur. Le droit d'auteur sur l'oeuvre décrite ci-dessous, a été enregistré à la date d'enregistrement comme suit :

Date of Registration - Date d'enregistrement :

October 29, 2012

Registration No. - Numéro d'enregistrement

1099765

First Publication - Première publication :

February 1, 1991

Houston, Texas, United States of America

Title - Titre :

Globe design

Category - Catégorie :

Artistic

Owner(s) - Titulaire(s) :

**Continental Airlines, Inc.
1600 Smith Street
Houston, Texas
United States of America, 77002**

Author(s) - Auteur(s) :

Steven Gilliat

Roger van den Bergh

Connie Birdsall

Canada

(CIP0 00200)
03-11

OPIC  CIP0



Office de la propriété
intellectuelle
du Canada

Un organisme
d'Industrie Canada

Canadian
Intellectual Property
Office

An Agency of
Industry Canada

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Date of Issuance of Certificate - Date d'émission du certificat :

October 29, 2012

Registrar of Copyright
Copyright office

Registraire des droits d'auteur
Bureau du droit d'auteur



1099765

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(CIPO 00200)
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Canadian
Intellectual Property
Office

An Agency of
Industry Canada

20

*Certificate of Registration of
Copyright*

*Certificat d'enregistrement du
Droit d'auteur*

This Certificate of Registration is issued pursuant to sections 49 and 53 of the Copyright Act. The copyright in the work described below was registered on the date of registration as follows:

Ce certificat d'enregistrement est émis conformément aux articles 49 et 53 de la Loi sur le droit d'auteur. Le droit d'auteur sur l'oeuvre décrite ci-dessous, a été enregistré à la date d'enregistrement comme suit.

Date of Registration - Date d'enregistrement : **October 29, 2012**

Registration No. - Numéro d'enregistrement : **1099766**

First Publication - Première publication : **August 11, 2010
Houston, Texas, United States of America**

Title - Titre : **United logotype**

Category - Catégorie : **Artistic**

Owner(s) - Titulaire(s) : **United Air Lines, Inc.
77 W. Wacker Drive
Chicago, Illinois
United States of America, 60601**

**Continental Airlines, Inc.
1600 Smith Street
Houston, Texas
United States of America, 77002**

Author(s) - Auteur(s) : **Su Mathews**

Connie Birdsall

Canada

(CIPQ 00200)
03-11

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du Canada

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d'Industrie Canada

Canadian
Intellectual Property
Office

An Agency of
Industry Canada

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Date of Issuance of Certificate - Date d'émission du certificat :

October 29, 2012

Registrar of Copyright
Copyright office

Registraire des droits d'auteur
Bureau du droit d'auteur



1099766

Canada

(CIPO 00200)
03-11

OPIC  CIPO



*Certificate of Registration of
Copyright*

*Certificat d'enregistrement du
Droit d'auteur*

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Ce certificat d'enregistrement est émis conformément aux articles 49 et 53 de la Loi sur le droit d'auteur. Le droit d'auteur sur l'oeuvre décrite ci-dessous, a été enregistré à la date d'enregistrement comme suit :

Date of Registration - Date d'enregistrement : **October 29, 2012**

Registration No. - Numéro d'enregistrement : **1099767**

First Publication - Première publication : **July 29, 2006**
Houston, Texas; United States of America

Title - Titre : **INTERNET WEBSITE CONTENT
INCLUDING, WITHOUT LIMITATION:
(TEXT, IMAGES, DESIGNS, LAYOUT,
FONT COLOUR SELECTION) AT
DOMAIN : WWW.united.com**

Category - Catégorie : **Artistic**

Owner(s) - Titulaire(s) : **Continental Airlines, Inc.
1600 Smith Street
Houston, Texas
United States of America, 77002**

Author(s) - Auteur(s) : **Michael Van Auken

Kathryn Van Auken

Aaron Hynes

Nora Bush**



Office de la propriété
intellectuelle
du Canada

Un organisme
d'Industrie Canada

Canadian
Intellectual Property
Office

An Agency of
Industry Canada

23

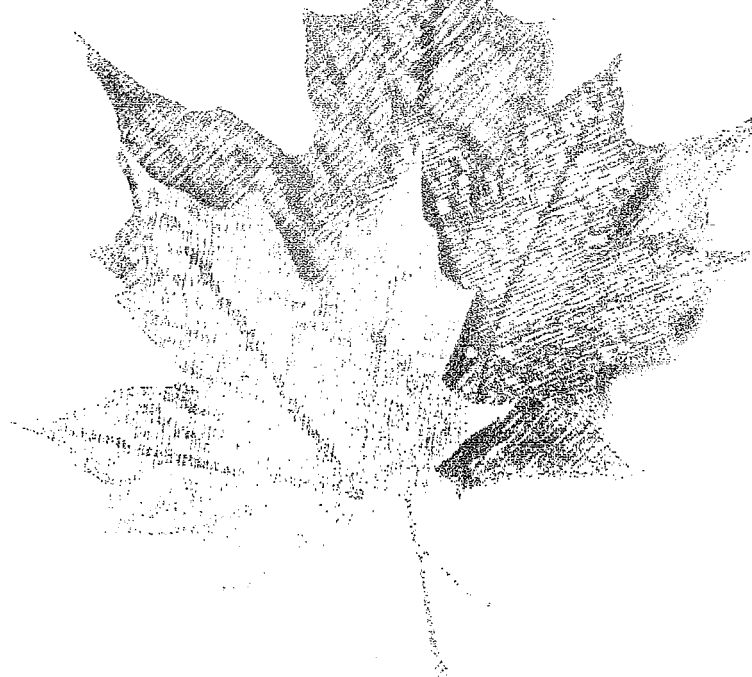
Michelle Bottomley

Date of Issuance of Certificate - Date d'émission du certificat :

October 29, 2012

Registrar of Copyright
Copyright office

Registraire des droits d'auteur
Bureau du droit d'auteur



1099767

Canada

(CIPO 00200)
03-11

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Schedule "B"



Marques de commerce
Certificat d'authenticité

Le(la) soussigné(e) certifie par la présente que le document ci-joint est une copie authentique de l'enregistrement officiel de la marque de commerce effectué sous le numéro TMA 204,456 conformément à la Loi sur les marques de commerce.


Conformément aux dispositions de la *Loi sur les marques de commerce*, la présente marque de commerce est enregistrée pour 15 années à compter de la date d'enregistrement ou de la dernière date de renouvellement indiquée dans le document ci-joint, qui contient tous les renseignements sur l'enregistrement.

Trade-marks
Certificate of Authenticity

The undersigned hereby certifies that the attached document is a true copy of the record of the registration of the trade-mark registered under No. TMA 204,456 in accordance with the Trade-marks Act.

In accordance with the provisions of the *Trade-marks Act*, this trade-mark is registered for 15 years from the registration date or the latest renewal date shown on the attached particulars of registration.

UNITED


Agent certificateur / Certifying Officer

29 oct/Oct 2012

Date

Canada

(CIPO 00200)
03-11

OPIC  CIPO



Marques de commerce

Certificat d'authenticité

Le(la) soussigné(e) certifie par la présente que le document ci-joint est une copie authentique de l'enregistrement officiel de la marque de commerce effectué sous le numéro TMA 367,179 conformément à la Loi sur les marques de commerce.

Conformément aux dispositions de la *Loi sur les marques de commerce*, la présente marque de commerce est enregistrée pour 15 années à compter de la date d'enregistrement ou de la dernière date de renouvellement indiquée dans le document ci-joint, qui contient tous les renseignements sur l'enregistrement.

Trade-marks

Certificate of Authenticity

The undersigned hereby certifies that the attached document is a true copy of the record of the registration of the trade-mark registered under No. TMA 367,179 in accordance with the Trade-marks Act.

In accordance with the provisions of the *Trade-marks Act*, this trade-mark is registered for 15 years from the registration date or the latest renewal date shown on the attached particulars of registration.

UNITED AIRLINES


Agent certificateur / Certifying Officer

29 oct/Oct 2012

Date

Canada

(CIP0 00200)
03-11

OPIC  CIPO



Marques de commerce
Certificat d'authenticité

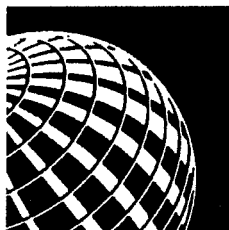
Le(la) soussigné(e) certifie par la présente que le document ci-joint est une copie authentique de l'enregistrement officiel de la marque de commerce effectué sous le numéro TMA 492,886 conformément à la Loi sur les marques de commerce.

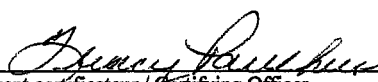
Conformément aux dispositions de la *Loi sur les marques de commerce*, la présente marque de commerce est enregistrée pour 15 années à compter de la date d'enregistrement ou de la dernière date de renouvellement indiquée dans le document ci-joint, qui contient tous les renseignements sur l'enregistrement.

Trade-marks
Certificate of Authenticity

The undersigned hereby certifies that the attached document is a true copy of the record of the registration of the trade-mark registered under No. TMA 492,886 in accordance with the Trade-marks Act.

In accordance with the provisions of the *Trade-marks Act*, this trade-mark is registered for 15 years from the registration date or the latest renewal date shown on the attached particulars of registration.




Agent certificateur / Certifying Officer

29 oct/Oct 2012

Date

Canada

(CIPO 00200)
03-11

OPIC  CIPO

Schedule "C"

UNITED

Michael C. Henning
Managing Counsel - Litigation & Intellectual Property
(713) 324-5103
(713) 324-5161 (fax)
mike.henning@united.com

15th Floor HQSLG
1600 Smith Street
Houston, Texas 77002
united.com

September 10, 2012

VIA E-MAIL

Without Prejudice

Jeremy Cooperstock
McGill University
McConnell Engineering Building, Rm 424
3480 rue University
Montreal H3A 0E9 Quebec
CANADA
jcooperstock@gmail.com

Re: untied.com

Dear Professor Cooperstock:

I write as a follow up to our earlier communications. As you know, I am one of United Airlines' in-house attorneys. The purpose of this letter is to continue our discussion about two issues that exist with respect to your untied.com website in hopes of getting them resolved.

To be clear, United Airlines is in no way suggesting by this letter that you may not criticize United Airlines and maintain a website on which such criticisms are collected and posted. While United Airlines certainly believes that there are far more productive ways to address the concerns raised on your website, the purpose of this letter is not to ask you to take down the untied.com site. Rather, it is to see if we can reach an agreement to resolve two specific problems that your website has created for United Airlines' customers and its employees.

The first issue concerns the actual confusion and likelihood of confusion that results from the current layout and appearance of the web pages presented by the untied.com website. As I am sure you know, the overall look and feel of the website you established at untied.com mimics the United Airlines website at the united.com site down to color, font, and location of active links. The untied.com website is also intermingled with the united.com website in that pages provided by the untied.com site include links that take one directly to pages on the united.com website.

Given the use of United Airlines' trade dress and its copyrighted and trademarked materials, and the intermingling of the untied.com and united.com websites caused by your linking to web pages within the united.com site, it is not surprising that we have received several reports of individuals who have accessed and used your untied.com website, believing that they



were on a website owned and/or sponsored by United Airlines. Such individuals have submitted statements or complaints through your website, believing they were being submitted directly to United Airlines. As a result of the confusion caused by your website, the communications from these customers to United Airlines has been delayed, or sometimes even lost. In addition, the amount of time between when these customers thought they were communicating with United Airlines and the time when they actually began communicating with United Airlines has been delayed to their detriment.

The second and particularly troubling issue concerns your posting – on a page on the untied.com website under the tagline “Contact UAL” – of names, office and e-mail addresses, and phone numbers of various specific United Airlines employees who have no connection to any issue discussed on your website. As a result of your postings, the individuals listed on your website have received an inordinately large number of e-mails and phone calls, many of an extremely disturbing nature. Not only are these e-mails and calls extremely disruptive, they have caused – and are causing – tremendous emotional strain and stress for these individuals. While we understand that you are a critic of United Airlines, we are sure that facilitating the harassment of individual employees simply trying to do their jobs is not your intent, and that you will have no issues with removing their names and contact information. There is simply no legitimate reason to subject them to the burdens and stress that listing their names on your website has imposed on them.

To give you an idea of the type of issues that the untied.com listings have caused, I have reproduced below portions of a transcript of a voicemail message left by someone who accessed the untied.com website and obtained an employee’s direct phone number from the “Contact UAL” page:

How come you’re so – uh...uh – familiar with untied.com but you are unwilling to talk to – uh – a member the public about a matter of great interest to United Airlines regarding litigation.

What the hell is wrong with [NAME REDACTED]? And how is that different from what is wrong with United Airlines? And how does that differ with what is wrong from the rogue, renegade, lying US government – the former national – I am sorry – the former constitutional republic and current national security state. What’s the matter [NAME REDACTED]? Traitor got your tongue?

[NAME REDACTED] would you have made a great Nazi – or just a good one?

Do you remember 80 years ago when the German government and media told everyone whom to hate and blame and once everybody knew that everybody knew that everybody knew whom it was not just socially acceptable but expected to amass hate and blame. How it would seem make perfect sense for that nation’s military to go marauding around the world, invading sovereign nations, starting wars all in the name of protecting and defending the fatherland. Of course, you

September 10, 2012
Page 3



being female you understand that we're far more progressive this time around. We use the gender-neutral term "homeland" to accomplish the exact same evil thing.

...

So maybe that that judge who that said that UAL should – uh – be on the hook for 9/11 isn't – uh – I don't know – part of the same treason party.

Untie yourself [NAME REDACTED]. You the one who needs to be untied.

Considering the content of the message partially reproduced above, you may begin to appreciate the negative impact that your website content has had on the listed United Airlines employees – employees who have no meaningful connections to the criticisms and issues raised on your website. Again, I'm sure this is not your intent, and you therefore will have no concerns with removing all such names and information.

As you will appreciate, the two issues raised above are of significant concern for United Airlines, its customers, and its employees. While there are legal avenues that United Airlines can take to address these concerns, we believe that it would be more productive and beneficial for us both to see if we can reach an agreement to avoid the likelihood of confusion that currently exists with respect to the untied.com website and address the significant concerns raised above with respect to the identified United Airlines employees. In that regard, I invite you to either arrange a call or a face-to-face meeting with me at a mutually convenient location to discuss a resolution of these issues.

Please let me know by September 28, 2012 if you are interested in arranging a call or meeting. If I do not hear from you by that date, I will assume that you do not want to try to work these issues out, and United Airlines will be forced to consider other avenues for resolving these issues.

As a final matter, United Airlines' management has considered the proposal you advanced in an earlier e-mail. You may recall, in that proposal – in response to our initial concerns – you offered your services to United Airlines' management "on a consultancy basis." If you were offering to meet, on a no fee basis, with representatives of United Airlines to discuss thoughts and ideas that you may have to make improvements in its relationships with United Airlines' customers and employees, I would be happy to arrange such a meeting. However, if your proposal was a suggestion that United Airlines retain you as a paid consultant, you surely will understand that we must respectfully decline such an offer. Given the history of your untied.com website, United Airlines does not want to create any appearance or suggestion that it has made payments to stifle the criticisms offered on untied.com, which is simply not United Airlines' practice.

I look forward to talking with you.

September 10, 2012
Page 4

UNITED



Sincerely,

A handwritten signature in black ink, appearing to read "Mike H." followed by a stylized flourish.

Michael C. Henning

September 10, 2012
Page 5

UNITED



33

bc: Mark Bergsrud
Elaine Clark
Christen David
Rich Fiore
Nene Foxhall
Brett Hart
Rahsaan Johnson
Megan McCarthy
Kevin McKenna
Dave Messing
Karin Moan
Scott Moga
Jessica Rossman
Nancy Tibbitts
Ben Vaughn
Scott Wilson
Jeff Wittig
United Airlines

Schedule "D"

UNITED



Michael C. Henning
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15th Floor HQSLG
1600 Smith Street
Houston, Texas 77002
united.com

October 2, 2012

VIA E-MAIL

Without Prejudice

Jeremy Cooperstock
McGill University
McConnell Engineering Building, Rm 424
3480 rue University
Montreal H3A 0E9 Quebec
CANADA
jcooperstock@gmail.com

Re: untied.com

Dear Professor Cooperstock:

Thank you for your e-mail of September 25. I appreciate the information you provided and do hope that our dialogue will assist in resolving the concerns that United Airlines has had with untied.com and the confusion that our United Airlines customers have had upon visiting your site. Unfortunately, I was disheartened that you did not address the two concerns that I mentioned in my September 10 correspondence to you. First, as mentioned in my letter, the design of your untied.com site closely mimics the design of United Airlines' united.com website down to color, font, and location of active links. United Airlines' customers have experienced a great deal of confusion due to the very similar look and feel of your untied.com site and United Airlines' united.com site. Additionally, communications submitted by United Airlines' customers via untied.com are sometimes lost or not directed through the appropriate channels, thus impeding the communication flow between United Airlines and its customers. As a result, we remain concerned about your use of United Airlines' trade dress and copyrighted and trademarked materials on your site.

Second, the names of and contact information for several United Airlines employees are still listed on the "Contact UAL" link of untied.com. As mentioned in my September 10 letter, these employees have received extremely disruptive and harassing messages as a result of your posting of their information on untied.com. These individuals have no connection to the issues discussed on your site but nevertheless are being subject to significant stress and burdens as a result of being listed as contacts on your site. I therefore am again requesting that you remove their names from your site. Moreover, although you requested information pertaining to the government's and United's investigation into the very disturbing message that I referenced in my September 10 letter to you, as I'm sure you can appreciate, I cannot disclose specific information

October 2, 2012
Page 2



at this time in order to preserve the integrity of the investigation and to ensure the safety of our employees.

Finally, I appreciate that you have accepted our offer to meet with us. During the first part of the meeting, we would like to discuss the two issues addressed above in the hopes that we can resolve these very important concerns. In the second part of the meeting, we would be happy to listen to your thoughts and ideas for improving United Airlines' relationships with its customers and employees. Martin Hand, United Airlines' Senior Vice President of Customer Experience, and I will attend the meeting for United Airlines. We are unable to meet with you on October 26, as proposed, but could meet with you in Montreal during the morning of October 31, the afternoon of November 12, or the morning of November 13. Please let me know if any of those dates would work for you.

Sincerely,

A handwritten signature in black ink, appearing to read "Mike H." followed by a stylized flourish.

Michael C. Henning

Court File No.: T-2084-12

FEDERAL COURT

BETWEEN:

UNITED AIRLINES, INC.

Plaintiff

– and –

DR. JEREMY COOPERSTOCK

Defendant

AMENDED STATEMENT OF DEFENCE

Dated: June 20, 2013

DR. JEREMY COOPERSTOCK

392 Grosvenor Street

Westmount, Québec H3Z 2M2

Tel: 438-808-6463

jcooperstock@gmail.com

Defendant

Court File No.: T-2084-12

FEDERAL COURT

BETWEEN:

UNITED AIRLINES, INC.

Plaintiff

– and –

DR. JEREMY COOPERSTOCK

Defendant

AMENDED STATEMENT OF DEFENCE

1. The Defendant admits the allegations contained in paragraphs 6 and 7 of the Statement of Claim.
2. The Defendant has no knowledge of the allegations contained in paragraphs 1-5 and 9-14 of the Statement of Claim.
3. The allegations contained in ~~paragraphs~~ paragraph 17 of the Statement of Claim are irrelevant. In any event, the removal of the link to www.inweddingdress.com was unrelated to the present action.
4. Pursuant to Rule 184(1) of the *Federal Court Rules*, all allegations of fact in the Statement of Claim that are not admitted are deemed to be denied.

THE DEFENDANT: DR. JEREMY COOPERSTOCK

5. The Defendant, Dr. Jeremy Cooperstock, is an individual living in the Province of Quebec, in the City of Westmount.
6. The Defendant is a full-time, tenured, associate professor of electrical and computer engineering at McGill University.
7. The Defendant does not own any business, and does not sell or offer to sell or distribute any goods.
8. Other than his full-time employment with McGill University, the only services that the Defendant offers are as a technical consultant.

PREDECESSOR OF THE UNTIED.COM WEBSITE: "POORSHOW"

9. In the summer of 1996, the Defendant travelled on a business and vacation trip with the Plaintiff ~~United Air Lines~~ ("United"), was mistreated by its agents during his travels, and was dissatisfied with United's refusal to address his complaint about his travel experience. The Defendant decided to share his negative experience with the public using his personal web page at the University of Toronto:
<http://www.dgp.toronto.edu/~jer/poorshow>
10. Over the course of the following months, the Defendant received numerous letters from other travellers about their poor experiences with United. In order to foster an open debate, the Defendant posted on his personal web page the comments he received from these travellers.
11. On September 6, 1996, the Defendant contacted the Plaintiff ~~United~~, brought to its attention the postings on his personal web page, and requested a personalized apology.

12. On or around March 17, 1997, the Plaintiff United contacted the President of the University of Toronto, suggesting that the University might be held liable for the contents of the Defendant's personal web page, and demanded that the University take steps to remove the content posted by the Defendant.
13. On or around March 24, 1997, the Defendant removed the content concerning the Plaintiff United from his personal web page at the University of Toronto, in order to spare the University legal hassles.

THE WEBSITE UNTIED.COM

14. On April 24, 1997, the Defendant registered the domain Untied.com, and re-launched the content concerning the Plaintiff United as an independent website ("Defendant's Website").
15. For over 15 years, since 1997, the Defendant has been maintaining the website Untied.com as both a forum for postings by passengers and employees of the Plaintiff United and as a satirical website, employing parody to expose poor service to passengers and mistreatment of employees by the Plaintiff United.
16. Visitors to Untied.com are offered the opportunity to post their account of their experiences with the Plaintiff United. Each posting is automatically assigned a unique ID number.
17. The Defendant denies the allegation at paragraph 16 of the Statement of Claim that he instructed any visitor to Untied.com to use the ID number automatically generated by Untied.com in correspondence with the Plaintiff United.

18. On the contrary, visitors who wish to submit a posting to Untied.com are presented with the following disclaimer:

Note that you are submitting your complaint to Untied.com, a website that provides a service for past and prospective passengers, alerting them to United Airlines' attitude towards its customers and employees. You may also wish to submit your complaint directly to any of the contacts at United Airlines. Before you do so, please see some tips for passengers considering legal action against the airline. And if you think United Airlines will take your complaint seriously, think again.

Furthermore, those who submit a posting to Untied.com are automatically sent an email message advising them of the appropriate avenues for contacting the Plaintiff United.

~~THE PLAINTIFFS ARE~~ PLAINTIFF IS THE MAKERS OF THEIR ITS OWN MISFORTUNE

19. On February 21, 1994, the Plaintiff United registered the domain name ual.com, and launched its website under that address.
20. Thus, in 1997, at the time of the registration of Untied.com, there was no possibility of confusion between Untied.com and the Plaintiff United's Plaintiff's website, which was operating under the address ual.com.
21. The Plaintiff United has been aware of the Defendant's Untied.com website since 1997.
22. On December 17, 1998, 20 months after the Defendant launched his Untied.com website, the Plaintiff United registered the domain united.com.
23. On November 7, 2000, that is, more than three years after the Defendant launched his Untied.com website, the Plaintiff United registered the

Canadian domain united.ca.

24. Therefore, the ~~Plaintiffs are~~ Plaintiff is the makers of their its own misfortune, because they it chose to use the domain names united.com and united.ca even though they it knew about the pre-existence of the Untied.com website.

COMPARISON: LOGOS DISPLAYED BY DEFENDANT VS. BY PLAINTIFFS PLAINTIFF

25. The predecessor of the Untied.com website, entitled "poorshow," which was posted on the Defendant's personal web page at the University of Toronto, displayed the following logo:



Defendant replaced this logo after United Air Lines expressed concern about the possibility that the logo may be misunderstood as a crashing airplane.

26. In part of 1998 and 1999, Untied.com displayed the following logo:

UNTIED AIRLINES

The most Unfriendly Skies



27. In 1999, the logo displayed on Untied.com was changed to the following:



This logo was displayed on Untied.com until March 2007.

28. Until 2005, the Plaintiff United displayed the following logo on its website:



29. In March 2007, the logo displayed on Untied.com was changed to the following:



30. Between 2006 and 2010, the Plaintiff United displayed the following logo on its website:



31. Since 2011, the Plaintiffs have Plaintiff has been displaying the following logo on their its website:



32. In August 2011, the Defendant redesigned the Untied.com website, and changed the logo displayed there to one that includes a frowning globe:



DEFENDANT'S RESPONSE TO THE ~~PLAINTIFFS'~~ PLAINTIFF'S CONCERNS

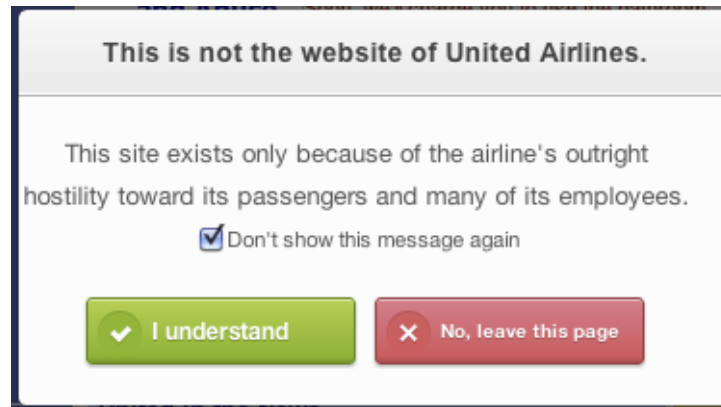
33. Between 1999 and July 16, 2012, the Plaintiffs Plaintiff expressed no concern nor objection regarding the logos displayed on the Defendant's website, which parodied the logos displayed by the Plaintiffs Plaintiff.

34. In early October 2012, the Defendant made the following changes on Untied.com in response to the ~~Plaintiffs'~~ Plaintiff's concerns as an additional, possibly unnecessary, safety measure to avoid any possible confusion:

- (a) The logo displayed on Untied.com was changed to the following (the color of the letters "TI" and the frown were changed to red):



- (b) A disclaimer that reads "(This is **not** the web page of United Airlines)" was added.
- (c) A pop-up, requiring first-time visitors to acknowledge that they understand that Untied.com is not the website of the Plaintiffs Plaintiff, was added:



35. The Defendant denies that a reasonable person could confuse his website, Untied.com, with the Plaintiffs' Plaintiff's website.

COPYRIGHT

36. The Defendant denies the Plaintiffs' Plaintiff's allegations that copyright subsists in the items listed in paragraphs 8-10 of the Statement of Claim.
37. Alternatively, the Defendant denies that the Plaintiffs' Plaintiff's own copyright in any of the items listed in paragraphs 8-10 of the Statement of Claim.
38. In the further alternative, the Defendant denies that the Defendant's Website reproduces a substantial part of any work in which the Plaintiffs own Plaintiff owns copyright.
39. With respect to paragraph 15 of the Statement of Claim, the graphics and text used on the Defendant's Website reproduce no substantial part of any original expression or work in which the ~~Plaintiffs own~~ Plaintiff owns copyright.
40. With respect to paragraph 9 of the Statement of Claim, the Plaintiffs Plaintiff can claim no copyright in banal and non-original design ele-

ments such as the use of “Sans-serif” font. The alleged use by the Defendant of particular design elements of the Plaintiffs’ Plaintiff’s website constitutes insubstantial copying that does not attract liability under section 3 of the *Copyright Act*, because the Defendant’s Website has markedly different content and functionality.

41. In the further alternative, any dealing on the Defendant’s Website with a substantial part of any work the copyright to which is owned by the Plaintiffs Plaintiff constitutes fair dealing for the purposes of parody, satire, criticism, and/or review, and as such constitutes no infringement pursuant to sections 29 and 29.1 of the *Copyright Act*.

DEFENDANT IS NOT ENGAGED IN COMMERCIAL ACTIVITY

42. The present matter relates to consumer criticism and consumer expression. It is far removed from the sort of commercial dispute for which a claim in trade-mark is appropriate.
43. According to paragraph 4 of the Statement of Claim, the Plaintiffs operate Plaintiff operates a large global airline, and ~~sell~~ sells air travel tickets on their its website.
44. In sharp contrast, the Defendant is an educator, who is engaged in no commercial activity or course of trade.
45. The Defendant is not a business, and in particular, not a business in the same area as the Plaintiffs Plaintiff.
46. The Defendant’s Website does not sell wares or services. The Defendant’s Website transfers no property in or possession of any wares. The Defendant’s non-commercial speech embodied in the Defendant’s

Website does not constitute a “service” within the meaning of the *Trade-marks Act*.

TRADE-MARK

47. The Defendant’s Website offers no “use” of trade-marks in association with the transfer of wares or advertisement or performance of services, as that term is defined and used in the *Trade-marks Act*. No trade-marks are associated with the transfer of property in or possession of any wares, nor associated with the advertisement or performance of any service.

48. The Defendant's Website makes no use of marks as a "trade-mark", that is, for the purpose of distinguishing or so as to distinguish wares or services manufactured, sold, leased, hired or performed by the Defendant – or anyone, for that matter – from those manufactured, sold, leased, hired or performed by others.
49. The Defendant uses no marks on the Defendant's Website that are owned by the Plaintiffs Plaintiff.
50. In the alternative, the Defendant's use of any marks on the Defendant's Website – which use is denied – does not constitute use of a mark in association with any ware or service itemized in any trade-mark registration registered in the Plaintiffs' Plaintiff's name.
51. In the further alternative, the Defendant's Website does not sell, distribute or advertise wares or services in association with a mark confusing with any trade-mark owned by the Plaintiffs Plaintiff. There is no likelihood of confusion between any trade-mark owned by the Plaintiff and anything on the Defendant's Website.
52. The theoretical possibility of such confusion – which is denied – is extinguished by the liberal use of disclaimers on the Defendant's Website, which specifically alert visitors to the Defendant's Website to the fact that it is not operated by the Plaintiffs Plaintiff.
53. The Defendant has made no use of a trade-mark registered by the Plaintiffs Plaintiff in a manner that is likely to have the effect of depreciating the value of the goodwill attaching thereto. To the extent that the Plaintiffs' Plaintiff's goodwill has depreciated, the Defendant claims that such goodwill attaches to the Plaintiffs' Plaintiff's business reputation, and not to the attractive force of its registered trade-marks.

54. According to the United States Department of Transportation, the ~~Plaintiffs~~ Plaintiff is the most complained about airline. Thus, it is unreasonable and ludicrous to allege that damage to goodwill has its source in the Defendant's actions.
55. Section 22 of the *Trade-marks Act* does not shield the ~~Plaintiffs~~ Plaintiff from the harmful ramifications of their its own treatment of passengers and/or their its own employees.

DELAY OF 15 YEARS

56. The ~~Plaintiffs~~ Plaintiff has been aware of the Defendant's Website, the domain Untied.com, and the Defendant's expressive activities therein for more than 15 years.
57. The ~~Plaintiffs~~ Plaintiff has not brought legal claims against the Defendant during that time, and the Defendant has relied upon the ~~Plaintiffs'~~ Plaintiff's conduct. The ~~Plaintiffs~~ Plaintiff is now barred from raising claims that ought to have been brought years ago.
58. The ~~Plaintiffs~~ Plaintiff now attempt attempts to revive their its claim in trade-mark by framing it in copyright. The ~~Plaintiffs~~ Plaintiff should not thereby be allowed to sidestep a delay of a decade and a half.

ABUSE OF PROCESS

59. This action is an abuse of process and should be dismissed, or in the alternative, the ~~Plaintiffs~~ Plaintiff should be denied equitable relief.
60. The ~~Plaintiffs~~ Plaintiff has brought this action in bad faith, without justification, and with an extraneous and improper purpose, namely, to use this litigation to coerce the Defendant to shut down the Untied.com

website.

61. The ~~Plaintiffs have~~ Plaintiff has not previously asserted their its rights with respect to copyright in Canada. Indeed, as Schedule “A” of the Statement of Claim demonstrates, ~~Plaintiffs~~ Plaintiff registered their its copyright only on October 29, 2012, that is, 21 days before instituting the present action.
62. The ~~Plaintiffs have~~ Plaintiff has no reasonable ground to believe that the Defendant’s Website wrongfully interferes with the ~~Plaintiffs’~~ Plaintiff’s business in Canada or elsewhere.
63. The ~~Plaintiffs’~~ Plaintiff’s predominant purpose in bringing this action is not to preserve or defend any alleged rights under the *Trade-marks Act* or the *Copyright Act*, or to obtain proper compensation for the violation of any such rights. Rather, their predominant purpose is to strong-arm the Defendant into giving up his expressive activities critical of the ~~Plaintiffs’~~ Plaintiff’s conduct.
64. The ~~Plaintiffs’~~ Plaintiff’s unlawful conduct described above is reprehensible, and deserves this Honourable Court’s condemnation.

GOOD FAITH AND REMEDIES

65. In the alternative, should the Honourable Court find any infringements of copyright or trade-mark, the Defendant has at all times acted in good faith and has taken steps to avoid infringement of ~~Plaintiffs’~~ Plaintiff’s intellectual property.
66. The Defendant was responsive to the ~~Plaintiffs’~~ Plaintiff’s concerns, and offered to meet with the ~~Plaintiffs’~~ Plaintiff’s representatives on a num-

ber of occasions since July 17, 2012. The Defendant was expecting that such a meeting would take place in December 2012; however, instead, ~~Plaintiffs~~ Plaintiff chose to institute the present action against the Defendant.

67. The Defendant denies that ~~Plaintiffs~~ Plaintiff suffered any damages as a result of the Defendant's actions. To the extent that the ~~Plaintiffs are~~ Plaintiff is ultimately found to be entitled to damages, and elect statutory damages under copyright law, such damages ought to be set at no more than \$100 as non-commercial statutory damages.
68. The Defendant submits that the ~~Plaintiffs'~~ Plaintiff's action against him be dismissed with costs.

June 20, 2013

DR. JEREMY COOPERSTOCK
392 Grosvenor Street
Westmount, Québec H3Z 2M2
Tel: 438-808-6463

jcooperstock@gmail.com

Defendant

TO: **GOWLING LAFLEUR HENDERSON LLP**
1 Place Ville Marie, 37th Floor
Montreal, Quebec H3B 3P4

Me Hélène D'Iorio

Tel: 514-392-9564
Fax: 514-878-1450

Me Lee A. Johnson

Tel: 514-392-9502

Fax: 514-876-9502

**Solicitor for the Plaintiff,
United Airlines, Inc.**

FEDERAL COURT

BETWEEN: UNITED AIR LINES AIRLINES, INC. and
~~CONTINENTAL AIRLINES, INC.~~

Plaintiffs
Plaintiff

AND

JEREMY COOPERSTOCK

Defendant

AMENDED REPLY

1. The ~~Plaintiffs deny~~ Plaintiff denies all of the allegations contained in the Defendant's Amended Statement of Defence, except as specifically admitted herein, and puts the Defendant to the strict proof thereof.
2. The ~~Plaintiffs~~ Plaintiff accepts the admission made in paragraph 1 of the Amended Statement of Defence.
3. With respect to the Defendant's allegations contained in paragraphs 19 to 24, 28, 30 and 31, the ~~Plaintiffs have~~ Plaintiff has used the trade-marks UNITED and UNITED

AIRLINES in Canada since at least as early as 1939 and these marks are the subject of registration numbers TMA204,456 and TMA367,179.

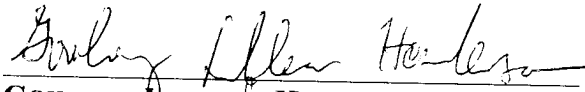
4. With respect to the Defendant's allegations relating to parody, including those contained in paragraphs 33 to 35 and 41, the ~~Plaintiffs deny~~ Plaintiff denies that the logos displayed on the Defendant's website constitute parodies of the ~~Plaintiffs'~~ Plaintiff's works as protected by copyright. The ~~Plaintiffs~~ Plaintiff further submits that any defence of fair dealing for the purposes of parody under Section 29 of the *Copyright Act* was only available as of November 7, 2012 and in any event, is not applicable to the case at hand. Furthermore, the ~~Plaintiffs deny~~ denies that the actions of the Defendant, before or after November 7, 2012, constitute fair dealing under the *Copyright Act*.
5. With respect to paragraph 34, the ~~Plaintiffs~~ Plaintiff alleges that the changes outlined in this paragraph were only made after the filing and service of the Statement of Claim, namely after November 19, 2012.
6. The ~~Plaintiffs~~ Plaintiff admits the allegation contained in paragraph 43.
7. With respect to paragraphs 42 and 44 to 55, the ~~Plaintiffs~~ Plaintiff ~~deny~~ denies that these are defences to trade-mark infringement. With respect to paragraph 52, the ~~Plaintiffs~~ Plaintiff further submits that even if disclaimers were made by the Defendant, which is not admitted by the ~~Plaintiffs~~ Plaintiff, there have been actual instances of confusion where visitors to the UNTIED.com website thought they were on the UNITED website.
8. With respect to paragraphs 56 to 58, the ~~Plaintiffs~~ Plaintiff ~~deny~~ denies that there has been a delay of fifteen (15) years in commencing the present proceeding. The proceeding commenced by the ~~Plaintiffs~~ Plaintiff relates to activities of the Defendant relating to the redesign of his website, which occurred by the Defendant's own admission in 2011, as contained in paragraph 32 of the Amended Statement of Defence.
9. With respect to paragraphs 59 to 64, the ~~Plaintiffs~~ Plaintiff expressly ~~deny~~ denies that the present action is an abuse of process and that the ~~Plaintiffs~~ Plaintiff should be denied equitable relief. As specifically stated in the Amended Statement of Claim, the ~~Plaintiffs~~ Plaintiff ~~are~~ is not seeking to prevent the Defendant from operating a website where

individuals can express their views about the ~~Plaintiffs~~ Plaintiff, but ~~are~~ is rather seeking to protect ~~their~~ its intellectual property rights and prevent consumer confusion over whether the ~~Plaintiffs~~ Plaintiff owns and/or sponsors the Defendant's UNTIED.com website.

10. With respect to paragraph 66, the Defendant refused to modify ~~its~~ his website prior to commencement of the present action.
11. The ~~Plaintiffs~~ Plaintiff further ~~deny~~ denies that the Defendant is entitled to any of the remedies or relief sought in the Amended Statement of Defence, including the remedies and relief sought in paragraphs 59, 67 and 68.

MONTREAL, February 6, 2013.

Amended June 27, 2013.



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Solicitors for the ~~Plaintiffs~~ Plaintiff

TO: The Administrator
Federal Court of Canada
Trial Division

AND TO: Jeremy Coopertsock
392 Grosvenor Street
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Defendant

Federal Court



Cour fédérale

Date: 20140703

Docket: T-2084-12

Citation: 2014 FC 645

Montréal, Quebec, July 3, 2014

PRESENT: Prothonotary Richard Morneau**BETWEEN:****UNITED AIRLINES, INC.****Plaintiff****and****JEREMY COOPERSTOCK****Defendant****ORDER AND REASONS**

[1] This is a motion by the defendant for a ruling on objections raised by the plaintiff (United) during the examination for discovery of United's representative, Scott Albert Wilson, on October 2, 2013.

Background

[2] The general background to this motion is essentially the following.

[3] On November 19, 2012, United filed an action in this Court against the defendant for registered trade-mark infringement, copyright infringement, the tort of passing off and depreciation of goodwill.

[4] It is the Court's understanding that United filed such an action in November 2012 essentially because it found that the defendant was causing it harm by operating a website under a specific domain name and in a manner such that United's clients were confusing the defendant's site with that of United.

[5] It is also the Court's understanding that United claims that it is because of the following major events that the parties ended up essentially, over the years, using very similar domain names (including associated visual elements).

[6] After an unpleasant travel experience with United in the summer of 1996, the defendant created a website under the domain name untied.com (UNTIED.com) in April 1997.

[7] Subsequently, in December 1998, United stopped using its website under the domain name ual.com, which it had been using since February 21, 1994, and started using the domain name united.com (UNITED.com). Note that United has apparently been the owner, among other things, of registered trade mark UNITED since 1975 based on use since 1939.

[8] On or about March 3, 2012, United re-launched its website to appear as follows, which is its present form:



[9] Until then, the parties seem to have been able to co-exist without incident.

[10] However, United submits that, in April 2012, it noted that the defendant had modified his website in the recent past to appear as follows:



[11] According to United, that situation is essentially what has led to the action. At paragraphs 15 and 16 of its Statement of Claim, United alleges the following:

15. At some time between March 3, 2012 and April 9, 2012, the Defendant caused UNTIED.com to be redesigned. The newly designed UNTIED.com site very closely resembles the recently redesigned United Website. Amongst other things, the colour scheme, font, general website layout, and prominent placement of the logo, which is confusingly similar with the United Logo and the Globe Design, are all nearly exactly the same on both the United Website and the new version of UNTIED.com. All of ~~Plaintiffs'~~ Plaintiff's Trade-marks, and/or indicia confusingly similar therewith, appear on the redesigned version of UNTIED.com. This results in UNTIED.com having an overall appearance which very closely resembles and is difficult to distinguish from that of the United Website.

16. UNTIED.com allows visitors to the site to submit complaints. For at least one visitor, the Defendant assigned an Untied.com complaint number to the visitor's complaint and instructed the visitor to use the complaint number in correspondence with ~~United~~ the Plaintiff. However, since ~~United~~ the Plaintiff does not operate UNTIED.com, it did not receive this visitor's complaint and did not assign a complaint number to the visitor. As a result, the visitor subsequently contacted ~~United~~ the Plaintiff, noted that he had registered an online complaint via UNTIED.com, but he had not received a response from ~~United~~ the Plaintiff. This example is one of many situations where customers

have evidenced confusion between the United Website and UNTIED.com.

[12] The defendant strongly criticizes United's legal action.

[13] According to him, United is the maker of its own misfortune because, in December 1998, it changed its domain name to a name similar to the one he established in April 1997.

[14] Furthermore, the defendant is of the opinion that any damage United has allegedly suffered from over the years is due to its mistreatment of its passengers and employees.

[15] The defendant—who is self-represented, even though counsel, on his behalf, conducted the examination of Mr. Wilson on October 2, 2013—notes that he does not operate any business in connection with his website and does not sell any items via the website. He also states that, even though United challenges the timing of the event, he re-designed his website in October 2012 by making modifications which would reduce confusion, if any.

[16] In paragraphs 15 to 18 of his Amended Defence dated June 20, 2013, the defendant describes the purpose and presentation of his website:

15. For over 15 years, since 1997, the Defendant has been maintaining the website Untied.com as both a forum for postings by passengers and employees of the Plaintiff ~~United~~ and as a satirical website, employing parody to expose poor service to passengers and mistreatment of employees by the Plaintiff ~~United~~.

16. Visitors to Untied.com are offered the opportunity to post their account of their experiences with the Plaintiff ~~United~~. Each posting is automatically assigned a unique ID number.

17. The Defendant denies the allegation at paragraph 16 of the Statement of Claim that he instructed any visitor to Untied.com to use the ID number automatically generated by Untied.com in correspondence with the Plaintiff ~~United~~.

18. On the contrary, visitors who wish to submit a posting to Untied.com are presented with the following disclaimer:

Note that you are submitting your complaint to Untied.com, a website that provides a service for past and prospective passengers, alerting them to United Airlines' attitude towards its customers and employees. You may also wish to submit your complaint directly to any of the contacts at United Airlines. Before you do so, please see some tips for passengers considering legal action against the airline. And if you think United Airlines will take your complaint seriously, think again.

Furthermore, those who submit a posting to Untied.com are automatically sent an email message advising them of the appropriate avenues for contacting the Plaintiff ~~United~~.

[17] At paragraphs 60 and 63 of that same Defence, the defendant contends, as follows, that United's action before this Court is disguised in nature and that the real purpose of the action is to silence him by having his website shut down.

60. The ~~Plaintiffs have~~ Plaintiff has brought this action in bad faith, without justification, and with an extraneous and improper purpose, namely, to use this litigation to coerce the Defendant to shut down the Untied.com website.

...

63. The ~~Plaintiffs'~~ Plaintiff's predominant purpose in bringing this action is not to preserve or defend any alleged rights under the *Trade-marks Act* or the *Copyright Act*, or to obtain proper compensation for the violation of any such rights. Rather, their predominant purpose is to strong-arm the Defendant into giving up his expressive activities critical of the ~~Plaintiffs'~~ Plaintiff's conduct.

[18] Finally, note that United previously stated that it will no longer be claiming monetary compensation from the defendant. However, as noted by the Court at paragraph 3 of the reasons for order and order dated February 20, 2014, nonetheless, United still maintains that the defendant caused it damages:

[3] The Defendant wanted the Statement of Claim to be amended in order to reflect that the action for copyright infringement and for trade-mark infringement and passing off would not claim any more for damages. Evidently, the rest of the action continues on the same basis. Actually, the Plaintiff continues to claim that damages are incurred. It is rather that it will not be claiming monetary compensation for those alleged damages.

(See also paragraph 15 of that same decision.)

Analysis

Questions to be answered and documents to be produced during an examination for discovery: General applicable principles

[19] In *Reading & Bates Construction Co and al v Baker Energy Resources Corp and al* (1988), 24 CPR (3rd) 66, Justice McNair, in a general six-point note, first defined, in points 1 to 3, the parameters for determining whether a question or a document is relevant, and then stated, in points 4 to 6, a series of circumstances or exceptions whereby a question need not be answered or a document need not be produced.

[20] The Court stated the following at pages 70 to 72:

1. The test as to what documents are required to be produced is simply relevance. The test of relevance is not a matter for the exercise of the discretion. What documents parties are entitled to is a matter of law, not a matter of discretion. The principle for

determining what document properly relates to the matters in issue is that it must be one which might reasonably be supposed to contain information which may directly or indirectly enable the party requiring production to advance his own case or to damage the case of his adversary, or which might fairly lead him to a train of inquiry that could have either of these consequences: *Trigg v. MI Movers Int'l Transport Services Ltd.* (1986), 13 C.P.C. (2d) 150 (Ont. H.C.); *Canex Placer Ltd. v. A.-G. B.C.* (1975), 63 D.L.R. (3d) 282, [1976] 1 W.W.R. 644 (B.C.S.C.); and *Compagnie Financiere et Commerciale du Pacifique v. Peruvian Guano Co.* (1882), 11 Q.B.D. 55 (C.A.).

2. On an examination for discovery prior to the commencement of a reference that has been directed, the party being examined need only answer questions directed to the actual issues raised by the reference. Conversely, questions relating to information which has already been produced and questions which are too general or ask for an opinion or are outside the scope of the reference need not be answered by a witness: *Algonquin Mercantile Corp. v. Dart Industries Canada Ltd.* (1984), 82 C.P.R. (2d) 36 (F.C.T.D.); affirmed 1 C.P.R. (3d) 242 (F.C.A.).

3. The propriety of any question on discovery must be determined on the basis of its relevance to the facts pleaded in the statement of claim as constituting the cause of action (...)

4. The court should not compel answers to questions which, although they might be considered relevant, are not at all likely to advance in any way the questioning party's legal position: *Canex Placer Ltd. v. A.-G. B.C.*, supra; and *Smith, Kline & French Laboratories Ltd. v. A.-G. Can.* (1982), 67 C.P.R. (2d) 103 at p. 108, 29 C.P.C. 117 (F.C.T.D.).

5. Before compelling an answer to any question on an examination for discovery, the court must weigh the probability of the usefulness of the answer to the party seeking the information, with the time, trouble, expense and difficulty involved in obtaining it. Where on the one hand both the probative value and the usefulness of the answer to the examining party would appear to be, at the most, minimal and where, on the other hand, obtaining the answer would involve great difficulty and a considerable expenditure of time and effort to the party being examined, the court should not compel an answer. One must look at what is reasonable and fair under the circumstances: *Smith, Kline & French Ltd. v. A.-G. Can.*, per Addy J. at p. 109.

6. The ambit of questions on discovery must be restricted to unadmitted allegations of fact in the pleadings, and fishing expeditions by way of a vague, far-reaching or an irrelevant line of questioning are to be discouraged: *Carnation Foods Co. Ltd. v. Amfac Foods Inc.* (1982), 63 C.P.R. (2d) 203 (F.C.A.); and *Beloit Canada Ltee/Ltd. v. Valmet Oy* (1981), 60 C.P.R. (2d) 145 (F.C.T.D.).

[Emphasis added.]

[21] Furthermore, a party cannot be required in an examination for discovery to answer a question that forces the party to express an opinion, be it an expert opinion, its interpretation of a patent or its beliefs. The following is stated at page 508 of *Philips Export BV v Windmere Consumer Products Inc* (1986), 8 CPR (3d) 505:

Question 467, which must be read with Q. 466, asks for the belief of the plaintiff. In both the *Smith, Kline & French* case and in *Sperry Corp. v. John Deere Ltd. et al.* (1984), 82 C.P.R. (2d) 1, it is stated that opinion cannot be asked, as a rule, of a person being examined who is not an expert and that a party cannot be asked to express its position in terms of mental attitudes.

[Emphasis added.]

(See also *Rivtow Straits Ltd v BC Marine Shipbuilders Ltd*, [1977] 1 FC 735, page 736.)

[22] In light of these principles, we shall now address the defendant's motion to rule on the objections.

[23] Under this motion, there are close to forty-four (44) objections or questions to rule on. As required by this Court, the parties have produced a joint chart showing the Court the substance of the reasons in favour or not in favour of answering any question to be determined.

[24] Thus, and even though the Court has noted United's resentment in using the chart produced by the defendant, the Court has reproduced the duly completed chart and given it the title "the Chart".

[25] After having considered the parties' motion records and having heard them, and keeping the relevant principles of case law in mind, including those cited above and those raised by the parties, the Court has indicated in the Chart, using a double line (||) in the margin next to all or part of the reasoning of a party for each question to be determined, whether, ultimately, this question should be answered or not. The double line in the margin is in either one or the other of the last two columns of the Chart (with the exception of the Court's comments below that reflect the decision of the Court).

[26] Regarding category A in the Chart (the Chart has nine (9) categories and each category contains a number of questions), the only question included need not be answered because it uses, like the category title, loaded language.

[27] With respect to category B, and without regard to the title the defendant gave to this category, United is required—to the extent that the information or the documents exist—to answer questions 355, 356, 357 and 363 because, in addition to what the Court accepts from the Chart, the issue of the damages allegedly suffered by United still exists and United has not produced in its reply record an affidavit raising what it stated on page 4, point (c), of the Chart, which is, in short, that the information sought is not within its means of knowledge and that information finding is a disproportionate effort.

[28] Regarding questions 367 and 368, they are on their face disproportionate and irrelevant. They need not be answered.

[29] Regarding category C, United must answer question 463 because, as mentioned in paragraphs [18] and [27], *supra*, United still maintains that the defendant caused it damages. In that sense, question 463 is relevant and is notably limited to the damages caused by the defendant himself. It therefore does not include any other entity or person, who, over the years, could have caused, as is possibly the situation in the case of an imposing corporation like United, damages to United's reputation by, as well as other actions, providing or publicizing criticism in respect of it.

[30] Regarding category G, questions 211 and 212 need not be answered because they are a fishing expedition.

[31] Thus, United must answer questions 355, 356, 357, 363 and 463. However, United's representative need not return to answer those five questions. United may do so with a written letter to be served on or before July 28, 2014. That exercise will end the examination for discovery stage for the two parties.

[32] Furthermore, and as discussed in Court on May 27, 2014, the Court finds that this case is now at the requisition for pre-trial conference stage.

[33] Thus, on or before September 2, 2014, United will serve and file its requisition for pre-trial conference and its pre-trial conference memorandum in accordance with the requirements in Rule 258 of the *Federal Courts Rules* (Rules).

[34] Then, on or before October 2, 2014, the defendant will serve and file, in accordance with the requirements in the Rules, his pre-trial conference memorandum.

[35] The Court shall then schedule a pre-trial conference in this case as per the usual practice.

[36] Regarding costs, given that United was largely successful under the motion in issue, the Court awards costs to United under Column III of Tariff B.

[37] Finally, given the length of the Chart, it is deemed to be part of this order but will be sent to the parties by e-mail under separate cover.

“Richard Morneau”

Prothonotary

FEDERAL COURT
SOLICITORS OF RECORD

DOCKET: T-2084-12

STYLE OF CAUSE: UNITED AIRLINES, INC. v JEREMY COOPERSTOCK

PLACE OF HEARING: MONTRÉAL, QUEBEC

DATE OF HEARING: MAY 27, 2014

ORDER AND REASONS: RICHARD MORNEAU, PROTHONOTARY

DATED: JULY 3, 2014

APPEARANCES:

Hélène D'Iorio

FOR THE APPLICANT

Jeremy Cooperstock

FOR THE RESPONDENT
(ON HIS OWN BEHALF)

SOLICITORS OF RECORD:

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Montréal, Quebec

FOR THE APPLICANT

Jeremy Cooperstock
Westmount, Quebec

FOR THE RESPONDENT
(ON HIS OWN BEHALF)

THE CHART

Court File No. T-2084-12

FEDERAL COURT

BETWEEN:

UNITED AIRLINES, INC.

Plaintiff

And

JEREMY COOPERSTOCK

Defendant

ANSWERS TO REFUSALS

EXAMINATION FOR DISCOVERY OF MR. SCOTT WILSON (held October 2, 2013)

(Defendant's Motion to Compel Answers)

Q #	Pg.	Question	Objection	Defendant's position	Plaintiff's position
A. Plaintiff knowingly chose to use confusing domain name					
700 O-111	360	Why did United Airlines choose to move its operations from the perfectly acceptable short three letter UAL.com domain to United.com, which is longer and had the possibility of confusion with the Defendant's site?	Refused. Not relevant to any of the issues pleaded.	Relevance: a) the Plaintiff is alleging customer confusion resulting from the Defendant's website (paras. 21, 23 of the Statement of Claim) b) it is common ground that the Defendant began to use the domain untied.com, 20 months before the Plaintiff began using the domain, united.com c) the Defendant alleges that any alleged confusion by passengers arises from the Plaintiff's decision to use the domain name united.com (paras. 19-24 of the Defence)	This is a proper refusal. a) This question is not relevant to any of the issues pleaded. This question is not relevant to any or all of trade-mark infringement, confusion, depreciation of goodwill, and copyright infringement. b) Furthermore, these questions are characterized by the Defendant under the heading "Plaintiff knowingly chose to use confusing domain name". The Plaintiff is alleging, inter alia, infringement of its registered trade-marks for UNITED (registration 204,456) and UNITED AIRLINES (registration 367,179). These trade-marks were registered in 1975 and 1990, respectively, and are based on use since at least 1939, all well before the creation of the Defendant's website.

Q #	Pg.	Question	Objection	Defendant's position	Plaintiff's position
B. Plaintiff is the maker of its own misfortune					
355 U-36	194 (192)	To indicate how many complaints were forwarded via and from Untied.com to Ms. Harvill and Mr. Goodwin at United Airlines between October 1998 and September 2000.	Refused. This question is not relevant to any of the issues pleaded and in any event the Plaintiff cannot ascertain this information.	<p>Relevance:</p> <p>a) the Plaintiff is alleging customer confusion relating to passengers who submit their complaints through the Defendant's website (para. 16 of Statement of Claim)</p> <p>b) any damage the Plaintiff is allegedly suffering (para. 31 of Statement of Claim) is due to its own fault; this can defeat the Plaintiff's claim that there is a causality between Defendant's action and the damages allegedly suffered by Plaintiff</p> <p>The Plaintiff can easily answer questions 355 and 363 by consulting its own complaints database.</p>	<p>This is a proper refusal.</p> <p>a) This question is not relevant to any of the issues pleaded. This question is not relevant to any or all of trade-mark infringement, confusion, depreciation of goodwill, and copyright infringement.</p> <p>b) Furthermore, these questions are characterized by the Defendant under the heading "Plaintiff knowingly chose to use confusing domain name". The Plaintiff is alleging, inter alia, infringement of its registered trade-marks for UNITED (registration 204,456) and UNITED AIRLINES (registration 367,179). These trade-marks were registered in 1975 and 1990, respectively, and are based on use since at least 1939, all well before the creation of</p>

Q #	Pg.	Question	Objection	Defendant's position	Plaintiff's position
					<p>the Defendant's website.</p> <p>c) The answer to this question is also not within the Plaintiff's means of knowledge, but rather within the Defendant's means of knowledge.</p> <p>It is an abuse of process for one party to require the other party to expend great time and effort to obtain information within its means of knowledge.</p>
356 O-57	195	Produce records of the complaints received by United Airlines via Untied.com.	Refused. Not relevant to any of the issues pleaded.		<p>These are proper refusals.</p> <p>a) These questions are not relevant to any of the issues pleaded. These questions are not relevant to any or all of trade-mark infringement, confusion, depreciation of goodwill, and copyright infringement.</p> <p>b) Furthermore, these questions are characterized by the Defendant under the heading</p>
357 O-58	197	To provide the date when Ms. Harvill's email address ceased accepting forwarded complaints from Untied.com.	Refused. Not relevant to any of the issues pleaded.		

Q #	Pg.	Question	Objection	Defendant's position	Plaintiff's position
					<p>"Plaintiff knowingly chose to use confusing domain name". The Plaintiff is alleging, inter alia, infringement of its registered trade-marks for UNITED (registration 204,456) and UNITED AIRLINES (registration 367,179). These trade-marks were registered in 1975 and 1990, respectively, and are based on use since at least 1939, all well before the creation of the Defendant's website.</p>
363 U-39	199	To verify whether during and after September 2000 United received forwarded complaints sent to customercare@united.com from Untied.com, and until when these were received at customercare@united.com.	Refused. This information is impossible to ascertain, and this question is not relevant to any of the issues pleaded in any event.		<p>This is a proper refusal.</p> <p>a) This question is not relevant to any of the issues pleaded. This question is not relevant to any or all of trade-mark infringement, confusion, depreciation of goodwill, and copyright infringement.</p> <p>b) Furthermore, these questions are characterized by the Defendant under the heading "Plaintiff knowingly chose to</p>

Q #	Pg.	Question	Objection	Defendant's position	Plaintiff's position
					<p>use confusing domain name". The Plaintiff is alleging, inter alia, infringement of its registered trade-marks for UNITED (registration 204,456) and UNITED AIRLINES (registration 367,179). These trade-marks were registered in 1975 and 1990, respectively, and are based on use since at least 1939, all well before the creation of the Defendant's website.</p> <p>c) The answer to this question is also not within the Plaintiff's means of knowledge, but within the Defendant's means of knowledge.</p> <p>It is an abuse of process for one party to require the other party to expend great time and effort to obtain information within its means of knowledge.</p>
367	202	How many passenger complaints does United receive every	Refused. Not relevant to any of the issues	Relevance: a) Plaintiff alleges that it	These are proper refusals. a) These questions are not

Q #	Pg.	Question	Objection	Defendant's position	Plaintiff's position
O-62		year?	pleaded.	is "rated the world's most admired airline" para. 4 of Statement of Claim)	relevant to any of the issues pleaded. This question is not relevant to any or all of trade-mark infringement, confusion, depreciation of goodwill, and copyright infringement.
368 O-63	203	How many complaints has United received since the merger with Continental?	Refused. Not relevant to any of the issues pleaded.	<p>b) the Plaintiff alleges that Defendant's activities have had the effect of depreciating the value of the goodwill attaching to the Plaintiff's trade-marks (para. 29 of Statement of Claim)</p> <p>c) the Defendant alleges that the Plaintiff is the most complained about airline (para. 54 of the Defence)</p> <p>d) this speaks to the causality of the Defendant's conduct and the damages allegedly suffered by the Plaintiff</p> <p>e) the Defendant alleges that it is the Plaintiff's conduct itself, and not the Defendant's activities complained about, that have the effect of depreciating the value of</p>	<p>b) Furthermore, these questions are characterized by the Defendant under the heading "Plaintiff knowingly chose to use confusing domain name". The Plaintiff is alleging, inter alia, infringement of its registered trade-marks for UNITED (registration 204,456) and UNITED AIRLINES (registration 367,179). These trade-marks were registered in 1975 and 1990, respectively, and are based on use since at least 1939, all well before the creation of the Defendant's website.</p> <p>c) These questions are not relevant if characterized to relate to the questions of damages since the Plaintiff has indicated it will not seek</p>

Q #	Pg.	Question	Objection	Defendant's position	Plaintiff's position
				the goodwill attaching to the Plaintiff's trade-mark (para. 54 of the Defence)	monetary compensation from the Defendant.
435, 437 O-70 – O-71	229- 230	So would you say that passengers were happy with the results of the merger?/ So would you say that passengers were happy with the results of the merger The next question: would you say that the merger caused damage to the goodwill of United?	Refused. Not relevant to any of the issues pleaded and question about goodwill requires a legal interpretation and/or expert opinion.		<p>These are proper refusals.</p> <p>a) These questions are not relevant to any of the issues pleaded. These questions are not relevant to any or all of trade-mark infringement, confusion, depreciation of goodwill, and copyright infringement. </p> <p>b) Furthermore, these questions are characterized by the Defendant under the heading "Plaintiff knowingly chose to use confusing domain name". The Plaintiff is alleging, inter alia, infringement of its registered trade-marks for UNITED (registration 204,456) and UNITED AIRLINES (registration 367,179). These trade-marks were registered in 1975 and 1990, respectively, and are based on use since at least 1939, all well before the creation of</p>

Q #	Pg.	Question	Objection	Defendant's position	Plaintiff's position
					<p>the Defendant's website.</p> <p>c) Furthermore, answer to these questions require a legal opinion and/or expert opinion and therefore are not a proper subject for discovery. </p> <p>d) These questions are not relevant if characterized to relate to the questions of damages since the Plaintiff has indicated it will not seek monetary compensation from the Defendant.</p>
443 O-72	233	Would you agree with me that the loss of goodwill was a result of the bad treatment, and had nothing to do with Dr. Cooperstock's alleged actions?	Refused. Requires a legal interpretation and/or expert opinion.		<p>This is a proper refusal.</p> <p>a) Answer to this question requires a legal opinion and/or expert opinion and therefore are not a proper subject for discovery. </p> <p>b) These questions are not relevant if characterized to relate to the questions of damages since the Plaintiff has indicated it will not seek monetary compensation from the</p>

Q #	Pg.	Question	Objection	Defendant's position	Plaintiff's position
					Defendant.
448 O-73	235	Are the events described in the video true? [exhibit 29]	<u>Refused</u> . Not relevant to any of the issues pleaded.		These are proper refusals. a) These questions are not relevant to any of the issues pleaded. These questions are not relevant to any or all of trade-mark infringement, confusion, depreciation of goodwill, and copyright infringement.
455 O-79	241	Are the events described in the second video true? [exhibit 29]	<u>Refused</u> . Not relevant to any of the issues pleaded.		b) Furthermore, these questions are characterized by the Defendant under the heading "Plaintiff knowingly chose to use confusing domain name". The Plaintiff is alleging, inter alia, infringement of its registered trade-marks for UNITED (registration 204,456) and UNITED AIRLINES (registration 367,179). These trade-marks were registered in 1975 and 1990, respectively, and are based on use since at least 1939, all well before the creation of the Defendant's website.

Q #	Pg.	Question	Objection	Defendant's position	Plaintiff's position
					c) These questions are not relevant if characterized to relate to the questions of damages since the Plaintiff has indicated it will not seek monetary compensation from the Defendant.
C. Damages allegedly suffered by United -- paragraph 31 of the Statement of Claim					
449 O-74	235	Have you calculated the amount of revenue that United allegedly lost as a result of this video? [exhibit 29]	Refused. Not relevant to any of the issues pleaded.	Relevance: a) although the Plaintiff is no longer claiming monetary compensation as a remedy, it is alleging that the Defendant's activities cause the Plaintiff to suffer considerable damages (para. 31 of Statement of Claim); b) thus, whether and to what extent the Plaintiff has suffered damages caused by the Defendant, is relevant; and c) whether Plaintiff has suffered damages caused	These are proper refusals. a) These questions are not relevant to any of the issues pleaded. These questions are not relevant to any or all of trade-mark infringement, confusion, depreciation of goodwill, and copyright infringement. b) Furthermore, these questions are characterized by the Defendant under the heading "Plaintiff knowingly chose to use confusing domain name". The Plaintiff is alleging, inter alia, infringement of its registered trade-marks for UNITED (registration 204,456) and
456 O-80	242	Have you calculated the amount of revenue that United allegedly lost as a result of the second video? [exhibit 29]	Refused. Not relevant to any of the issues pleaded.		

Q #	Pg.	Question	Objection	Defendant's position	Plaintiff's position
				by other individuals against whom the Plaintiff has taken no legal action, relates to abuse of process (paras. 59-63 of the Defence)	UNITED AIRLINES (registration 367,179). These trade-marks were registered in 1975 and 1990, respectively, and are based on use since at least 1939, all well before the creation of the Defendant's website.
463 O-85	246	Provide specific answers, so specific type of damages, specific dollar amounts, specific prejudice that United suffered or claims to suffer as a result of the infringement which it alleges that Untied.com/ Jeremy Cooperstock is responsible for?	<u>Refused</u> United hereby confirms that it will not be claiming monetary compensation in the present proceeding for the infringement of its rights and as such, the questions are not relevant.		This is a proper refusal. a) These questions are not relevant to any of the issues pleaded. These questions are not relevant to any or all of trade-mark infringement, confusion, depreciation of goodwill, and copyright infringement. b) Furthermore, these questions are characterized by the Defendant under the heading "Plaintiff knowingly chose to use confusing domain name". The Plaintiff is alleging, inter alia, infringement of its registered trade-marks for UNITED (registration 204,456) and UNITED AIRLINES (registration 367,179). These

Q #	Pg.	Question	Objection	Defendant's position	Plaintiff's position
					<p>trade-marks were registered in 1975 and 1990, respectively, and are based on use since at least 1939, all well before the creation of the Defendant's website.</p> <p>c) Plaintiff has confirmed that it will not be claiming any monetary compensation in the within proceeding for infringement of its rights. Accordingly, this question is not relevant.</p>
D. History of Defendant's website as known to the Plaintiff					
114 O-15	82	As United Airlines, do you see any trade mark or copyright objections to this webpage as it now stands?	Refused. The question calls for a legal interpretation and requires expert opinion.	The questions were not related to mental attitudes, but rather, seeking a factual response as to whether the Plaintiff considered the Defendant's website to be a source of potential customer confusion or any other harm, earlier in its history.	<p>This is a proper refusal.</p> <p>Answer to this question requires a legal opinion and/or expert opinion and therefore are not a proper subject for discovery.</p>
133 O-17	91	Does United have any concerns about trade mark or copyright at this stage/how did United "feel" in this regard, as of the year 2000 (with reference	Refused. United's "concerns" or "feelings" as of 2000 are a) not relevant to any of the issues pleaded; b) the question is vague		<p>This is a proper refusal.</p> <p>a) This question is not relevant to any of the issues pleaded. This question is not relevant to any or all of trade-mark infringement, confusion,</p>

Q #	Pg.	Question	Objection	Defendant's position	Plaintiff's position
		to Exhibit 9)?	because the meaning of "concerns" or "feelings" cannot be ascertained; c) witness cannot be asked to express his position in terms of mental attitudes and d) any discussions about infringement of the Plaintiff's rights are subject to solicitor-client privilege.	<p>The Plaintiff's representative readily understood similar question(s) and had no difficulty ascertaining the meaning of "what United felt" and "what was United's concern" in answering undertakings #2 and #3.</p> <p>Relevance:</p> <p>a) timeliness of the action, in not bringing legal claims for more than 15 years (para. 25-33 and 56-57 of the Defence);</p> <p>b) bad faith (para. 60 of the Defence);</p> <p>c) allegations of infringement of trade-mark and copyright (para. 7-14 of Plaintiff's amended Statement of Claim).</p>	<p>depreciation of goodwill, and copyright infringement.</p> <p>This question is also not relevant because it relates to situations and circumstances in and around the year 2000. The within proceeding is concerned, <i>inter alia</i>, with the Defendant's infringing activities beginning in and around the year 2012.</p> <p>b) Furthermore, these questions are characterized by the Defendant under the heading "Plaintiff knowingly chose to use confusing domain name". The Plaintiff is alleging, <i>inter alia</i>, infringement of its registered trade-marks for UNITED (registration 204,456) and UNITED AIRLINES (registration 367,179). These trade-marks were registered in 1975 and 1990, respectively, and are based on use since at least 1939, all well before the creation of the Defendant's website.</p>

Q #	Pg.	Question	Objection	Defendant's position	Plaintiff's position
				Plaintiff has provided no evidence to support solicitor-client privilege on these questions.	<p>c) This question is also vague. Questions of this nature amount to fishing expeditions and are inappropriate.</p> <p>d) This question is also inappropriate for asking the Plaintiff to express its position in terms of mental attitudes.</p> <p>e) This question relating to discussions about infringement of the Plaintiff's rights is also inappropriate for relating to subject matter protected by privilege.</p> <p>In the context of a motion to compel, questions that fall under solicitor-client privilege need not be answered.</p>
134 O-18	92	Was United concerned with the use of the word "Untied" or the font as of the year 2000? (with reference	Refused. United's "concerns" as of 2000 are a) not relevant to any of the issues pleaded; b) the question is vague		<p>This is a proper refusal.</p> <p>For the same reasons as question 133 above.</p>

Q #	Pg.	Question	Objection	Defendant's position	Plaintiff's position
		to Exhibit 9)	because the meaning of "concerns" cannot be ascertained; c) witness cannot be asked to express his position in terms of mental attitudes and d) any discussions about infringement of the Plaintiff's rights are subject to solicitor-client privilege.		
135 O-19	92	Was United worried about the colour scheme employed in the logo or the webpage layout as of the year 2000?	Refused. Whether United was "worried" as of 2000 is a) not relevant to any of the issues pleaded; b) the question is vague because the meaning of "concerns" cannot be ascertained; c) witness cannot be asked to express his position in terms of mental attitudes and d) any discussions about infringement of the Plaintiff's rights are subject to solicitor-client		This is a proper refusal. For the same reasons as question 133 above.

Q #	Pg.	Question	Objection	Defendant's position	Plaintiff's position
			privilege.		
136 O-20	92	Was United worried that this might be infringing on United's trademarks or copyright as of the year 2000?	Refused. Whether United was "worried" as of 2000 is a) not relevant to any of the issues pleaded; b) the question is vague because the meaning of "worried" cannot be ascertained; c) witness cannot be asked to express his position in terms of mental attitudes; d) requires a legal interpretation and e) any discussions about infringement of the Plaintiff's rights are subject to solicitor-client privilege.		<p>This is a proper refusal.</p> <p>a) This question is not relevant to any of the issues pleaded. This question is not relevant to any or all of trade-mark infringement, confusion, depreciation of goodwill, and copyright infringement.</p> <p>b) Furthermore, these questions are characterized by the Defendant under the heading "Plaintiff knowingly chose to use confusing domain name". The Plaintiff is alleging, inter alia, infringement of its registered trade-marks for UNITED (registration 204,456) and UNITED AIRLINES (registration 367,179). These trade-marks were registered in 1975 and 1990, respectively, and are based on use since at least 1939, all well before the creation of the Defendant's website.</p>

Q #	Pg.	Question	Objection	Defendant's position	Plaintiff's position
					<p>c) This question is also vague. Questions of this nature amount to fishing expeditions and are inappropriate.</p> <p>d) This question is also inappropriate for asking the Plaintiff to express its position in terms of mental attitudes.</p> <p>e) Answer to this question requires a legal opinion and/or expert opinion and therefore is not a proper subject for discovery.</p> <p>f) This question relating to discussions about infringement of the Plaintiff's rights is also inappropriate for relating to subject matter protected by privilege.</p> <p>In the context of a motion to compel, questions that fall under solicitor-client privilege need not be answered.</p>

Q #	Pg.	Question	Objection	Defendant's position	Plaintiff's position
146 U-15	98	To verify if United had any concerns about trade-marks or copyright at the date of Exhibits 11 and 12 (August 25, 2005 and March 6, 2007).	Refused. United's "concerns" as of 2005-2007 are a) not relevant to any of the issues pleaded; b) the question is vague because the meaning of "concerns" cannot be ascertained; c) witness cannot be asked to express his position in terms of mental attitudes and d) any discussions about infringement of the Plaintiff's rights are subject to solicitor-client privilege.		This is a proper refusal. For the same reasons as question 133 above.
147 O-22	98	Was United concerned about the use of the word "Untied" or was United concerned about the font at the date of Exhibits 11 and 12 (August 25, 2005 and March 6, 2007).	Refused. United's "concerns" as of 2005-2007 are a) not relevant to any of the issues pleaded; b) the question is vague because the meaning of "concerned" cannot be ascertained; c) witness cannot be asked to express his position in terms of		This is a proper refusal. For the same reasons as question 133 above.

Q #	Pg.	Question	Objection	Defendant's position	Plaintiff's position
			mental attitudes and d) any discussions about infringement of the Plaintiff's rights are subject to solicitor-client privilege.		
148 O-23	99	Was United worried about the colour scheme employed in the logo or the webpage layout at the date of Exhibits 11 and 12 (August 25, 2005 and March 6, 2007)?	<u>Refused.</u> Whether United was "worried" as of 2005-2007 are a) not relevant to any of the issues pleaded; b) the question is vague because the meaning of "worried" cannot be ascertained; c) witness cannot be asked to express his position in terms of mental attitudes and d) any discussions about infringement of the Plaintiff's rights are subject to solicitor-client privilege.		This is a proper refusal. For the same reasons as question 133 above.
149 O-24	99	Was United worried that this might be infringing on United's trade-marks or	<u>Refused.</u> Whether United was "worried" as of 2005-2007 is a) not relevant to any of		This is a proper refusal.

Q #	Pg.	Question	Objection	Defendant's position	Plaintiff's position
		copyrights?	the issues pleaded; b) the question is vague because the meaning of "worried" cannot be ascertained; c) witness cannot be asked to express his position in terms of mental attitudes; d) calls for a legal interpretation and e) any discussions about infringement of the Plaintiff's rights are subject to solicitor-client privilege.		For the same reasons as question 136 above.
169 U-18	108	To verify if United had concerns about trade mark or copyright issues regarding the Untied.com webpage on September 3, 2011 (Exhibit 15).	Refused. United's "concerns" as of 2011 are not relevant to any of the issues pleaded, the question is vague because the meaning of "concerns" cannot be ascertained and witness cannot be asked to express his position in terms of mental attitudes.		This is a proper refusal. a) This question is not relevant to any of the issues pleaded. This question is not relevant to any or all of trade-mark infringement, confusion, depreciation of goodwill, and copyright infringement. b) Furthermore, these questions are characterized by the Defendant under the heading "Plaintiff knowingly chose to use confusing domain

Q #	Pg.	Question	Objection	Defendant's position	Plaintiff's position
					<p>name". The Plaintiff is alleging, inter alia, infringement of its registered trade-marks for UNITED (registration 204,456) and UNITED AIRLINES (registration 367,179). These trade-marks were registered in 1975 and 1990, respectively, and are based on use since at least 1939, all well before the creation of the Defendant's website.</p> <p>c) This question is also vague. Questions of this nature amount to fishing expeditions and are inappropriate. </p> <p>d) This question is also inappropriate for asking the Plaintiff express its position in terms of mental attitudes. </p>
170 O-30	108	Was United concerned about the word "Untied" or the font (as depicted on the Untied.com webpage on September 3, 2011	Refused. a) United's "concerns" as of 2011 are not relevant to any of the issues pleaded, b) the question is vague because the		<p>This is a proper refusal.</p> <p>For the same reasons as question 133 above. </p>

Q #	Pg.	Question	Objection	Defendant's position	Plaintiff's position
		(Exhibit 15))?	meaning of "concerned" cannot be ascertained, c) witness cannot be asked to express his position in terms of mental attitudes and d) any discussions about infringement of the Plaintiff's rights are subject to solicitor-client privilege.		
171 O-31	109	Was United worried about the colour scheme employed in the logo, or the webpage layout (as depicted on the Untied.com webpage on September 3, 2011 (Exhibit 15))?	Refused. Whether United was "worried" as of 2011 is not relevant to any of the issues pleaded, the question is vague because the meaning of "worried" cannot be ascertained, the witness cannot be asked to express his position in terms of mental attitudes and any discussions about infringement of the Plaintiff's rights are subject to solicitor-		This is a proper refusal. For the same reasons as question 133 above.

Q #	Pg.	Question	Objection	Defendant's position	Plaintiff's position
			client privilege.		
172 O-32	109	Was United worried that the Untied.com webpage on September 3, 2011 might be infringing on United's trade-marks or copyright?	Refused. Whether United was "worried" as of 2011 is a) not relevant to any of the issues pleaded; b) the question is vague because the meaning of "worried" cannot be ascertained; c) witness cannot be asked to express his position in terms of mental attitudes; d) calls for a legal opinion and e) any discussions about infringement of the Plaintiff's rights are subject to solicitor-client privilege.		This is a proper refusal. For the same reasons as question 136 above.
E. Failure to take legal action for 15 years					
137 O-21	94	Did United contemplate legal action?	Refused. This information is subject to solicitor-client privilege.	Relevance: a) the Plaintiff alleges infringement of trade-mark and copyright (paras. 7-14 of amended	These are proper refusals. a) These questions relating to discussions about infringement of the Plaintiff's rights and legal

Q #	Pg.	Question	Objection	Defendant's position	Plaintiff's position
				Statement of Claim) b) yet the Plaintiff took no action regarding Defendant's website for 15 years (paras. 25-33 and 56-57 of Defence); c) the delay may be grounds for denying equitable relief. The Plaintiff has provided no evidence to support solicitor-client privilege on these questions.	action are inappropriate for relating to subject matter protected by privilege. In the context of a motion to compel, questions that fall under solicitor-client privilege need not be answered. b) The defence of laches is not relevant since the within proceeding pertains to the redesign of the Defendant's website in 2012. Furthermore, even if the defence of laches had been applicable, it would go to the quantum of damages. Given that the Plaintiff is no longer claiming monetary compensation from the Defendant, the questions would, in any event, not be relevant.
153 O-25	101	Why did United Airlines do nothing about it?	Refused. This information is subject to solicitor-client privilege.		
		Why didn't United Airlines threaten legal action?	Refused. This information is subject to solicitor-client privilege.		
157 O-28	103	Why did United Airlines do nothing about it (Exhibit 12)?	Refused. This information is subject to solicitor-client privilege.		
159 O-29	104	And why didn't United Airlines threaten legal action about it (Exhibit 12)?	Refused. This information is subject to solicitor-client privilege.		
175	111	Did United Airlines contemplate legal action?	Refused. This information is subject to solicitor-client privilege.		

Q #	Pg.	Question	Objection	Defendant's position	Plaintiff's position
O-33		action?	to solicitor-client privilege.		
179 O-35	112	(Assuming that it did not) Why did United Airlines not do nothing about (the website as it appeared in Exhibit 15), and why didn't United Airlines threaten legal action?	Refused. This information is subject to solicitor-client privilege.		
F. Defendant has taken steps to avoid confusion					
203 O-36	119	Just to verify, would it be fair to say that you find that this is confusingly similar to the words "United" in blue?	Refused. The question requires a legal interpretation.	<p>This question does not require a legal interpretation, but is rather seeking a fact.</p> <p>Relevance:</p> <p>a) the Plaintiff is pleading "customers have evidenced confusion" (para.16 of Statement of Claim)</p> <p>b) the Defendant alleges that he has used different font colour, a pop-up</p>	<p>This is a proper refusal.</p> <p>Answer to this question requires a legal opinion and/or expert opinion and therefore is not a proper subject for discovery.</p>

Q #	Pg.	Question	Objection	Defendant's position	Plaintiff's position
				<p>dialog, and liberal disclaimers throughout his website to extinguish the theoretical possibility of confusion (para. 52 of Defence)</p> <p>c) answers to this question can show that the Defendant has taken sufficient steps to avoid creating confusion</p>	
G. Plaintiff brought action in bad faith					
211 O-38	123	To produce the minutes and internal correspondence of the meetings of United Airlines management regarding the discussions of Untied.com about the 23rd of August 2012 version of the website.	Refused. This information is subject to solicitor-client privilege and is not relevant to the issues pleaded.	<p>Relevance:</p> <p>a) the Defendant raises as a defence the Plaintiff's abuse of process (paras.59-60, 63-64, and 66 of the Defence)</p> <p>b) information provided in answer to these questions can demonstrate that the Plaintiff was never concerned about alleged damages but rather, the</p>	<p>This is a proper refusal.</p> <p>a) This question relating to discussions and documents about infringement of the Plaintiff's rights and legal action is inappropriate for relating to subject matter protected by privilege.</p> <p>In the context of a motion to compel, questions that fall under solicitor-client privilege need not be answered.</p>

Q #	Pg.	Question	Objection	Defendant's position	Plaintiff's position
				<p>real purpose of its action was to shut down the Defendant's website, contrary to what the Plaintiff states in the Statement of Claim</p>	<p>b) This question is not relevant to any of the issues pleaded. This question is not relevant to any or all of trade-mark infringement, confusion, depreciation of goodwill, and copyright infringement.</p> <p>This question neither seeks answers to advance the Defendant's position nor to damage the Plaintiff's position and is not relevant and is in the nature of a fishing expedition.</p> <p>c) Furthermore, these questions are characterized by the Defendant under the heading "Plaintiff knowingly chose to use confusing domain name". The Plaintiff is alleging, inter alia, infringement of its registered trade-marks for UNITED (registration 204,456) and UNITED AIRLINES (registration 367,179). These trade-marks were registered in 1975 and 1990, respectively, and are based on use since at least 1939, all</p>

Q #	Pg.	Question	Objection	Defendant's position	Plaintiff's position
					well before the creation of the Defendant's website.
212 O-39	124	To produce minutes and internal correspondence at United Airlines about the Untied.com website.	Refused. This information is subject to solicitor-client privilege and is not relevant to the issues pleaded.		<p>This is a proper refusal.</p> <p>a) This question relating to discussions and documents about infringement of the Plaintiff's rights and legal action is inappropriate for relating to subject matter protected by privilege.</p> <p>In the context of a motion to compel, questions that fall under solicitor-client privilege need not be answered.</p> <p>b) This question is not relevant to any of the issues pleaded. This question is not relevant to any or all of trade-mark infringement, confusion, depreciation of goodwill, and copyright infringement.</p> <p>c) Furthermore, these questions are characterized by the Defendant under the heading "Plaintiff knowingly chose to use confusing domain</p>

Q #	Pg.	Question	Objection	Defendant's position	Plaintiff's position
					name". The Plaintiff is alleging, inter alia, infringement of its registered trade-marks for UNITED (registration 204,456) and UNITED AIRLINES (registration 367,179). These trade-marks were registered in 1975 and 1990, respectively, and are based on use since at least 1939, all well before the creation of the Defendant's website.
550-552 O-101-O-103	294-295	What sort of legal action has United Airlines taken against Amplicate?/Has it threatened Amplicate with such legal action? Why not?	Refused. Not relevant to any of the issues pleaded.	Relevance: a) the Defendant alleges that the Plaintiff has singled out the Defendant, using litigation to coerce the Defendant to shut down his website (para. 60 of the Defence)	These are proper refusals. a) These questions are not relevant to any of the issues pleaded. These questions are not relevant to any or all of trade-mark infringement, confusion, depreciation of goodwill, and copyright infringement.
556-557 O-104-O-106	296-297	What sort of threats of legal action has United Airlines taken against Goldring Travel?/Has it taken any such legal action? Why not?	Refused. Not relevant to any of the issues pleaded.	b) the Defendant alleges that the Plaintiff's real purpose is to shut down the Defendant's website, rather than to preserve or defend any alleged rights under the Trade-marks	b) Furthermore, these questions are characterized by the Defendant under the heading "Plaintiff knowingly chose to use confusing domain name". The Plaintiff is alleging, inter alia,
562-564	299-300	What sort of threats of legal action has United Airlines taken against	Refused. Not relevant to any of the issues		

Q #	Pg.	Question	Objection	Defendant's position	Plaintiff's position
O-107– O-109		change.org?/Has it taken any such legal action? Why not?	pleaded.	Act or Copyright Act (para. 63 of the Defence).	infringement of its registered trade-marks for UNITED (registration 204,456) and UNITED AIRLINES (registration 367,179). These trade-marks were registered in 1975 and 1990, respectively, and are based on use since at least 1939, all well before the creation of the Defendant's website.
565 O-110	300	Indicate whether "anything has been done" about the webpages in Exhibits 32, 33, and 34.	Refused. Not relevant to any of the issues pleaded.	The Plaintiff has provided no evidence to support solicitor-client privilege on these questions.	
H. Right to know identity and nature of testimony of non-expert witnesses					
493- 495 O-91 – O-93	263- 264	What witnesses does United intend to call/what non-expert witnesses does United intend to call/what topics will they testify on?	Refused. This is an improper question under the Rules and is in the nature of a fishing expedition.	a) the Plaintiff is required to provide this information under Rule 240 (b) b) the requested information is specific to the identity and topics of testimony for "non-expert" witnesses	These are proper refusals. a) The Defendant is seeking answers through an improper use of Rule 240(b). Rule 240(b) does not compel disclosure of any witnesses and/or topics any such witnesses will they testify on. b) These questions also amount to a fishing expedition and are improper.

Q #	Pg.	Question	Objection	Defendant's position	Plaintiff's position
I. Mootness					
545-546 O-99 – O-100	293	Does United have plans to modify the layout of its web pages at any point in the future?/ Does United have plans to modify its logo at any point in the future?	<u>Refused.</u> Not relevant to any of the issues pleaded.	<u>Relevance:</u> By the time the matter goes to trial, it may become moot as United changes its website.	These are proper refusals. a) These questions are not relevant to any of the issues pleaded. These questions are not relevant to any or all of trade-mark infringement, confusion, depreciation of goodwill, and copyright infringement. b) Furthermore, these questions are characterized by the Defendant under the heading “Plaintiff knowingly chose to use confusing domain name”. The Plaintiff is alleging, inter alia, infringement of its registered trade-marks for UNITED (registration 204,456) and UNITED AIRLINES (registration 367,179). These trade-marks were registered in 1975 and 1990, respectively, and are based on use since at least 1939, all well before the creation of the Defendant's website.

Q #	Pg.	Question	Objection	Defendant's position	Plaintiff's position

Court File No.: T-2084-12

FEDERAL COURT

BETWEEN:

UNITED AIRLINES, INC.

Plaintiff

– and –

DR. JEREMY COOPERSTOCK

Defendant

AFFIDAVIT OF DR. JEREMY R. COOPERSTOCK

I, **DR. JEREMY R. COOPERSTOCK**, of the City of Westmount, in the Province of Quebec, AFFIRM THAT:

1. I am the Defendant in this proceeding, and as such I have personal knowledge of the matters deposed to.
2. I launched my website, Untied.com, in 1997, and operated it as both a forum for postings by passengers and employees of United Airlines and as a satirical website, employing parody to expose poor service to passengers and mistreatment of employees by United Airlines.

3. For more than 15 years since I launched Untied.com, the Plaintiff had not brought legal action against me.
4. On November 19, 2012, Plaintiff commenced two separate proceedings against me in two separate courts:
 - (a) the present proceeding before the Federal Court, alleging copy-right infringement, trade-mark infringement, and passing off; and
 - (b) a proceeding before the Quebec Superior Court, seeking a permanent injunction to have certain information removed from the United.com website.
5. On June 27, 2013, Plaintiff served its affidavit of documents in the present proceeding, a copy of which is attached and marked as Exhibit "A".
6. On October 2, 2013, examination on discovery of Plaintiff's representative in the present proceeding, Mr. Scott Albert Wilson, was held. Excerpts of the transcript of examination are attached and marked as Exhibit "B".
7. On November 25, 2013, Plaintiff communicated its responses to undertakings from the examination on discovery. Excerpts of these responses are attached and marked as Exhibit "C".
8. On May 21, 2014, I brought a motion to compel for examination on discovery of certain questions that Plaintiff had refused to answer, including those that related to my defence that Plaintiff brought its action in bad faith.

9. On July 3, 2014, Prothonotary Morneau ordered that Plaintiff need not answer questions regarding internal correspondence and meetings of United Airlines management regarding my Untied.com website.

10. More than one month after Prothonotary Morneau's order, it came to my attention that in internal correspondence, dated June 16, 2012, Mr. Jeff Wittig, senior in-house counsel for Plaintiff, wrote to Ms. Sandy Rodriguez in reference to my Untied.com website that "We're working on shutting it down."

11. This document was disclosed during the August 7, 2014 examination for discovery of Plaintiffs in a parallel action brought against me before the Quebec Superior Court. The implied undertaking rule prevented me from referring to this document before it was filed with that Court. A copy of the document is attached and marked as Exhibit "D".

12. On September 11, 2014, I served and filed my Defence in the Quebec Superior Court, including as an exhibit a copy of Mr. Wittig's email of June 16, 2012. An excerpt of the statement of defence in the parallel proceeding is attached and marked as Exhibit "E".

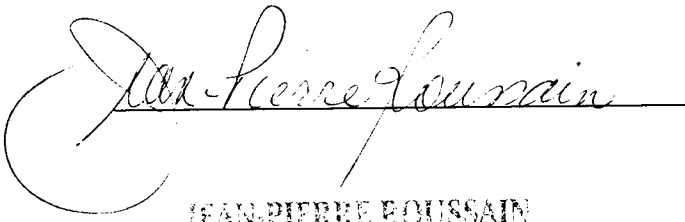
13. On September 12, 2014, I sent a letter to Plaintiff's counsel, requesting that Plaintiff update its affidavit of documents. A copy of this letter is attached and marked as Exhibit "F".

14. On September 22, 2014, I sent a follow-up letter to Plaintiff's counsel, again requesting that Plaintiff update its affidavit of documents. A copy of this letter is attached and marked as Exhibit "G".

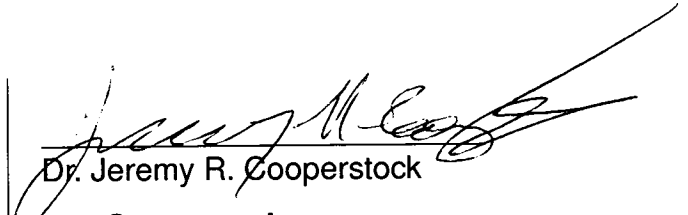
15. On October 3, 2014, I sent a follow-up letter to Plaintiff's counsel, again requesting that Plaintiff update its affidavit of documents. A copy of this letter is attached and marked as Exhibit "H".

16. As of the time of this writing, there has been no response received from Plaintiff's counsel to any of my letters from September 12, 2014 onward, requesting that Plaintiff update its affidavit of documents.

AFFIRMED before me at the City of
Montréal, in the Province of Québec
on October 31, 2014.

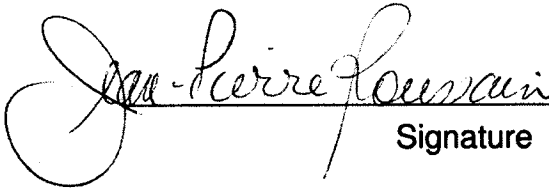


JEAN-PIERRE ROUSSAIN
AGENT DU GREFFE
REGISTRY OFFICER



Dr. Jeremy R. Cooperstock
392 Grosvenor Avenue
Westmount, Québec H3Z 2M2
Tel: 438-808-6463
jcooperstock@gmail.com

This is **Exhibit "A"** to the Affidavit of Dr. Jeremy R. Cooperstock
affirmed before me on October 31, 2014


Signature

JEAN-PIERRE ROUSSAIN
AGENT DU GREFFE
REGISTRY OFFICER

FEDERAL COURT**BETWEEN: UNITED AIRLINES, INC.****Plaintiff****AND****JEREMY COOPERSTOCK****Defendant**

AFFIDAVIT OF DOCUMENTS OF THE PLAINTIFF, UNITED AIRLINES, INC.

I, Scott Wilson, of the city of Chicago, Illinois, U.S.A., HEREBY SWEAR AND MAKE OATH THAT:

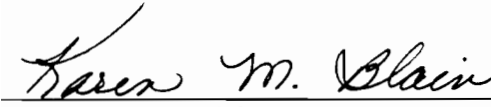
1. I am the Vice President, Merchandising and eCommerce, of the Plaintiff, United Airlines, Inc., in this action.
2. I have conducted a diligent search of the records of the Plaintiff and have made appropriate inquiries of others to inform myself in order to make this affidavit.
3. This affidavit discloses, to the full extent of my knowledge, information and belief, all of the documents relevant to any matter in issue in the action that are in the Plaintiff's possession, power or control, that were but are no longer in the Plaintiff's possession, power or control or that I believe are in the possession, power or control of a person who is not a party to the action.

4. I have listed and described in Schedule 1 all of the relevant documents, or bundles of relevant documents, that are in the Plaintiff's possession, power or control and for which no privilege is claimed.
5. I have listed and described in Schedule 2 all of the relevant documents, or bundles of relevant documents, that are or were in the Plaintiff's possession, power or control and for which privilege is claimed.
6. I have listed in Schedule 3 all of the relevant documents, or bundles of relevant documents, that were but are no longer in the Plaintiff's possession, power or control and for which no privilege is claimed.
7. I am not aware of any other relevant document other than those that are listed in this affidavit or that are or were only in the possession, power or control of another party in this action.

Sworn before me at the city of Chicago,
this 17 th day of June, 2013.



Scott Wilson



Commissioner of Oaths



Court File No. T-2084-12

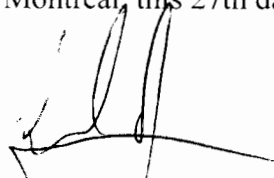
FEDERAL COURT**BETWEEN: UNITED AIRLINES, INC.****Plaintiff****AND****JEREMY COOPERSTOCK****Defendant**

CERTIFICATE OF SOLICITOR

I, **Lee Johnson**, certify that I have explained to the deponent of this affidavit of documents the necessity of making full disclosure under Rule 223 of the *Federal Courts Rules* and the possible consequences of failing to do so.

The documents listed in Schedule 1 to this affidavit may be inspected at 1 Place Ville Marie, 37th Floor, Montreal, Quebec, Canada, H3B 3P4, at a date and time to be agreed upon.

Montreal, this 27th day of June, 2013.



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Lee A. Johnson

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Solicitors for the Plaintiff

TO: The Administrator
Federal Court of Canada
Trial Division

AND TO: Jeremy Coopertsock
392 Grosvenor Street
Westmount, Quebec
H3Z 2M2
Defendant

SCHEDULE 1

The following are all of the relevant documents, or bundles or relevant documents, that are in the Plaintiff's possession, power or control and for which no privilege is claimed:

1. A copy of the Restated Certificate of incorporation for United Air Lines, Inc., dated February 1, 2006.
2. A copy of the Certificate of merger of JT Merger Sub Inc. With and Into Continental Airlines, Inc., dated effective October 1, 2010.
3. A copy of the Certificate of merger of United Air Lines, Inc. with and into Continental Airlines, Inc., with the surviving entity being United Airlines, Inc., dated effective March 31, 2013.
4. A copy of the certificates of Canadian copyright registration nos. 1099767 and 1104163, en liasse.
5. A copy of the certificates of Canadian copyright registration nos. 1099766 and 1104162, en liasse.
6. A copy of the certificates of Canadian copyright registration nos. 1099765 and 1104163, en liasse.
7. A copy of the certificate of Canadian trade-mark registration no. TMA204,456 for UNITED.
8. A copy of the certificate of Canadian trade-mark registration no. TMA367,179 for UNITED AIRLINES.
9. A copy of the certificate of Canadian trade-mark registration no. TMA492,886 for GLOBE DESIGN.
10. A copy of a Master Consulting Services Agreement between United Air Lines, Inc., Continental Airlines, Inc. and Oliver Wyman, Inc., through its Lippincott division, dated July 30, 2010.
11. A copy of a Confirmatory Assignment of copyright in the Globe Design from Oliver Wyman Inc., through its Lippincott Division, to Continental Airlines, Inc., executed November 9 and 16, 2012.
12. A copy of a Confirmatory Assignment of copyright in the Globe Design from Roger van den Bergh to Continental Airlines, Inc., executed November 27, 2012.
13. A copy of a Confirmatory Assignment of copyright in the www.united.com home page graphic design from OgilvyOne LLC, through its The Lacek Group division, to Continental Airlines, Inc., executed October 29, 2012.

14. A copy of a Confirmatory Assignment of copyright in the United Logotype from Oliver Wyman Inc., through its Lippincott Division, to United Air Lines, Inc. and Continental Airlines, Inc., executed November 9 and 16, 2012.
15. A printout of a chain of email correspondence between United Air Lines, Inc. and Jeremy Cooperstock between July 16, 2012 and October 12, 2012.
16. A copy of a letter sent from United Air Lines, Inc. to Defendant on September 10, 2012.
17. A copy of a letter sent from United Air Lines, Inc. to Defendant on October 2, 2012.
18. A printout of the homepage of www.untied.com, as it appeared on June 15, 2012.
19. A printout of the homepage of United Air Lines, Inc.'s website www.united.com, as it appeared on November 10, 2012.
20. A printout of the homepage of United Air Lines, Inc.'s website www.united.com, as it appeared on May 9, 2013.
21. A printout of the donations page of www.untied.com, retrieved on June 22, 2012.
22. A printout of the homepage of www.uspassportnow.com, retrieved on June 15, 2012.
23. A printout of the homepage of www.inweddingdress.com, retrieved on June 15, 2012.
24. A printout of an Internic whois search for www.untied.com, retrieved on June 15, 2012.
25. A printout of an eNom whois search for www.untied.com, retrieved on June 15, 2012.
26. A printout of the donations page from www.untied.com, retrieved on February 25, 2013.
27. A bundle of printouts of complaint statistics pages from www.untied.com, retrieved on June 11, 2013.
28. A printout of a webpage entitled "United Airlines attacks Untied.com" from www.untied.com, retrieved on February 25, 2013.
29. A printout of the complaint submission page from www.untied.com, retrieved on February 25, 2013.
30. A bundle of printouts of inquiries posted on www.untied.com, retrieved on February 25 and 26, 2013.
31. Printout of Roseman, R., "United Airlines fights legal battle with Untied website", *Toronto Star*, November 30, 2012.
32. Printout of "Sticking up for the big guy: United v. Untied.com", *The Legal Satyricon*, retrieved from <http://randazza.wordpress.com/2012/11/29/sticking-up-for-the-big-guy/> on March 11, 2013.

33. Printout of “United Airlines Sues Passenger Complaint Site Untied”, *Techdirt*, retrieved from <http://www.techdirt.com/articles/20121130/03343521182/united-airlines-sues-passenger-...11/03/2013> on May 2, 2013.
34. A bundle of printouts of inquiries submitted to United Airlines, Inc. employees whose direct contact information had been posted by the Defendant on www.untied.com.
35. A copy of a Writ of Summons served upon United Air Lines, Inc., dated September 14, 2012.
36. A printout of a Google search for “United complaints” performed February 25, 2013.
37. A printout of www.untied.com, as it appeared on May 9, 2013.
38. A printout of an inquiry posted on www.untied.com dated April 26, 2013, retrieved on May 8, 2013.
39. A bundle of printouts of web archive documents, each retrieved on June 11, 2013, showing the homepage of www.untied.com as it appeared on September 25, 2011, March 6, 2007, October 12, 1999 and May 26, 1998.
40. A bundle of printouts of web archive documents, each retrieved on June 12, 2013, showing the homepage of United Air Lines, Inc.’s website www.united.com, as it appeared on September 21, 2011, March 5, 2007 and April 7, 2000.

SCHEDULE 2

The following are all of the relevant documents, or bundles of relevant documents, that are or were in the Plaintiff's possession, power or control and for which privilege is claimed:

All correspondence with the Plaintiff's solicitors or between the Plaintiff's solicitors and third parties relating to matters at issue in this action.

SCHEDULE 3

The following are all of the relevant documents, or bundles of relevant documents, that were but are no longer in the Plaintiff's possession, power or control and for which no privilege is claimed:

- Nil -

This is **Exhibit "B"** to the Affidavit of Dr. Jeremy R. Cooperstock
affirmed before me on October 31, 2014

 JEAN-PIERRE ROUSSAIN
AGENT DU GREFFE
REGISTRY OFFICER
Signature

IN THE FEDERAL COURT OF CANADA

FILE NO: T-2084-12

BETWEEN :

UNITED AIRLINES, INC.,

Plaintiff,

- and -

JEREMY COOPERSTOCK,

Defendant.

Examination on Discovery of SCOTT ALBERT WILSON,
taken on OCTOBER 2, 2013 in Montreal, Quebec, Canada.

APPEARANCES :

Me LOUIS BELIVEAU (via Skype) For the Defendant

Me HÉLÈNE D'IORIO/Me LEE A. JOHNSON For the Plaintiff

ALSO PRESENT:

Mr. MIKE HENNING (in-house counsel for United Airlines)

Elizabeth Robinson, Official Court Reporter

1 [Under Advisement]

2
3 BY Me LOUIS BELIVEAU:

4 135. Q. Was United worried about the colour scheme
5 employed in the logo or the webpage layout?

6 Me HÉLÈNE D'IORIO:

7 Yes, we will take that under advisement.
8

9 OBJECTION NO. 19: Was United worried about
10 the colour scheme employed in the logo or the
11 webpage layout? [Under Advisement]
12

13 BY Me LOUIS BELIVEAU:

14 136. Q. Was United worried that this might be
15 infringing on United's trade marks or copyright?

16 Me HÉLÈNE D'IORIO:

17 We will take that under advisement.
18

19 OBJECTION NO. 20: Was United worried that
20 this might be infringing on United's trade
21 marks or copyright? [Under Advisement]
22

23 BY Me LOUIS BELIVEAU:

24 137. Q. I will have to ask some questions, Mr.
25 Wilson, which I know you don't know the answer to,

1 because -- just to get them on the record so that
2 you can answer them as you answer the other ones,
3 so I don't actually expect you to be able to answer
4 these now. Which would be: Did United Airlines
5 protest or communicate its concerns to Dr.
6 Cooperstock in any way? The second one is: Did
7 United contemplate legal action? The third one:
8 Did United instruct counsel to issue a take-down
9 notice? Did United Airlines threaten to sue? Why
10 did United Airlines do nothing about it? Why
11 didn't United Airlines threaten legal action?
12 These are questions which you will be able to
13 answer after you have informed yourself of the
14 previous answers about these two productions.

15 Me HÉLÈNE D'IORIO:

16 We will take those under advisement, but I can
17 tell you without sort of -- I will deal with
18 it afterwards when we answer the questions;
19 certainly some of them are, you are asking for
20 privileged information.

21 Me LOUIS BELIVEAU:

22 Okay, and we will likely end up having a
23 follow-up session if we can't -- well, we will
24 deal with it when we get there.

1 UNDERTAKING NO. 20: To verify whether United
2 Airlines threatened Jeremy Cooperstock with a
3 lawsuit as of or around the 3rd of September
4 2011. [Under Advisement]

5
6 BY Me LOUIS BELIVEAU:

7 179. Q. As a follow-up question, assuming that
8 your answer is going to be no, so it is ridiculous
9 right now, but: Why did United Airlines do nothing
10 about it, and why didn't United Airlines threaten
11 legal action? So, if you could please find out
12 those as well --

13 Mr. JEREMY COOPERSTOCK:

14 Maitre Beliveau, that was why did not United
15 Airlines threaten legal action?

16 Me LOUIS BELIVEAU:

17 That is right. Why did not.

18 Me HÉLÈNE D'IORIO:

19 Okay, we will take that under advisement, both
20 questions.

21 Me LOUIS BELIVEAU:

22 Sorry, my tongue slipped or something.

23
24 OBJECTION NO. 35: Why did United Airlines do
25 nothing about it, and why didn't United

1 Airlines threaten legal action? [Under
2 Advisement]

3
4 BY Me LOUIS BELIVEAU:

5 180. Q. Were there any discussions about this
6 website by United Airlines or Continental or
7 Management?

8 A. Sorry, once again please?

9 181. Q. Do you know if there were any discussions
10 about this website, Untied.com by United Airlines,
11 or it might be at the time Continental or United
12 Management?

13 A. I know that Untied.com was familiar to
14 members of United Airlines, and there have been
15 discussions about Untied.com.

16 182. Q. Moving on, we will move on to another area
17 of questioning.

18 Mr. JEREMY COOPERSTOCK:

19 Maitre Beliveau, I am just wondering if you
20 want to enter into the record, we have
21 Exhibits 16 -- my notes have Exhibit 16 and
22 17.

23 Me LOUIS BELIVEAU:

24 Oh, yes. We didn't enter them into the
25 record? I am sorry.

1 Mr. JEREMY COOPERSTOCK:

2 I just trying to make sure.

3
4 EXHIBIT NO. 16: State of the Untied.com
5 webpage on the 23rd of August 2012.

6
7 BY Me LOUIS BELIVEAU:

8 I beg your pardon, I did skip one. I beg your
9 pardon, Mr. Wilson, I extended the link, two
10 pages stuck together.

11 A. Okay.

12 183. Q. So we are not quite through this process
13 yet.

14 A. Okay.

15 184. Q. We have an Exhibit here, it is the state
16 of the Untied.com webpage on the 23rd of August
17 2012. I would like to ask you some questions about
18 it, please.

19 A. Okay.

20 185. Q. Do you find anything legally objectionable
21 about this exhibit, i.e. the webpage of Untied.com
22 of the 23rd of August 2012?

23 A. Well, at least I am consistent; I wouldn't
24 want to speak to a legal perspective on this.

25 186. Q. Okay, so do you find anything

1 objectionable in any other way?

2 A. If you could help me understand what you
3 mean by 'objectionable', a personal opinion about
4 design, about user experience, about layout?

5 187. Q. From a United Airlines point of view.

6 A. The use of the United Airlines trade marks
7 and copyright.

8 188. Q. Could you point to me, please, where these
9 trade marks and copyright are on this webpage?

10 189. Q. Sure, as they have throughout, the logo at
11 the top, the page layout, the colours, the fonts,
12 the design schema, many of the menus. It is a very
13 close facsimile of United.com.

14 190. Q. Do you find the logo similar to that used
15 by United?

16 Me HÉLÈNE D'IORIO:

17 Just to be clear for the record, given you are
18 not present, when you say 'logo' are you
19 referring to the word 'Untied', or are you
20 referring to the globe design?

21
22 BY Me LOUIS BELIVEAU:

23 I am referring to the frowning face with a
24 sort of circular, a square form around it, and
25 sort of an arc or something above it.

1 A. If you are referring to the use of the
2 United globe as the logo, or the totality of the
3 word 'United' with the United globe?

4 191. Q. For the first part of the question I am
5 referring to the object that is to the right of the
6 word 'Untied'?

7 Me HÉLÈNE D'IORIO:

8 And I believe the witness is referring to that
9 as 'the United globe'.

10
11 BY Me LOUIS BELIVEAU:

12 192. Q. Okay, and I am referring to it as the
13 frowning face; are we talking about the same thing
14 that is roughly square in shape?

15 A. I would ask you to point to it, but
16 unfortunately that is not possible. Maybe Jeremy
17 can do that.

18 193. Q. Dr. Cooperstock, perhaps you could point
19 to it.

20 A. Yes, that is the United globe.

21 194. Q. Okay, well I guess that is what you call
22 it. Do you find it is similar to the United logo?

23 A. It is the United logo. It has a red
24 frowny face and two eyes drawn on top of the United
25 logo, yes.

1 195. Q. Okay, now to the left of it, the word is
2 'Untied'. Are you concerned about those?

3 A. If you are asking me if I think they look
4 similar, yes, I do.

5 196. Q. Okay, in what way do they look similar?

6 A. The colour, the typeface, the separation
7 between the letters is, to me, clearly indicative
8 of the use of the United brand and the trade mark.

9 197. Q. I think there is a sort of blue or black
10 colour maybe, and there is sort of a reddish kind
11 of colour; which of those colours do you find is
12 indicative of the United trade mark?

13 A. The blue.

14 198. Q. The blue. What about the red?

15 A. Well, the red is not an exact copy of
16 United's trade mark.

17 199. Q. Does United use red in its trade mark?

18 A. United has historically used red in its
19 trade mark, and you will actually see that red
20 throughout previous versions of Untied.com, and
21 that red was brought over, it would appear to me,
22 to be on their current.

23 200. Q. As of the 23rd of August 2012 does United
24 use red in its trade mark?

25 A. United does not use red in the trade mark

1 that we are referring to, which is the United brand
2 name.

3 201. Q. Okay, so would it be fair to say that the
4 colours used in the Untied, I don't know what we
5 want to call it, words or logo, this thing on the
6 webpage and the United, what United claims is a
7 trade mark are not the same?

8 A. Let me make sure I am understanding, and I
9 know that Jeremy would understand this as well, you
10 know, if I turn in a homework assignment that I
11 have changed a word or two it is still plagiarism.
12 Yes, I agree that the red is not used in United's
13 trade mark today, but to me this is clearly a use
14 of United's trade mark with minor adjustments that
15 don't sufficiently avoid confusion.

16 202. Q. Okay, let me review. So the word here is
17 'Untied', and there are two red letters in the
18 middle, is that correct?

19 A. Yes.

20 203. Q. Just to verify, would it be fair to say
21 that you find that this is confusingly similar to
22 the words 'United' in blue?

23 Me HÉLÈNE D'IORIO:

24 Mr. Beliveau, I will object to that question.

25 That is a legal question; the test of

1 confusion between trade marks is one for the
2 Court and for expert witnesses.

3
4 OBJECTION NO. 36: Just to verify, would it be
5 fair to say that you find that this is
6 confusingly similar to the words 'United' in
7 blue?

8
9 BY Me LOUIS BELIVEAU:

10 I was just following up on Mr. Wilson's
11 previous statements, and I am just trying to
12 clarify for myself, but we can leave that
13 question for later.

14 204. Q. I would like to confirm that United is not
15 currently using any red colours in its logo?

16 A. If we are talking about the logo that has
17 the word 'United' as shown on Exhibit 14, you are
18 correct, there is no use of the colour red.

19 205. Q. Okay, moving on.

20 Mr. JEREMY COOPERSTOCK:

21 Maitre Beliveau, do you want to request that
22 they make an undertaking to deal with those
23 issues?

24 Me LOUIS BELIVEAU:

25 Yes, please, I would like to request that you

1 undertake to --

2 Me HÉLÈNE D'IORIO:

3 Undertake to do what?

4 Me LOUIS BELIVEAU:

5 To answer the question that wasn't answered.

6 Me HÉLÈNE D'IORIO:

7 Which one was that? I am sorry.

8 Me LOUIS BELIVEAU:

9 Regarding whether there is a similarity.

10 Me HÉLÈNE D'IORIO:

11 I think he answered that question. That

12 question was asked and answered; he pointed

13 out two similarities, but then you went on to

14 ask the question about confusingly similar, so

15 I don't know if you asked a different question

16 after that and maybe I missed it, but I --

17 Me LOUIS BELIVEAU:

18 Okay, fine, perhaps you are correct.

19 Me HÉLÈNE D'IORIO:

20 No, there is no undertaking.

21

22 BY Me LOUIS BELIVEAU:

23 206. Q. Okay, no undertaking. Could you explain

24 to me whether United Airlines protested or

25 communicated its concerns to Dr. Cooperstock in any

1 way as of the 23rd of August 2012?

2 A. At this point I do recall that there had
3 been some communication between Mr. Cooperstock and
4 United.

5 207. Q. Okay, did United contemplate legal action?

6 Me HÉLÈNE D'IORIO:

7 I instruct the witness not to answer that
8 question; that is privileged information, but
9 clearly a lawsuit has been commenced.

10 Me LOUIS BELIVEAU:

11 Yes, I suppose I already know the answer to
12 this one.

13 Me HÉLÈNE D'IORIO:

14 I think you do.

15
16 BY Me LOUIS BELIVEAU:

17 208. Q. Did United instruct counsel to issue a
18 take-down notice?

19 Me HÉLÈNE D'IORIO:

20 I instruct the witness not to answer the
21 question.

22
23 OBJECTION NO. 37: Did United instruct counsel
24 to issue a take-down notice?

1 BY Me LOUIS BELIVEAU:

2 209. Q. Did United Airlines threaten to sue? I
3 think you can answer that question; I mean, we sort
4 of all know the answer, so I will ask it again.
5 Did United Airlines threaten to sue?

6 A. I would only repeat that I know that there
7 is a suit that has been commenced, so --

8 210. Q. Okay. Were there any discussions about
9 this website, this specific version, the 23rd of
10 August 2012 by United Management?

11 A. Yes.

12 211. Q. Could you produce minutes and internal
13 correspondence of the meetings regarding the
14 discussions of Untied.com?

15 Me HÉLÈNE D'IORIO:

16 I refuse to answer that question; it is
17 irrelevant and it is confidential information.

18 Me LOUIS BELIVEAU:

19 I think it is very relevant, so I would like
20 to ask you to undertake to produce the minutes
21 and internal correspondence.

22 Me HÉLÈNE D'IORIO:

23 No, we are refusing to answer that question.

24 Me LOUIS BELIVEAU:

25 Yes, it is a request for undertaking. I don't

1 see what is confidential about it, Maitre
2 D'Iorio. I am not talking about
3 correspondence with you, which would be
4 legally privileged, I am talking about
5 internal discussions.

6 Me HÉLÈNE D'IORIO:

7 I am refusing to answer, and I am instructing
8 the witness not to answer the question. We
9 can debate it at the Motion, Mr. Beliveau.

10
11 UNDERTAKING NO. 21: To produce the minutes
12 and internal correspondence of the meetings of
13 United Airlines management regarding the
14 discussions of Untied.com about the 23rd of
15 August 2012 version of the website. [under
16 objection]

17
18 OBJECTION NO. 38: To Undertaking 21.

19
20 BY Me LOUIS BELIVEAU:

21 212. Q. Okay, we will debate it at the Motion.

22 Moving on -- okay, just one second please, I just
23 need to get my papers in order. Mr. Wilson,
24 regarding previous discussions in 2000 - 2007,
25 previous versions of this webpage, would you be

1 able to obtain for us minutes and internal
2 correspondence at United about the Untied.com
3 website?

4 Me HÉLÈNE D'IORIO:

5 Yes, we are refusing to answer that question
6 as well on the same ground, on the grounds
7 that have already been stated.

8 Me LOUIS BELIVEAU:

9 My understanding is that there was probably no
10 lawsuit, and I am not talking about
11 discussions with counsel, I am strictly
12 talking about internal discussions at the
13 time; you are refusing to produce those?

14 Me HÉLÈNE D'IORIO:

15 That is correct.

16 BY THE COURT REPORTER:

17 So is that an undertaking? Excuse me, excuse
18 me --

19 Me LOUIS BELIVEAU:

20 Could you please state, could you please
21 state, Maitre D'Iorio, since you answered the
22 question for Mr. Wilson, could you please
23 state why you are refusing to produce these?

24 Me HÉLÈNE D'IORIO:

25 Because it is not relevant to any of the

1 issues in the case.

2 Me LOUIS BELIVEAU:

3 Well, I think is very relevant to see why
4 there was a lawsuit now and there wasn't
5 before, and so I would like --

6 Me HÉLÈNE D'IORIO:

7 Well, that will be for you to argue before a
8 Court, Mr. Beliveau, okay?

9 Me LOUIS BELIVEAU:

10 Okay, I guess that is where we are heading.

11 Me HÉLÈNE D'IORIO:

12 Yes.

13 Me LOUIS BELIVEAU:

14 Yes, that was a request for an undertaking to
15 produce minutes from previous years.

16

17 UNDERTAKING NO. 22: To produce minutes and
18 internal correspondence at United Airlines
19 about the Untied.com website. [under
20 objection]

21

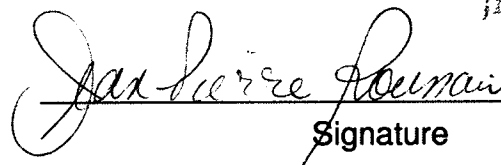
22 OBJECTION NO. 39: To Undertaking 22.

23

24 Me LOUIS BELIVEAU:

25 Well, we are going to move on from this issue,

This is **Exhibit "C"** to the Affidavit of Dr. Jeremy R. Cooperstock
affirmed before me on October 31, 2014


Signature

JEAN-PIERRE ROUSSAIN
AGENT DU GREFFE
REGISTRY OFFICER

Undertaking (taken under Advisement) no.	Transcript page no.	Question	Response
			of mental attitudes; d) calls for a legal interpretation and e) any discussions about infringement of the Plaintiff's rights are subject to solicitor-client privilege.
16	100	To verify if United Airlines protested or communicated its concerns to Dr. Cooperstock in any way in 2007.	No communication was sent to the Defendant in 2007 threatening suit.
Objection no 27 (taken under advisement)	102	Was Mr. Cooperstock issued with the threat of a lawsuit over this page (Exhibit 12)?	No communication was sent to the Defendant threatening suit with respect to the website depicted in Exhibit 12.
Objection no 28 (taken under advisement)	103	Why did United Airlines do nothing about it (Exhibit 12)?	<u>Refused.</u> This information is subject to solicitor-client privilege.
Objection no 29 (taken under advisement)	104	And why didn't United Airlines threaten legal action about it (Exhibit 12)?	<u>Refused.</u> This information is subject to solicitor-client privilege.
17	106	To verify if there is anything that is legally objectionable about the Untied webpage that was presented in September 3, 2011 (Exhibit 15), and if so, provide an explanation.	<u>Refused.</u> The question calls for a legal interpretation.
18	108	To verify if United had concerns about trade mark or copyright issues regarding the Untied.com webpage on September 3,	<u>Refused.</u> United's "concerns" as of 2011 are not relevant to any of the issues pleaded, the question is vague because the meaning of "concerns" cannot be ascertained and witness cannot be asked to express his

Undertaking (taken under Advisement) no.	Transcript page no.	Question	Response
		2011 (Exhibit 15).	position in terms of mental attitudes.
Objection no 30 (taken under advisement)	108	Was United concerned about the word "Untied" or the font (as depicted on the Untied.com webpage on September 3, 2011 (Exhibit 15))?	Refused. a) United's "concerns" as of 2011 are not relevant to any of the issues pleaded, b) the question is vague because the meaning of "concerned" cannot be ascertained, c) witness cannot be asked to express his position in terms of mental attitudes and d) any discussions about infringement of the Plaintiff's rights are subject to solicitor-client privilege.
Objection no 31 (taken under advisement)	109	Was United worried about the colour scheme employed in the logo, or the webpage layout (as depicted on the Untied.com webpage on September 3, 2011 (Exhibit 15))?	Refused. Whether United was "worried" as of 2011 is not relevant to any of the issues pleaded, the question is vague because the meaning of "worried" cannot be ascertained, the witness cannot be asked to express his position in terms of mental attitudes and any discussions about infringement of the Plaintiff's rights are subject to solicitor-client privilege.
Objection no 32 (taken under advisement)	109	Was United worried that the Untied.com webpage on September 3, 2011 might be infringing on United's trade-marks or copyright?	Refused. Whether United was "worried" as of 2011 is a) not relevant to any of the issues pleaded; b) the question is vague because the meaning of "worried" cannot be ascertained; c) witness cannot be asked to express his position in terms of mental attitudes; d) calls for a legal opinion and e) any discussions about infringement of the Plaintiff's rights are subject to solicitor-client privilege.
19	110	To verify if United Airlines protested or	No communication was sent to the Defendant threatening suit with

Undertaking (taken under Advisement) no.	Transcript page no.	Question	Response
		communicated any concerns to Dr. Cooperstock in any way around September 3, 2011.	respect to the website depicted in Exhibit 15.
20	112	To verify whether United Airlines threatened Jeremy Cooperstock with a lawsuit as of or around the 3rd of September 2011.	No communication was sent to the Defendant threatening suit in September 2011.
Objection no 35 (taken under advisement)	112	(Assuming that it did not) Why did United Airlines not do nothing about (the website as it appeared in Exhibit 15), and why didn't United Airlines threaten legal action?	Refused. This information is subject to solicitor-client privilege.
Objection no 43 (taken under advisement)	137	Advise as to why the Google rankings were relevant to include into United's productions (Exhibit 17)?	The Google rankings are relevant to the issue of likelihood of confusion.
32	173	To indicate what address Exhibit 21 was re-sent to.	It is impossible to ascertain this information and the question is in any event, not relevant to the issues pleaded.
36	194	To indicate how many complaints were forwarded via and from Untied.com to Ms. Harvill and Mr. Goodwin at United Airlines between October 1998 and September 2000.	Refused. This question is not relevant to any of the issues pleaded and in any event the Plaintiff cannot ascertain this information.
38	198	To verify what the email address customercare@united.com	This email address was used as a channel for United's customers to

Refusal no.	Transcript page no.	Question	Response
		was provided to the media by Tony Molinaro, or others within United Airlines?	issues pleaded.
15	82	As United Airlines, do you see any trade mark or copyright objections to this webpage as it now stands?	Refused. The question calls for a legal interpretation and requires expert opinion.
16	83	Do you agree that the phrase 'the most unfriendly skies' qualifies as disparaging United's alleged 'friendly skies' trade-marks?	Refused. The question requires a legal interpretation. In any event, this question is not relevant to any of the issues pleaded.
17-24	[NOT REFUSALS — QUESTIONS TAKEN UNDER ADVISEMENT]		
25	101	Did United contemplate legal action?	Refused. This information is subject to solicitor-client privilege.
26	101	Did United instruct counsel to issue a take-down notice?	Refused. This information is subject to solicitor-client privilege.
27-32	[NOT REFUSALS — QUESTIONS TAKEN UNDER ADVISEMENT]		
33	111	Did United contemplate legal action?	Refused. This information is subject to solicitor-client privilege.
34	111	Did United instruct counsel to issue a take-down notice?	Refused. This information is subject to solicitor-client privilege.
35	[NOT REFUSAL]		
36	119	Just to verify, would it be fair to say that you find that this is confusingly similar to the words "United" in blue?	Refused. The question requires a legal interpretation.

Refusal no.	Transcript page no.	Question	Response
37	121	United instruct counsel to issue a take-down notice?	Refused. This information is subject to solicitor-client privilege.
38	123	To produce the minutes and internal correspondence of the meetings of United Airlines management regarding the discussions of Untied.com about the 23rd of August 2012 version of the website.	Refused. This information is subject to solicitor-client privilege and is not relevant to the issues pleaded.
39	124	To produce minutes and internal correspondence at United Airlines about the Untied.com website.	Refused. This information is subject to solicitor-client privilege and is not relevant to the issues pleaded.
40	133	Did United sue, or contemplate suing Frommers or Trip Advisor for having their Google search result for "united complaints" ahead of United?	Refused. Whether United contemplated suing is subject to solicitor-client privilege. United did not in fact sue Frommers or TripAdvisor.
41	135	Confirm whether United ever contemplated suing Google over the search results rankings.	Refused. This information is not relevant to the issues pleaded and is subject to solicitor-client privilege. United did not in fact sue Google.
42	136	Were there any internal discussions held about doing something relating to this ranking for the Google search "united complaints", and wanting perhaps United Airlines' own site to show up first?	Refused. This information is not relevant to the issues pleaded.
43	[NOT REFUSAL]		
45	139	Did United contact Google, or purchase	Refused. Not relevant to any of the

This is **Exhibit "D"** to the Affidavit of Dr. Jeremy R. Cooperstock
affirmed before me on October 31, 2014


Signature

JEAN-PIERRE ROUSSAIN
AGENT DU GREFFE
REGISTRY OFFICER

Subject: Re: Voice Message from 757-463-5534 on 6/16/12 12:51 PM for 49351
From: Wittig, Jeff </O=COAIR/OU=NORTH AMERICA/CN=RECIPIENTS/CN=COA8142>
Date: 2012-06-16, 4:11 PM
To: Rodriguez, Sandy <sandy.rodriguez@united.com>

Thanks, Sandy. We're working on shutting it down.

From: Rodriguez, Sandy
Sent: Saturday, June 16, 2012 02:03 PM
To: Wittig, Jeff
Subject: Re: Voice Message from 757-463-5534 on 6/16/12 12:51 PM for 49351

Jeff

Again, will do my best. Its difficult to give you a name in Res because we have minimum coverage on weekends.

I'm working with NHC Ops to see who is on duty and can assist. This is not a Res situation rather a BRC issue. I know its difficult for you to assess where it goes, so for the time being just forward to me.

We really need that United site to be closed. Its creating more problems.

Thanks

Sandy

From: Wittig, Jeff
Sent: Saturday, June 16, 2012 01:30 PM
To: Rodriguez, Sandy
Subject: Fw: Voice Message from 757-463-5534 on 6/16/12 12:51 PM for 49351

Sandy,
Here is another one. If you let me know who to send it to in Res, I can send these messages to them directly.
Thanks,
Jeff

From: evm@coair.com [<mailto:evm@coair.com>]
Sent: Saturday, June 16, 2012 12:52 PM
To: Wittig, Jeff
Subject: Voice Message from 757-463-5534 on 6/16/12 12:51 PM for 49351

Voice Message from 757-463-5534 on 6/16/12 12:51 PM

Attachment(s):
* Voice Message (60 sec)

Delete this message from my Voice Mailbox

<<http://10.192.231.91:88//deletemsgrt.asp?SysID=1&Mailbox=49351&CCM=22032&MsgDT=6%2F16%2F2012%2012%3A51%3A56%20PM&CS=50675>>

Mark this message read in my Voice Mailbox

<<http://10.192.231.91:88//markreadrt.asp?SysID=1&Mailbox=49351&CCM=22032&CS=50675>>

Delete this and older messages from my Voice Mailbox

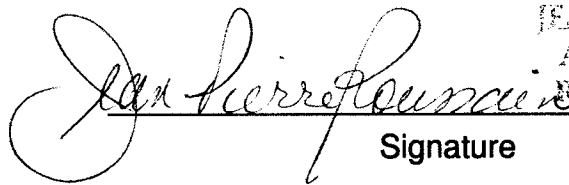
<<http://10.192.231.91:88//deletemsgallrt.asp?SysID=1&Mailbox=49351&CCM=A22032&MsgDT=6%2F16%2F2012%2012%3A51%3A56%20PM&CS=50675>>

View/Edit my EVM Settings

<<http://10.192.231.91:88//evmredir.asp?SysID=1&Subscriber=49351>>

Mailbox currently contains 2 New and 7 Old messages.

This is **Exhibit "E"** to the Affidavit of Dr. Jeremy R. Cooperstock
affirmed before me on October 31, 2014

A handwritten signature in cursive script, reading "Jean-Pierre Roussain", written over a horizontal line.

JEAN-PIERRE ROUSSAIN
AGENT DU GREFFE
REGISTRY OFFICER

Signature

CANADA

SUPERIOR COURT

(Civil Division)

**PROVINCE OF QUEBEC
DISTRICT OF MONTREAL**

UNITED AIRLINES, INC.

and

JESSICA ROSSMAN

and

JEFF WITTIG

Plaintiffs

vs.

DR. JEREMY COOPERSTOCK

Defendant

No: 500-17-074743-124

STATEMENT OF DEFENCE

1. The Defendant has no knowledge of the allegations contained in paragraphs 1-3, and paragraphs 25-27 of the Amended Introductory Motion for the Issuance of a Permanent Injunction.
2. The Defendant admits the allegations contained in the first sentence of paragraph 4, paragraph 5, the first sentence of paragraph 6, the first sentence of paragraph 8, the first two sentences of paragraph 13, the first three sentences of paragraph 19, and paragraphs 31-36 to the extent that they document the timeline of correspondence, of the Amended Introductory Motion.
3. Contrary to what is stated in paragraph 22 of the Amended Introductory Motion, a substantial portion of the correspondence received by Individual Plaintiffs came from attorneys, investigators, law courts, employment records offices, law

- 2 -

enforcement, government, or health officials, or United Airlines employees, and passengers bringing legal claims against the Airline Plaintiff.

4. With the exception of those sentences identified above, the allegations contained in paragraphs 10-15 of the Amended Introductory Motion, which the Defendant denies, are immaterial and duplicative of almost identical claims made in a parallel action brought by the Plaintiffs in the Federal Court. Pursuant to Rule 168 of the *Code of Civil Procedure*, the Defendant asks that the Court strike out these allegations.
5. The Defendant admits that the Airline Plaintiffs have initiated proceedings against Defendant before the Federal Court of Canada, as described in paragraph 16 of the Amended Introductory Motion, but denies the premise of this paragraph.
6. The Defendant denies the improper allegations contained in paragraphs 24, 28, 29, and 30 of the Amended Introductory Motion. None of the Plaintiffs have received threatening correspondence. The Individual Plaintiffs received correspondence that could arguably be harassing from a disturbed individual, Mr. Dave Clark, and from an additional individual, Mr. Ron Goodson.
7. The Plaintiffs have conceded that the Defendant is not responsible for the actions of disturbed individuals including Mr. Clark (**Exhibit D-1**). Therefore, the Defendant asks the court to strike out the immaterial allegations of paragraphs 24-28 of the Amended Introductory Motion pursuant to Rule 168 of the *Code of Civil Procedure*.
8. All other allegations of fact that are not admitted are deemed to be denied.

BACKGROUND: THE AIRLINE PLAINTIFF AVOIDS PAYING ITS DEBTS TO PASSENGERS

9. The background to this proceeding is the practice of the Airline Plaintiff to evade its responsibility of compensating or refunding passengers to whom it owes debts in accordance with government regulations, international conventions, and its own contract of carriage.

- 3 -

10. For example, on August 4, 2011, the Airline Plaintiff was assessed a civil penalty of \$20,000 for failing to provide proper disclosures regarding baggage liability limits under Article 22 of the Montreal Convention, and ordered to cease and desist from future violations of 49 U.S.C. §41712 (**Exhibit D-2**).
11. More recently, on August 30, 2013, the Airline Plaintiff was assessed a civil penalty of \$350,000 for failing, inter alia, to process consumer refund requests in a timely manner as required by the Consumer Credit Protection Act and Regulation Z of the Board of Governors of the Federal Reserve System, 15 U.S.C. §§1601-1693r and 12 CFR Part 226, and ordered to cease and desist from future similar violations (**Exhibit D-3**).
12. The Airline Plaintiff does not provide on its website an email address or telephone number through which passengers can communicate directly with airline representatives for the purpose of obtaining refunds or collection of other debts, nor does it provide a mailing address for the service of legal correspondence or subpoenas.
13. Calls placed to telephone numbers of the Airline Plaintiff associated with reporting damaged, delayed, or lost baggage often entail long waiting times, automated replies, or communication with call center agents who cannot understand English-speaking passengers (**Exhibits D-4–D-6**).
14. Inquiries submitted through the Airline Plaintiff's web site are often ignored, replied to only after extensive delays, or answered with form-letter responses that fail to address the passengers' demands, necessitating follow-up escalation.
15. The Airline Plaintiff frustrates and obstructs escalation attempts by passengers who are dissatisfied with the initial response(s) they receive to their inquiries, complaints, and attempts to collect debts, as illustrated by the example correspondence produced herewith, *en liasse*, as **Exhibit D-7**.
16. In several instances, passengers who were unable to resolve their situation with

- 4 -

the Airline Plaintiff's "Customer Care" department finally obtained substantive responses after escalating their issue to the attention of the Individual Plaintiffs, who, as senior counsel for the airline, were able to influence the outcome either directly or indirectly.

17. As explained below, a substantial portion of the correspondence received by the Individual Plaintiffs refers to refunds or reimbursement.

THE MERGER BETWEEN UNITED AIR LINES AND CONTINENTAL AIRLINES

18. On October 1, 2010, United Air Lines and Continental Airlines announced the "successful" completion of their merger into a single airline. The process of integrating the operations of the two airlines into a single entity was estimated to be complete in the first quarter of 2012 (**Exhibit D-8**).
19. As a result of the problems arising from the integration process of these previously separate airlines, the number of passenger complaints filed against the Airline Plaintiff escalated dramatically, increasing by more than 250% between 2010 and 2012 (**Exhibit D-9**).
20. The increase in customer complaints over this period made the Airline Plaintiff the most complained-about U.S. airline, and added further stress to an already inadequate "customer care" process, resulting in refunds not being processed in a timely manner (**Exhibit D-3**), and creating additional passenger frustration directed toward the Airline Plaintiff.

THE DEFENDANT'S ACTIVITIES

21. The Defendant, Dr. Jeremy Cooperstock, is a full-time, tenured, associate professor of electrical and computer engineering at McGill University.
22. Since 1997, the Defendant has been maintaining the web site Untied.com, which uses parody and satire to expose the poor service by the Airline Plaintiff, as

- 5 -

a consumer rights advocacy resource for passengers and employees of United Airlines. Through this non-profit activity, the Defendant helps passengers and mistreated employees to enforce their legal rights and to obtain remedy in a timely manner.

23. The Defendant provides on his web site numerous resources to passengers and employees of Airline Plaintiff, including:

23.1 a publicly viewable database of over 25,000 complaints (**Exhibit D-10**);

23.2 information concerning the legal rights of passengers (**Exhibit D-11**);

23.3 information concerning the legal rights of employees (**Exhibit D-12**);

23.4 details of Airline Plaintiff's mistreatment of its employees (**Exhibit D-13**);

23.5 decisions of the Canadian Transportation Agency (**Exhibit D-14**); and

23.6 an analysis of safety concerns of Plaintiff's operations (**Exhibit D-15**).

24. In light of the growing number of complaints against the Airline Plaintiff involving legal claims, refunds, and unpaid compensation, the Defendant's not-for-profit activities have increasingly focused on assisting passengers in the collection of their debts and upholding their rights.

THE DEFENDANT HAS ACTED RESPONSIBLY AND LAWFULLY

25. Individual Plaintiffs' names and workplace contact information are publicly available and accessible worldwide on numerous web sites, other than the web site maintained by the Defendant (**Exhibit D-16**).

26. The Defendant re-posts on his web site the publicly available workplace contact information for certain senior employees and officers of Airline Plaintiff as a service to passengers and attorneys who have a need to contact the Airline Plaintiff in relation to their claims (**Exhibit D-17**).

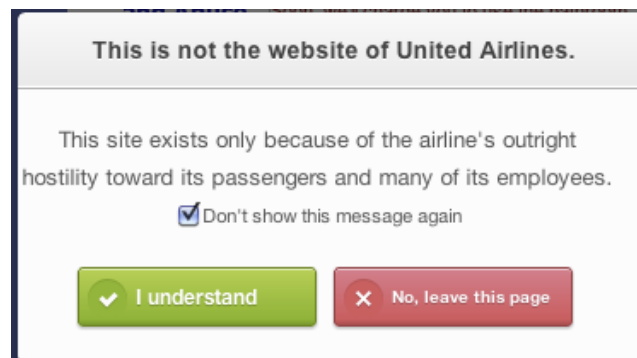
- 6 -

27. The title and function, work address, workplace and telephone number of an employee acting on behalf of a company is not personal information, and Plaintiffs admit that this information of its senior employees is not confidential information. Defendant has therefore lawfully re-posted information which is neither personal information nor confidential information.
28. The Defendant strongly discourages readers from using the workplace contact information of United Airlines' senior personnel for improper purposes with the following disclaimer, reproduced from **Exhibit D-17**:

Note that Untied.com strongly discourages readers from using the contact information provided below to harass or intimidate the management or other personnel at United Airlines. The addresses, emails, and telephone numbers are provided only as a means to facilitate more efficient communication between you and those in the airline with the decision-making authority to help resolve your problem.

29. Contrary to what is alleged, the Defendant clearly and unambiguously distinguishes his web site from the Plaintiffs' web site:

- 29.1 A pop-up dialog requires first-time visitors to acknowledge that they understand that Untied.com is not the website of the Plaintiffs:



- 29.2 A disclaimer at the top of every page reads "(This is **not** the web page of United Airlines)".

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29.3 The logo displayed on Untied.com uses a red font color for the letters "TI" and a red pixel color for the frown:



30. On August 11, 2014, shortly after it was revealed that Individual Plaintiff Jeff Wittig no longer acts as Senior Counsel, Asia and Pacific, the Defendant updated his web site to remove Mr. Wittig's workplace contact information (**Exhibit D-25**).

NO HARASSING OR THREATENING COMMUNICATIONS

31. Individual Plaintiffs have not received any allegedly threatening e-mails or voicemails at their homes (**Exhibit D-18, P 104**).
32. With the possible exception of the voice mail messages left by a single disturbed individual, Mr. Clark, for which Plaintiffs conceded that the Defendant is not responsible (**Exhibit D-1**), and one email message from Mr. Goodson, who refers to "Jessica Rosslyn" as "an idiot" (**Exhibit D-19**), none of the communications received by Individual Plaintiffs can be considered harassing.
33. Indeed, Individual Plaintiff Jessica Rossman admitted that the content of the e-mail she receives is not harassing (**Exhibit D-18, P 105-112**).
34. Ms. Rossman has been making light of the voice mails received from Mr. Clark (**Exhibit D-20**), which demonstrates that her claims to have suffered tremendous emotional and physical distress are baseless.
35. Even if the entirety of the e-mails alleged by Ms. Rossman as being "professional harassment" were due to the Defendant's website, which is denied, this accounts for at most 1-2% of the e-mail that she receives each day (**Exhibit D-18, P 102**).

- 8 -

COMMUNICATIONS TO INDIVIDUAL PLAINTIFFS ARE LEGITIMATE

36. The Defendant holds Plaintiffs to the full burden of proof to demonstrate that the attorneys, law enforcement officers, public health officials, travel agencies, records offices, passengers, and other individuals who contacted Individual Plaintiffs:
 - 36.1 obtained their contact information from the Defendant's web site; and
 - 36.2 made communications that were unrelated to the Individual Plaintiffs' professional competencies and/or responsibilities as senior legal counsel for United Airlines.
37. As summarized in **Exhibit D-21**, of the approximately 287 email communications identified by Individual Plaintiff Jeff Wittig as allegedly harassing correspondence, received between October 1, 2012 and July 31, 2014:
 - 37.1 at least 89 of these communications relate to lawyers, claims, or subpoenas against United Airlines;
 - 37.2 approximately 90 of these communications were addressed to additional United recipients whose contact information did not appear on Untied.com, and thus, were obtained from other sources than Untied.com; and
 - 37.3 only 3 of the senders mention the Defendant's website.
38. As summarized in **Exhibit D-21**, of the approximately 465 email communications identified by Individual Plaintiff Jessica Rossman as allegedly harassing correspondence, received between October 1, 2012 and July 31, 2014:
 - 38.1 at least 146 of these communications relate to lawyers, claims, or subpoenas against United Airlines;
 - 38.2 approximately 136 of these communications were addressed to additional United recipients whose contact information did not appear on Untied.com,

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and thus, were obtained from other sources than Untied.com; and

38.3 only 2 of the senders mention the Defendant's website.

39. As summarized in **Exhibit D-22**, of the approximately 77 voice mails identified by Individual Plaintiff Jeff Wittig as allegedly harassing communications, received between October 1, 2012 and July 31, 2014:

39.1 approximately 8 were calls from attorneys, law enforcement, government departments, health officials, or records offices; and

39.2 1 was a call from another United Airlines employee.

40. As summarized in **Exhibit D-22**, of the approximately 133 voice mails identified by Individual Plaintiff Jessica Rossman as allegedly harassing communications, received between October 1, 2012 and July 31, 2014:

40.1 approximately 34 were calls from attorneys, law enforcement, government departments, health officials, or records offices; and

40.2 2 were calls from other United Airlines employees or their family members.

NO GROUNDS FOR SEEKING AN INJUNCTION

41. The Defendant is engaged in legitimate activity to assist passengers of Airline Plaintiff in enforcing their legal rights, including collecting refunds and other debts owed to them by the Airline Plaintiff.

42. Plaintiffs have not alleged any defamation on the part of the Defendant.

43. Even if some correspondents obtained the workplace contact information for the Individual Plaintiffs from the Defendant's web site, the Defendant is not responsible for the actions of these third parties.

44. If there were any harassment of the Individual Plaintiffs, which is denied, this is due

- 10 -

to the Airline Plaintiff making it onerously difficult and frustrating for passengers to contact a representative of the Airline Plaintiff with the decision-making authority to help them obtain refunds, collect debts owed, or resolve other issues.

45. Therefore, there are no grounds whatsoever to justify Plaintiffs' seeking of an injunction.

AMICABLE EFFORTS TO RESOLVE DISPUTE

46. Between September 25 and October 12, 2012, the Defendant twice indicated his willingness to meet with the Plaintiffs to discuss their concerns, as proposed by Mr. Mike Henning, the Plaintiff Airline's Managing Counsel for Litigation and Intellectual Property (**Exhibit D-23**). However, instead of meeting with the Defendant, the Plaintiffs initiated two parallel legal proceedings against the Defendant.
47. On June 22, 2014, the Defendant proposed a good faith settlement offer, and clarified the details of this offer on June 25, 2014 (**Exhibit D-24**), which the Plaintiffs summarily rejected.
48. As recently as August 11, 2014, the Defendant reiterated his good faith offer of settlement (**Exhibit D-25**), which the Plaintiffs again summarily rejected.

THE PLAINTIFFS' ACTION IS A SLAPP

49. The materials of **Exhibits D-10–D-15** from Defendant's web site are critical of Airline Plaintiff's conduct, embarrassing to Airline Plaintiff, and have encouraged numerous passenger and employee lawsuits against Airline Plaintiff.
50. Plaintiffs commenced legal proceedings against Defendant for the purpose of shutting down the Defendant's web site (**Exhibit D-26**). The present action serves the purpose of creating a chilling effect, and interfering with Defendant's ability to engage in free speech and continue to expose egregious behaviour of Plaintiff United.

- 11 -

51. Despite its critical relevance to Defendant's motion to dismiss of Plaintiffs' action under article 54.1, on which the Honourable Justice Micheline Perrault ruled on June 3, 2014, the e-mail of **Exhibit D-26**, admitting that Plaintiffs were "working on shutting [the Defendant's web site] down", was withheld by Plaintiffs until August 7, 2014.
52. Plaintiffs' refusal to accept the Defendant's reasonable settlement proposal (**Exhibits D-24 and D-25**) further demonstrates that the true purpose of the present action is to shut down the Defendant's web site altogether, and not to seek remedy for any alleged harassment of employees.
53. The Defendant is therefore entitled to request that the action be declared improper, and be dismissed.

FOR THESE REASONS, MAY IT PLEASE THE COURT:

DISMISS Plaintiffs' action;

THE WHOLE with costs.

WESTMOUNT, September 11, 2014

Dr. Jeremy Cooperstock
Defendant

LIST OF EXHIBITS

- Exhibit D-1:** Excerpt of transcript of hearing before Justice Casgrain, February 15, 2013
- Exhibit D-2:** Consent Order OST 2011-8-7 of the US Department of Transportation, served August 4, 2011
- Exhibit D-3:** Consent Order OST 2013-8-27 of the US Department of Transportation, served August 30, 2013
- Exhibit D-4:** Email from passenger Robert Lintz to United Airlines' representatives, dated February 2, 2014
- Exhibit D-5:** Email from passenger David Warren to United Airlines' representatives, dated June 12, 2014
- Exhibit D-6:** Email from passenger Dr. Ernest Bordini to Jessica Rossman, dated June 17, 2014
- Exhibit D-7:** Thread of passenger email with representatives of United Airlines, between June 13, 2012 and March 13, 2013
- Exhibit D-8:** United Hub news regarding merger between United and Continental, dated October 1, 2010 and December 9, 2011
- Exhibit D-9:** Excerpts of Air Travel Consumer Report of the U.S. Aviation Consumer Protection Division, summarizing complaints against U.S. Airlines for calendar years 2010-2012
- Exhibit D-10:** Passenger complaints statistics against United Airlines, retrieved August 30, 2014

- Exhibit D-11:** Untied.com information concerning legal rights of passengers, retrieved August 30, 2014
- Exhibit D-12:** Untied.com information concerning legal rights of employees, retrieved August 30, 2014
- Exhibit D-13:** Untied.com information concerning employee lawsuits against United Airlines, retrieved August 30, 2014
- Exhibit D-14:** Untied.com information on regulatory decisions, retrieved August 30, 2014
- Exhibit D-15:** Untied.com information on safety concerns, retrieved August 30, 2014
- Exhibit D-16:** Third party websites providing contact information for Individual Plaintiffs, retrieved December 18, 2012
- Exhibit D-17:** Untied.com listing of contacts at United Air Lines, retrieved August 30, 2014
- Exhibit D-18:** Excerpts of transcript of examination before plea of Ms. Jessica Rossman, dated August 7, 2014
- Exhibit D-19:** E-mail from Mr. Ron Goodson, dated March 28, 2014
- Exhibit D-20:** Thread of e-mails concerning voice message from Dave Clark, dated April 10, 2013
- Exhibit D-21:** Summary of allegedly harassing email correspondence received by Individual Plaintiffs between October 1, 2012 and July 31, 2014
- Exhibit D-22:** Summary of allegedly harassing voice mail correspondence received by Individual Plaintiffs between October 1, 2012 and July 31, 2014

- Exhibit D-23:** Defendant's email to Mr. Mike Henning between September 25 and October 12, 2012
- Exhibit D-24:** Defendant's correspondence with Plaintiff's counsel, Me Mark Bantey, between June 11 and June 27, 2014
- Exhibit D-25:** Defendant's correspondence with Plaintiff's counsel, Me Mark Bantey, dated August 11, 2014
- Exhibit D-26:** E-mail from Jeff Wittig to Sandy Rodriguez, dated June 16, 2012

Subject: Re: Voice Message from 757-463-5534 on 6/16/12 12:51 PM for 49351
From: Wittig, Jeff </O=COAIR/OU=NORTH AMERICA/CN=RECIPIENTS/CN=COA8142>
Date: 2012-06-16, 4:11 PM
To: Rodriguez, Sandy <sandy.rodriguez@united.com>

Thanks, Sandy. We're working on shutting it down.

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Subject: Re: Voice Message from 757-463-5534 on 6/16/12 12:51 PM for 49351

Jeff

Again, will do my best. Its difficult to give you a name in Res because we have minimum coverage on weekends.

I'm working with NHC Ops to see who is on duty and can assist. This is not a Res situation rather a BRC issue. I know its difficult for you to assess where it goes, so for the time being just forward to me.

We really need that United site to be closed. Its creating more problems.

Thanks

Sandy

From: Wittig, Jeff
Sent: Saturday, June 16, 2012 01:30 PM
To: Rodriguez, Sandy
Subject: Fw: Voice Message from 757-463-5534 on 6/16/12 12:51 PM for 49351

Sandy,
Here is another one. If you let me know who to send it to in Res, I can send these messages to them directly.
Thanks,
Jeff

From: evm@coair.com [<mailto:evm@coair.com>]
Sent: Saturday, June 16, 2012 12:52 PM
To: Wittig, Jeff
Subject: Voice Message from 757-463-5534 on 6/16/12 12:51 PM for 49351

Voice Message from 757-463-5534 on 6/16/12 12:51 PM

Attachment(s):
* Voice Message (60 sec)

Delete this message from my Voice Mailbox

<<http://10.192.231.91:88//deletemsgrt.asp?SysID=1&Mailbox=49351&CCM=22032&MsgDT=6%2F16%2F2012%2012%3A51%3A56%20PM&CS=50675>>

Mark this message read in my Voice Mailbox

<<http://10.192.231.91:88//markreadrt.asp?SysID=1&Mailbox=49351&CCM=22032&CS=50675>>

Delete this and older messages from my Voice Mailbox

<<http://10.192.231.91:88//deletemsgallrt.asp?SysID=1&Mailbox=49351&CCM=A22032&MsgDT=6%2F16%2F2012%2012%3A51%3A56%20PM&CS=50675>>

View/Edit my EVM Settings

<<http://10.192.231.91:88//evmredir.asp?SysID=1&Subscriber=49351>>

Mailbox currently contains 2 New and 7 Old messages.

This is **Exhibit "F"** to the Affidavit of Dr. Jeremy R. Cooperstock
affirmed before me on October 31, 2014

A handwritten signature in cursive script, reading "Jean-Pierre Roussain", is written over a horizontal line.

JEAN-PIERRE ROUSSAIN
AGENT DU GREFFE
REGISTRY OFFICER

Signature

Dr. Jeremy Cooperstock
392 Grosvenor Avenue
Westmount, QC H3Z 2M2

jcooperstock@gmail.com

September 12, 2014

VIA EMAIL

Me Hélène D'Iorio
Gowling Lafleur Henderson LLP
1 Place Ville Marie, 37th Floor
Montréal, QC HJ8 JP4

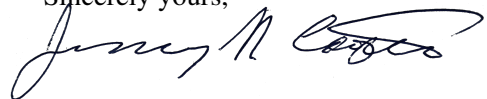
Dear Me D'Iorio :

Re: United Airlines, Inc. v. Jeremy Cooperstock
Federal Court File No.: T-2084-12
Updates to Affidavit of Documents

Please find attached my Supplemental Affidavit of Documents. For clarity, I have indicated all changes that are subsequent to the Further Revised Affidavit of Documents of August 8, 2013. I am also including below the associated updated table of concordance (Table 1).

I request that you kindly update Plaintiff's affidavit of documents, and send the updated version to me no later than September 19, 2014.

Sincerely yours,



Dr. Jeremy Cooperstock

September 12, 2014
Page 2 of 10

Table 1: Concordance table between CD contents (and files subsequently sent by email) and supplemental affidavit of documents of September 11, 2014

file on CD (or via email)	corres-ponding entry in affidavit of documents
1	1
2	2
3	3
4	11
5	56
6	4
7	18
8	19
9–10, 12–16, 26, 75, 129, 190, 208, 250, 286, 318, 362, 412, 467, 534, 611, 663, 712, 748, 803, 846, 896, 958, 1052, 1138, 1241, 1282, 1337, 1358, 1398, 1432, 1457, 1488, 1517, 1533, 1568, 1613, 1648, 1666, 1697, 1741, 1757, 1800, 1823, 1854, 1882, 1915, 1957–1958, 1995, 2017, 2035, 2054, 2082, 2106, 2135, 2162, 2183, 2203, 2236, 2283, 2294, 2299, 2334, 2360, 2404, 2457, 2479, 2514, 2555, 2590, 2640, 2671, 2751, 2817, 2858, 2899, 2948, 3052, 3125, 3216, 3317, 3438, 3550, 3675, 3874, 3973, 4053, 4155, 4316, 4505, 4621, 4728, 4869, 4983, 5121, 5304, 5425, 5491, 5571, 5627, 5714, 5812, 5924, 6030, 6141, 6247, 6369, 6497, 6612, 6673, 6754, 6810, 6862, 6938, 7007, 7072, 7127, 7182, 7245, 7312, 7378, 7440, 7492, 7529, 7585, 7645, 7699, 7760, 7815, 7881, 7956, 8029, 8104, 8148, 8202, 8261, 8326, 8388, 8442, 8526, 8590, 8646, 8721, 8785, 8849, 8881, 8924, 8956, 8983, 9031, 9062, 9101, 9146, 9199, 9327, 9439, 9547, 9618, 9695, 9751, 9797, 9880, 9956, 10181, 10366, 10488, 10666, 10917, 11258, 11496, 11647, 11725, 11745, 11770, 11772, 11776, 11781	54
Continued on next page	

September 12, 2014
Page 3 of 10

Table 1 – continued from previous page

file on CD (or via email)	corres- ponding entry in affidavit of docu- ments
11, 47, 84, 92–93, 179, 196, 203, 557, 808–810, 813, 857, 912–913, 935, 970, 981, 1002, 1191, 1305, 1310–1312, 1364, 1433, 1435, 1438–1439, 1458–1459, 1494, 1659, 1731, 1789, 1852, 1905, 1913–1914, 1920, 1960, 2007, 2009, 2011, 2013–2014, 2043–2044, 2048, 2112–2113, 2116, 2123, 2152, 2154, 2175–2176, 2200, 2209, 2225, 2227, 2273, 2279, 2293, 2296, 2314, 2319, 2356–2357, 2369, 2388, 2392, 2464, 2497, 2531, 2540, 2577, 2591, 2593, 2597–2598, 2601–2602, 2605–2609, 2611, 2614, 2622–2623, 2627, 2630–2635, 2637–2639, 2641–2670, 2681, 2690, 2693, 2697–2699, 2705, 2708, 2710–2712, 2715, 2718, 2722, 2724, 2728, 2730, 2732, 2734, 2736–2739, 2743, 2745–2746, 2748–2750, 2752, 2754, 2760, 2765, 2768, 2773–2775, 2777, 2780, 2784–2785, 2789–2790, 2793–2795, 2797, 2800– 2802, 2805–2806, 2808, 2810, 2812–2813, 2818, 2829–2830, 2832–2835, 2843–2845, 2849–2852, 2855–2857, 2873, 2877, 2880–2881, 2884–2885, 2887–2890, 2893–2894, 2911, 2916, 2919, 2922–2923, 2925, 2985, 2991– 2992, 2997, 3003, 3008, 3018–3019, 3023, 3025–3026, 3029, 3034, 3038, 3041, 3043–3044, 3057, 3062–3066, 3068, 3070, 3073–3074, 3078, 3081, 3084, 3092–3093, 3096, 3099–3100, 3103, 3115, 3118–3119, 3126–3127, 3130, 3134–3139, 3141, 3145, 3151, 3154–3155, 3157–3158, 3161, 3164, 3168–3169, 3176, 3182, 3184, 3186–3188, 3190, 3195, 3200, 3203, 3209, 3211, 3217, 3221–3222, 3224, 3228–3229, 3233, 3239–3240, 3244–3245, 3249, 3252, 3257, 3260–3261, 3264–3265, 3269–3270, 3272–3273, 3279, 3282, 3287, 3291–3292, 3294, 3303, 3305, 3312, 3316, 3328–3329, 3332, 3334, 3336–3337, 3346–3347, 3358–3359, 3363, 3365–3367, 3373, 3381, 3387–3388, 3395–3396, 3400–3401, 3404, 3411–3412, 3417–3418, 3427, 3431, 3441–3443, 3446, 3449, 3451, 3456, 3461, 3465–3467, 3471, 3477– 3478, 3482, 3488, 3492, 3497, 3499, 3504–3506, 3509, 3513, 3516, 3520– 3521, 3526–3527, 3535, 3541, 3544, 3551–3552, 3557, 3562–3563, 3570– 3571, 3576–3577, 3581–3583, 3586, 3589, 3602–3604, 3608–3609, 3611, 3614, 3617, 3626, 3629–3630, 3633, 3642, 3646–3647, 3662, 3666, 3669– 3671, 3690, 3696, 3701–3702, 3706, 3717, 3722–3723, 3728–3729, 3735, 3739, 3743, 3753, 3760, 3772–3773, 3779–3780, 3787, 3793–3794, 3797– 3801, 3804–3805, 3812–3814, 3821–3824, 3829–3833, 3837–3845, 3850– 3855, 3860–3865, 3867–3869, 3875–3876, 3887, 3893–3894, 3898, 3902, 3909–3911, 3913–3916, 3935, 3939, 3942–3948, 3959, 3974–3975, 3992, 4025, 4032, 4041–4042, 4045, 4049, 4051–4052, 4054, 4058–4059, 4066, 4069, 4071, 4074–4075, 4119, 4122–4124, 4126–4132, 4140–4141,	64
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file on CD (or via email)	corres- ponding entry in affidavit of docu- ments
4144–4145, 4150–4151, 4156, 4162–4164, 4170, 4175, 4179, 4182, 4190, 4194–4195, 4202–4203, 4210, 4214, 4220, 4225, 4232, 4238–4239, 4245–4246, 4258, 4268–4269, 4276, 4297, 4307–4311, 4317–4321, 4325–4329, 4341–4346, 4363, 4380, 4388, 4403–4404, 4418, 4421, 4427, 4436–4437, 4443, 4483–4485, 4490, 4492, 4494, 4497, 4512–4515, 4520–4521, 4528–4530, 4534, 4539, 4551, 4707, 4732, 4754, 4790, 4794, 4800, 4804, 4807, 4810, 4842–4843, 4847, 5025, 5030–5031, 5036, 5122, 5155, 5183, 5200, 5205, 5211, 5317, 5350–5351, 5355, 5371, 5424, 5426, 5517, 5563, 5579, 5591–5592, 5609, 5618, 5626, 5628, 5631, 5635, 5654, 5676, 5706–5707, 5726, 5743, 5755, 5768, 5784, 5803, 5817–5818, 5836, 5877, 5915, 5955–5956, 5990, 5992, 6009, 6047, 6057, 6176, 6284, 6331, 6357, 6370, 6405, 6519, 6524, 6583, 6630, 6669, 6671, 6678, 6685, 6691, 6697, 6702, 6707, 6709–6710, 6712, 6755, 6781, 6801, 6823, 6844, 6870, 6908, 6940, 6999, 7037, 7080, 7143, 7148, 7158, 7222, 7407, 7423, 7451, 7457, 7474, 7503, 7537, 7550, 7560, 7591, 7634, 7653, 7683, 7733, 8398, 8404, 8957, 8973, 9032, 9144, 9162, 9332, 9387, 9390, 9395–9396, 9477, 9553, 9599, 9612, 9633, 9644, 9712, 9738, 9767, 9809, 9847, 9854, 9912, 9964, 10028, 10082, 10193–10194, 10260, 10298, 10335, 10362, 10380–10381, 10422, 10429, 10558, 10654, 10943, 11155, 11331, 11648, 11726–11728	64
12–16	54
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file on CD (or via email)	corres- ponding entry in affidavit of docu- ments
17–25, 27–44, 46, 48–74, 76–83, 85–91, 94–102, 104–128, 130–162, 164–178, 180–189, 191–195, 197–202, 204–207, 209–249, 251–285, 287– 317, 319–361, 363–411, 413–466, 468–533, 535–556, 558–610, 612–662, 664–711, 713–747, 749–802, 804–807, 811–812, 814–818, 820–845, 847– 854, 858–895, 897–911, 914–934, 936–957, 959–969, 971–980, 982–1001, 1003–1051, 1053–1137, 1139–1190, 1192–1240, 1242–1281, 1283–1304, 1306–1309, 1313–1336, 1338–1344, 1346–1357, 1359–1363, 1365–1397, 1399–1431, 1434, 1436–1437, 1440–1456, 1461–1487, 1489–1493, 1495– 1516, 1518–1532, 1534–1567, 1569–1612, 1614–1647, 1649–1658, 1660– 1665, 1667–1696, 1698–1730, 1732–1740, 1742–1756, 1758–1788, 1790– 1799, 1801–1822, 1824–1851, 1853, 1855–1881, 1883–1904, 1906–1912, 1916–1919, 1921–1956, 1961–1988, 1990–1994, 1996–2006, 2008, 2010, 2012, 2015–2016, 2019–2023, 2025–2034, 2036–2042, 2045–2047, 2049– 2053, 2055–2081, 2083–2105, 2107–2111, 2114–2115, 2117–2122, 2124– 2134, 2136–2151, 2153, 2155–2161, 2163–2174, 2177–2182, 2184–2199, 2201–2202, 2204–2208, 2210–2224, 2226, 2228–2235, 2237–2272, 2274– 2278, 2280–2282, 2284–2291, 2295, 2297–2298, 2300–2313, 2315–2318, 2320–2333, 2335–2355, 2358–2359, 2361–2368, 2370–2387, 2389–2391, 2393–2403, 2405–2456, 2458–2463, 2465–2478, 2480–2496, 2498–2513, 2515–2530, 2532–2539, 2541–2554, 2556–2576, 2578–2589, 2592, 2594– 2596, 2599–2600, 2603–2604, 2610, 2612–2613, 2615–2621, 2624–2626, 2628–2629, 2672–2680, 2682–2689, 2691–2692, 2694–2696, 2700–2704, 2706–2707, 2709, 2713–2714, 2716–2717, 2719–2721, 2723, 2725–2727, 2729, 2731, 2733, 2735, 2740–2742, 2744, 2747, 2753, 2755–2759, 2761– 2764, 2766–2767, 2769–2772, 2776, 2778–2779, 2781–2783, 2786–2788, 2791–2792, 2796, 2798–2799, 2803–2804, 2807, 2809, 2811, 2814–2816, 2819–2828, 2831, 2836–2842, 2846–2848, 2853–2854, 2859–2872, 2874– 2876, 2878–2879, 2882–2883, 2886, 2891–2892, 2895–2898, 2900–2910, 2912–2915, 2917–2918, 2920–2921, 2924, 2926–2947, 2949–2984, 2986– 2990, 2993–2996, 2998–3002, 3004–3007, 3009–3017, 3020–3022, 3024, 3027–3028, 3030–3033, 3035–3037, 3039–3040, 3042, 3045–3051, 3053– 3056, 3058–3061, 3067, 3069, 3071–3072, 3075–3077, 3079–3080, 3082– 3083, 3085–3091, 3094–3095, 3097–3098, 3101–3102, 3104–3114, 3116– 3117, 3120–3124, 3128–3129, 3131–3133, 3140, 3142–3144, 3146–3150, 3152–3153, 3156, 3159–3160, 3162–3163, 3165–3167, 3170–3175, 3177– 3181, 3183, 3185, 3189, 3191–3194, 3196–3199, 3201–3202, 3204–3208, 3210, 3212–3215, 3218–3220, 3223, 3225–3227, 3230–3232, 3234–3238,	69
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file on CD (or via email)	corres- ponding entry in affidavit of docu- ments
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file on CD (or via email)	corres- ponding entry in affidavit of docu- ments
103	57
163	66
819	67
855–856	66
1345	58
1460	20
1959	22
1989	23
2018	21
2024	24
2292	26
2636	25
3810	66
3811	66
3874	54
5471	27
5629	29
7973	74
8598	67
8599	44
8721	54
8764	66
8786	28
9064	66
9065	66
9209	59
9394	38
9731	75
9978	66
9979	66
10169	30
10311	40
10396	31
10476	76
Continued on next page	

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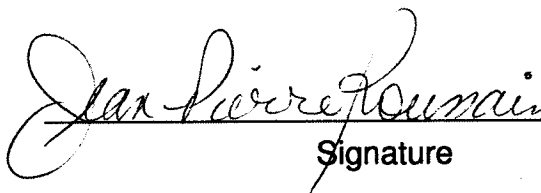
file on CD (or via email)	corres- ponding entry in affidavit of docu- ments
10667	68
10719	71
10786	5
10803	6
10823	32
11108	12
11225	41
11360	7
11367	60
11438	61
11471	8
11479	13
11516	9
11563	10
11589	14
11722	33
11723	34
11724	35
11729	62
11768	43
11769	36
11771	73
11779	55
11782	39
11785	59
11786	42
11794	16
11795	70
11796	75
11797	78
11798	77
11799	37
11800	15
11801	45
Continued on next page	

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Table 1 – continued from previous page

file on CD (or via email)	corres- ponding entry in affidavit of docu- ments
11802	46
11803	48
11804	47
11805	50
11806	52
11807	53
11808	51
11809	49
11810	17

This is **Exhibit "G"** to the Affidavit of Dr. Jeremy R. Cooperstock
affirmed before me on October 31, 2014

 **JEAN-PIERRE ROUSSAIN**
AGENT DU GREFFE
REGISTRY OFFICER
Signature

Dr. Jeremy Cooperstock
392 Grosvenor Avenue
Westmount, QC H3Z 2M2

jcooperstock@gmail.com

September 22, 2014

VIA EMAIL

Me Hélène D'Iorio
Gowling Lafleur Henderson LLP
1 Place Ville Marie, 37th Floor
Montréal, QC HJ8 JP4

Dear Me D'Iorio :

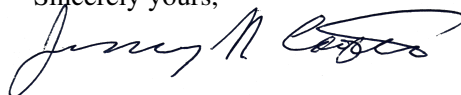
**Re: United Airlines, Inc. v. Jeremy Cooperstock
Federal Court File No.: T-2084-12
Updates to Affidavit of Documents
Follow-up to my letter of September 12, 2014**

I am writing to follow up on my letter of September 12, 2014, containing my Supplemental Affidavit of Documents and associated updated table of concordance.

I had requested that you kindly update Plaintiff's affidavit of documents, and send the updated version to me no later than September 19, 2014. Regrettably, you have failed to respond to my request.

As you surely know, Rule 226 of the *Federal Court Rules* imposes a positive duty on each party to update its affidavit of documents when one is in need of such an update. Therefore, I respectfully request that you provide me with an updated version of Plaintiff's affidavit of documents without further delay.

Sincerely yours,



Dr. Jeremy Cooperstock

This is **Exhibit "H"** to the Affidavit of Dr. Jeremy R. Cooperstock
affirmed before me on October 31, 2014

A handwritten signature in cursive script, reading "Jean-Pierre Roussain", written over a horizontal line.

JEAN-PIERRE ROUSSAIN
AGENT DU GREFFE
REGISTRY OFFICER

Signature

Dr. Jeremy Cooperstock
392 Grosvenor Avenue
Westmount, QC H3Z 2M2

jcooperstock@gmail.com

October 3, 2014

VIA EMAIL

Me Hélène D'Iorio
Gowling Lafleur Henderson LLP
1 Place Ville Marie, 37th Floor
Montréal, QC HJ8 JP4

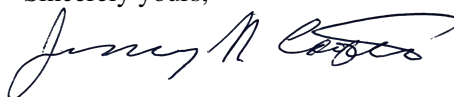
Dear Me D'Iorio :

**Re: United Airlines, Inc. v. Jeremy Cooperstock
Federal Court File No.: T-2084-12
Updates to Affidavit of Documents
Follow-up to my letters of September 12 and September 22, 2014**

I am writing to follow up on my letters of September 12 and September 22, 2014, requesting that you kindly update Plaintiff's affidavit of documents, and send the updated version to me no later than September 19, 2014.

I am profoundly disappointed that you have yet to respond to these requests. Again, I respectfully request that you provide me with an updated version of Plaintiff's affidavit of documents without further delay.

Sincerely yours,



Dr. Jeremy Cooperstock

Court File No.: T-2084-12

FEDERAL COURT

BETWEEN:

UNITED AIRLINES, INC.

Plaintiff

– and –

DR. JEREMY COOPERSTOCK

Defendant

**WRITTEN REPRESENTATIONS OF THE MOVING PARTY, THE
DEFENDANT**

PART I – STATEMENT OF FACTS

1. The present motion seeks a better affidavit of documents and further discovery of Plaintiff with respect to a crucial document that has been withheld by Plaintiff up until recently.

2. Defendant launched his website, Untied.com, in 1997, and operated it as both a forum for postings by passengers and employees of Plaintiff, and as a satirical website, employing parody to expose Plaintiff's poor service to passengers and mistreatment of its employees. Despite being a thorn in the side of Plaintiff for more than 15 years, Plaintiff had not brought legal actions against Defendant.

Defendant's Affidavit, paras. 2 and 3

[Tab 6, P102]

3. On November 19, 2012, the Plaintiff served upon the Defendant two separate proceedings, commenced in two separate courts:

- (a) the present proceeding before the Federal Court, alleging copy-right infringement, trade-mark infringement, and passing off; and
- (b) a proceeding before the Quebec Superior Court, seeking a permanent injunction to have certain information removed from the United.com website.

Amended Statement of Claim

[Tab 2, P5]

4. Defendant filed his amended Statement of Defence on June 20, 2013, alleging among other things that Plaintiff's action is an abuse of process by being a Strategic Lawsuit against Public Participation, disguised as a claim of

intellectual property infringement, brought with the purpose of preventing him from operating his website:

60. The ~~Plaintiffs have~~ Plaintiff has brought this action in bad faith, without justification, and with an extraneous and improper purpose, namely, to use this litigation to coerce the Defendant to shut down the Untied.com website.
63. The ~~Plaintiffs'~~ Plaintiff's predominant purpose in bringing this action is not to preserve or defend any alleged rights under the *Trade-marks Act* or the *Copyright Act*, or to obtain proper compensation for the violation of any such rights. Rather, their predominant purpose is to strong-arm the Defendant into giving up his expressive activities critical of the ~~Plaintiffs'~~ Plaintiff's conduct.

Amended Statement of Defence

[Tab 3, P50]

5. On June 27, 2013, Plaintiff served its affidavit of documents.

Plaintiff's Affidavit of Documents

[Tab 6A, P116]

6. On examination for discovery, conducted on October 2, 2013, Plaintiff's representative, Mr. Scott Wilson, refused to provide answers to certain questions concerning the meetings and internal correspondence of United Airlines management regarding Defendant's web site.

Defendant's Affidavit, para. 6 and Ex. "B"

**[Tabs 6 and 6B,
P103 and 134]**

7. Defendant brought a motion on March 10, 2014, seeking to compel Plaintiff to answer questions that had been refused. Prothonotary Morneau ordered on July 3, 2014 that Plaintiff need not answer questions related to the defence that Plaintiff brought its action in bad faith, holding that these questions were a fishing expedition.

**Order and reasons of Prothonotary Morneau,
dated July 3, 2014, para. 30**

[Tab 5, P57]

8. One month after the order of Prothonotary Morneau regarding Defendant's motion to compel, an email dated June 16, 2012 surfaced in which Mr. Jeff Wittig, senior in-house counsel of Plaintiff, made reference to efforts to shut down Defendant's website, to wit "We're working on shutting it down." This document was not disclosed in any way prior to August 7, 2014, and only came to light through the parallel proceeding brought by Plaintiff against Defendant before the Quebec Superior Court. Defendant subsequently included this document in his statement of defence, filed with the Quebec Superior Court.

Defendant's Affidavit, paras. 10-12 and Ex. "D"

**[Tabs 6 and 6D,
P104 and P143]**

9. Mr. Wittig's email supports Defendant's allegation that Plaintiff brought its action in bad faith for the purpose of shutting down Defendant's website, and thus, the present action constitutes an abuse of process.

10. Between September 12 and October 3, 2014, Defendant sent three letters to Plaintiff's counsel, requesting that Plaintiff's affidavit of documents be updated. To date, no reply has been received.

Defendant's Affidavit, Exhibits "F"-"H"

[Tab 6F-6H, P171-175]

PART II – STATEMENT OF THE POINTS IN ISSUE

11. The issues to be determined in the present motion are whether:
- (a) Plaintiff should be compelled to update its affidavit of documents;
 - (b) Plaintiff's representative, Mr. Scott Wilson, should be compelled to re-attend, at the expense of the Plaintiff, for cross-examination on the contents of its affidavit of documents; and
 - (c) either Mr. Scott Wilson, or another representative of Plaintiff with knowledge of Plaintiff's efforts to shut down Defendant's website, should be compelled to re-attend, at the expense of Plaintiff, for examination on discovery to answer questions relevant to abuse of process, and in particular, efforts to shut down Defendant's website.

PART III – STATEMENT OF SUBMISSIONS

A. Legal Principles

(i) Abuse of Process is a Defence

12. The Federal Court of Appeal has held abuse of process to be a defence.

Levi Strauss & Co. v. Roadrunner Apparel inc., [Tab 9, P188]
1997 Canlii 5596 (FCA)

(ii) Obligations of Disclosure

13. A party that is aware that its affidavit of documents is deficient has an obligation to serve a supplementary affidavit without delay. When a solicitor learns of the existence of documents relevant to the litigation, he or she should produce the documents.

Federal Court Rules, s. 226 [Tab 8]
Harper v. Harper, [1980] 1 SCR 2 [Tab 10, P196]

14. Internal communications containing damaging admissions fall under the obligation of disclosure. The principle for determining what document properly relates to the matters in issue is that it must be one which might reasonably be supposed to contain information which may directly or indirectly enable the party requiring production to advance his own case or to damage the case of his adversary, or which might fairly lead him to a train of inquiry that could have either of these consequences.

Reading & Bates Construction Co. v. Baker Energy Resources Corp. et al (1988) [Tab 11, P216]
Eli Lilly Canada inc. v. Novopharm Limited,
2008 FC 281, paras. 32-39 [Tab 12, P225]

(iii) **Cross-examination on Affidavit and/or Re-attendance for Examination on Discovery**

15. Where the Court is satisfied that an affidavit of documents is inaccurate or deficient, it may order that the deponent of the affidavit be examined.

Federal Court Rules, s. 227 [Tab 8]
Liebmann v. Canada (Min. of National Defence), [Tab 13, P246]
 1994 FCJ 1955, paras. 24-28

16. It is only fair that parties have a full set of documents in preparing for examination for discovery. Disclosure of documents is not discretionary; every party is obliged to list all relevant documents in its own affidavit of documents. In the event where specific documents have been overlooked or withheld, the opposing party may have remedy by way of cross-examination on affidavits of documents.

Havana House Cigar & Tobacco Merchants Ltd. v. Naeini, 1998 CanLII 7605 (FC), paras. 20-23 [Tab 14, P252]

B. Application of the Law to the Case

(i) **The Defence of Abuse of Process has been Pleaded and is Relevant**

17. Defendant alleges that Plaintiff's action constitutes of abuse of process, brought with the intent of strong-arming Defendant into giving up his expressive activities critical of Plaintiff's conduct. This is supported by Mr. Wittig's email of June 16, 2012, in which he writes, with reference to Defendant's website, "We're working on shutting it down."

Amended Statement of Defence, paras. 60 and 63 [Tab 3, P50-51]

(ii) Plaintiff Refuses to Fulfill its Obligations under Rule 226

18. Mr. Wittig's email of June 16, 2012 is a critical, relevant document that directly enables Defendant to advance his own case.

19. It is now clear that in its affidavit of documents, Plaintiff failed to fulfill its obligation to disclose this email, whose admission, "We're working on shutting it down" suggests the existence of other such documents that Plaintiff has similarly failed to disclose.

Defendant's Affidavit, Exhibit "D"

[Tab 6D, P143]

20. Plaintiff was made aware of the deficiency of its affidavit of documents at least by September 12, 2014. Nevertheless, Plaintiff refused to update its affidavit of documents despite its obligation under *Rule 226*, and several requests to do so.

Defendant's Affidavit, Exhibits "F"-"H"

[Tabs 6F-6H, P171-175]

21. This conduct demonstrates that the Court's intervention is necessary to compel Plaintiff to comply with its obligations.

(iii) Cross-examination on Affidavit and/or Re-attendance for Examination on Discovery

22. During the discovery process, Defendant had no knowledge of Mr. Wittig's email of June 16, 2012. Defendant was thus deprived of the opportunity to examine Plaintiff's representative on this document and similar documents regarding Plaintiff's efforts to shut down his website, Untied.com.

23. Defendant was also prejudiced by the withholding of Mr. Wittig's email of June 16, 2012, since he could not put this document before the Court when bringing his motion to compel, and thus Prothonotary Morneau found that Defendant's questions related to the meetings and internal correspondence of Plaintiff's management regarding Defendant's website were a fishing expedition.

**Order and reasons of Prothonotary Morneau,
dated July 3, 2014, para. 30**

[Tab 5, P57]

24. The belated revelation of Mr. Wittig's email of June 16, 2012 has created a new situation. It is now clear that Plaintiff withheld a relevant document, of which there may be more, and that Plaintiff's conduct deprived Defendant of the benefit of a full discovery. If this state of affairs is not corrected, it will prejudice Defendant's ability to mount a full defence at trial.

25. As remedy, Defendant seeks to cross-examine Plaintiff's representative on its affidavit of documents, and/or preferably, to examine a representative of Plaintiff with knowledge of the contents of the email and internal discussions related to Plaintiff's efforts to shut down his website, Untied.com.

C. Costs

26. When a re-examination is necessary because a party fails to disclose relevant documents, regardless of whether the omission was inadvertent or an act of deliberate concealment, such negligence warrants the awarding of costs to the opposing party.

***Pacific Forest Products Ltd. v. Canadian Transport Co.*, 1998 CanLII 7326 (FC), paras. 6-7**

[Tab 15, P260]

PART IV – ORDER SOUGHT

27. The Moving Party, Dr. Cooperstock, is seeking:
- (a) An Order pursuant to Rule 226 of the *Federal Court Rules*, requiring Plaintiff to update its affidavit of documents.
 - (b) An Order pursuant to Rule 227 of the *Federal Court Rules*, requiring Mr. Wilson, Plaintiff's representative, to re-attend, at the expense of Plaintiff, for cross-examination on the contents of its affidavit of documents.
 - (c) An Order pursuant to Rule 235 of the *Federal Court Rules*, requiring Plaintiff's witness, either Mr. Scott Wilson, or another representative of Plaintiff with knowledge of Plaintiff's efforts to shut down Defendant's website, to re-attend, at the expense of Plaintiff, at an examination for discovery to answer questions relevant to abuse of process, and in particular, efforts to shut down Defendant's website.
 - (d) An Order awarding costs of this motion to the Defendant.
 - (e) Such further and other relief as this Honourable Court may deem just.

ALL OF WHICH IS RESPECTFULLY SUBMITTED.

October 31, 2014



DR. JEREMY COOPERSTOCK

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Westmount, Québec H3Z 2M2
Tel: 438-808-6463

jcooperstock@gmail.com

Defendant / Moving Party

PART V – LIST OF AUTHORITIES

STATUTES AND REGULATIONS

Federal Courts Rules, S.O.R./98-106,
Rules 226, 227, and 235

CASES

Levi Strauss & Co. v. Roadrunner Apparel Inc.,
1997 CanLII 5596 (FCA)

Harper v. Harper,
[1980] 1 SCR 2, 1979 CanLII 168 (SCC)

Reading & Bates Construction Co. v. Baker Energy Resources Corp. et al
(1988)

Eli Lilly Canada Inc. v. Novopharm Limited, 2008 FC 281

Liebmann v. Canada (Min. of National Defence), 1994 FCJ 1955

Havana House Cigar & Tobacco Merchants Ltd. v. Naeini, 1998 CanLII
7605 (FC)

Pacific Forest Products Ltd. v. Canadian Transport Co., 1998 CanLII 7326
(FC)

Federal Courts Rules S.O.R./98-106	Règles des Cours fédérales DORS/98-106
<p>Need for continuing disclosure</p> <p>226. (1) A party who becomes aware that its affidavit of documents is inaccurate or deficient shall, without delay, serve a supplementary affidavit of documents correcting the inaccuracy or deficiency.</p> <p>Exception</p> <p>(2) A document produced and marked as an exhibit on an examination need not be included in a supplementary affidavit of documents.</p>	<p>Affidavit supplémentaire</p> <p>226. (1) La partie qui se rend compte que son affidavit de documents est inexact ou insuffisant signifie sans délai un affidavit supplémentaire corrigeant cette inexactitude ou insuffisance.</p> <p>Exception</p> <p>(2) Le paragraphe (1) ne s'applique pas aux documents produits lors d'un interrogatoire qui sont cotés comme pièces.</p>
<p>Sanctions</p> <p>227. On motion, where the Court is satisfied that an affidavit of documents is inaccurate or deficient, the Court may inspect any document that may be relevant and may order that</p> <p>(a) the deponent of the affidavit be cross-examined;</p> <p>(b) an accurate or complete affidavit be served and filed;</p> <p>(c) all or part of the pleadings of the party on behalf of whom the affidavit was made be struck out; or</p> <p>(d) that the party on behalf of whom the affidavit was made pay costs.</p>	<p>Sanctions</p> <p>227. La Cour peut, sur requête, si elle est convaincue qu'un affidavit de documents est inexact ou insuffisant, examiner tout document susceptible d'être pertinent et ordonner :</p> <p>a) que l'auteur de l'affidavit soit contre-interrogé;</p> <p>b) qu'un affidavit exact ou complet soit signifié et déposé;</p> <p>c) que les actes de procédure de la partie pour le compte de laquelle l'affidavit a été établi soient radiés en totalité ou en partie;</p> <p>d) que la partie pour le compte de laquelle l'affidavit a été établi paie les dépens.</p>

Single examination 235. Except with leave of the Court, a party may examine for discovery any adverse party only once.	Interrogatoire unique 235. Sauf autorisation contraire de la Cour, une partie ne peut interroger au préalable une partie adverse qu'une seule fois.
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Levi Strauss & Co. v. Roadrunner Apparel Inc., 1997 CanLII 5596 (FCA)

Date: 1997-10-27
 Docket: A-240-97
 Parallel 76 CPR (3d) 129
 citations:
 URL: <http://canlii.ca/t/4n04>
 Citation: Levi Strauss & Co. v. Roadrunner Apparel Inc., 1997 CanLII 5596 (FCA),
 <<http://canlii.ca/t/4n04>> retrieved on 2014-02-19
 Noteup: Search for decisions citing this decision
 Reflex Related decisions, legislation cited and decisions cited
 Record

A-240-97

CORAM: STRAYER J.A.
 DESJARDINS J.A.
 LÉTOURNEAU J.A.

BETWEEN:

LEVI STRAUSS & CO. and
LEVI STRAUSS & CO. (CANADA) INC.

Appellants
 (Plaintiffs)

AND:

ROADRUNNER APPAREL INC.

Respondent
 (Defendant)

REASONS FOR JUDGMENT

LÉTOURNEAU J.A.

This is an appeal by Levi Strauss & Co. and Levi Strauss & Co. (Canada) Inc. from the order of a motions judge, dated March 6, 1997, not to strike out paragraphs 18 and 21 of the Statement of Defence of the Respondent (Roadrunner Apparel Inc.) pursuant to Rule 419(1) of the Federal Court Rules.

The paragraphs relate to the Appellants' trade-mark rights in Canada to use a double arcuate design applied to the hip pocket of jeans-type garments. They read:

18. The Plaintiffs have acquiesced in and condoned the use of double arcuate designs applied to the rear pockets of jeans or similar garments by others in Canada or, in the alternative, the Plaintiffs have failed to diligently enforce their alleged rights in the alleged trade-mark against others.

21. The Defendant states that the Plaintiffs' action is frivolous and vexatious and intended only to try to harass and intimidate the Defendant. The Plaintiffs have threatened numerous jeans manufacturers and/or vendors, some of whom are outlined in Schedule "A" with legal action and have in fact commenced action against some manufacturers/vendors of jeans in Canada, for allegedly infringing registration number UCA39879. However, the Plaintiffs have failed to diligently pursue and prosecute those actions and have avoided the final adjudication of their alleged rights. By this course of action, the Plaintiffs attempt to interfere with said jeans manufacturers/vendors' business and maintain the Plaintiffs' market share.

a) Paragraph 18 and the defence of acquiescence

The Appellants argue in relation to the allegation of acquiescence found in paragraph 18 that the defence of acquiescence is personal to a defendant and, consequently, that a defendant cannot rely on a plaintiff's acquiescence to the use of its trade-mark by third parties. The contention is that the behaviour of a plaintiff toward other parties is irrelevant to the determination of an issue between the plaintiff and a specific defendant who does not claim acquiescence in relation to itself. In support of their position, the Appellants have referred us to American authorities, but to no Canadian precedents in the matter.

It is not necessary for us to decide the point as submitted and argued by the Appellants. I am satisfied that paragraph 18 ought to be read as a whole with paragraphs 16 and 17 of the Statement of Defence which specifically allege that the double design applied to the rear pockets of jeans has lost the distinctiveness claimed by the Appellants because it has been widely used in the past by a number of companies and still is in common use in Canada¹. It is, in my view, in this context of loss of distinctiveness that the Respondent's reference to acquiescence by the Appellants to the use of its trade-mark in the market place ought to be read and understood. The owner of a trade-mark may by his personal conduct or own behaviour, including acquiescence to the use of the trade-mark by others, irremediably compromise the distinctiveness of the mark and the validity of the registration². Consequently, it is quite proper for a defendant in an infringement lawsuit to allege such fact in its Statement of Defence provided it is supported by a factual base. The motions judge properly found that the Respondent had provided statements of fact supporting its allegation and I see no reason to intervene in the exercise of his discretion not to strike the part of paragraph 18 which refers

to acquiescence.

b) Paragraph 21 and the allegation that the Appellant's lawsuit is frivolous and vexatious

Paragraph 18 contains an alternative pleading which alleges that "the Plaintiffs have failed to diligently enforce their alleged rights in the alleged trade-mark against others". It is a re-statement in part of paragraph 21 and ought to be assessed with it.

The Appellants submit that the Respondent questions in paragraphs 18 and 21 the motive for bringing the lawsuit and that motive does not constitute at law a defence. They further submit that these allegations are immaterial and irrelevant and would prejudice and delay the fair trial of the action.

For its part, the Respondent basically submitted to us that what it alleges in its Statement of Defence is that the Appellants, under the guise of a valid enforcement of their trade-mark, are in fact abusing the process of the Court. The Respondent wants to establish that the abuse of process resides in the Appellants' action or course of conduct which is designed to harass him and other users of the trade-mark and also to avoid by all means a determination of the validity of their registration.

I think that the validity of paragraph 21 and the relevant portion of paragraph 18 stands to be decided on the principles applicable to an abuse of process of the Court and that, in this context, motive is highly relevant.

The concept of abuse of process has developed both in substantive and procedural law. It is well settled law, from the point of view of substantive law, that an abuse of process is an actionable tort. As Henry J. stated in *Tsiopoulous v. Commercial Union Assurance Co.*³ when dealing with a counterclaim for damages for abuse of process:

"This cause of action arises when the processes of law are used for an ulterior or collateral purpose. It is defined as the misusing of the process of the courts to coerce someone in some way entirely outside the ambit of the legal claim upon which the court is asked to adjudicate. It occurs when the process of the court is used for an improper purpose and where there is a definite act or threat in furtherance of such purpose."

In Fleming's *The Law of Torts*⁴, the learned author distinguishes between certain forms of abuse of legal procedure such as malicious arrest and execution and the concept of abuse of process:

"Quite distinct, however, are cases where a legal process, not itself devoid of foundation, has been perverted for some extraneous purpose, such as extortion or oppression. Here an action will lie at the suit of the injured party for what has come to be called "abuse of process"."

A review of the authorities shows that the essential element of the tort of abuse of process is that the abuser must have used the legal process for a purpose other than that which it was designed to serve, in other words for a collateral, extraneous, ulterior, improper or illicit purpose⁵. The gist of the tort is the misuse or perversion of the Court's process and there is no

abuse when a litigant employs regular legal process to its proper conclusion, even with bad intentions⁶.

Abuse of process has also been invoked as a procedural defence, especially in criminal law when the proceedings were oppressive or vexatious or offensive to the principles of fundamental justice and fair play⁷. When successful, the defence has resulted in a stay of the proceedings.

However, the procedural defence of abuse of process knows of no legal barrier in the sense that its application is not limited to the field of criminal law, but extends to other fields such as civil, constitutional or administrative law⁸. There is nothing to prevent its application to an infringement lawsuit. The abuse of process notion proceeds from a rationale unconnected with the various segments of the law in which it can be invoked. It is a request to a Court to vindicate its process and protect it from abuse by litigants and I, for one, would be very loath to deny a litigant the right to raise the issue in its Statement of Defence and seek our protection against such an abuse when there is a factual basis to support the claim.

Again, I think the motions judge properly exercised his discretion when he came to the conclusion that there was a supporting factual basis for the allegation made by the Respondent and refused to strike paragraph 21 and the relevant portion of paragraph 18.

Finally, I wish to add that the difficulties for a defendant of proving a misuse or perversion of the process on the part of a plaintiff seeking to enforce its trade-mark through the legal process cannot be underestimated. However, this is not a valid ground for denying a defendant such possibility.

For these reasons, the appeal should be dismissed with costs here and below.

"Gilles Létourneau"

J.A.

"I agree

B.L. Strayer J.A."

"I concur,

Alice Desjardins

J.A."

A-240-97

CORAM: STRAYER J.A.

DESJARDINS J.A.

LÉTOURNEAU J.A.

BETWEEN:

LEVI STRAUSS & CO. and

LEVI STRAUSS & CO. (CANADA) INC.

Appellants

(Plaintiffs)

AND:

ROADRUNNER APPAREL INC.

Respondent

(Defendant)

Heard at Ottawa, Wednesday, October 15, 1997

Judgment rendered at Ottawa, Monday, October 27, 1997

REASONS FOR JUDGMENT BY: **LÉTOURNEAU J.A.**

CONCURRED IN BY: **STRAYER J.A.**

DESJARDINS J.A.

¹ Paragraphs 16 and 17 read: 16. A double arcuate stitching design applied to the rear pockets of jeans or similar garments was not, at the time these proceedings were commenced, and is not at the present time, distinctive of the Plaintiffs or either of them. At the time these proceedings were commenced and at the present time, a double arcuate design applied to the rear pockets of jeans or similar garments were used by a number of companies and was used in the past and was in common use in Canada. Brands of jeans which have been offered for sale in Canada or are presently offered for sale in Canada having such a design are listed at Schedule "A" to the Statement of Claim. The identity of other manufacturers and sellers of jeans in Canada who also apply double arcuate design to the rear pockets of their jeans or similar garments is currently unknown to the Defendant. As a result of such use and/or registration, the Plaintiffs' trademark is not distinctive and the registration is therefore invalid and the Defendant pleads and relies upon Section 18(1)(b) of the Trademarks Act. 17. A double arcuate design has been and currently continues to be commonly applied to the rear pockets of jeans or similar garments for the purposes of ornament or decoration and therefore is not adapted to distinguish the wares of the Plaintiffs from those of others. The Defendant therefore states that a double arcuate design is not a trademark within the meaning of Section 2 of the Trademarks Act, [R.S.C. 1985 c. T. 13](#), as amended.

² *Hughes on Trade Marks*, (Toronto: Butterworths, March 1997) at para. 32, p. 459: "The owner of a trade mark may lose his exclusive rights if he permits the widespread use of it by rival trades, either by conscious or negative action... The more often a mark is used by third parties, the less the protection affords. Distinctiveness can be lost where a trade mark owner permits use by third parties". See also D. Vaver, *Intellectual Property Law*, (Toronto: Carswell, 1997) at p. 228.

³ [1986 CanLII 2531 \(ON SC\)](#), (1986) 32 D.L.R. (4th) 614, at 616 (O.H.C.). See also *Guilford Industries Ltd. v. Hankinson Management Services Ltd. et al.*, (1973) 40 D.L.R. (3d) 398 (B.C.S.C.); *Atland Containers Ltd. v. Macs Corp Ltd. et al.*, [1974 CanLII 864 \(ON SC\)](#), (1974) 7 O.R. (2d) 107, 54 D.L.R. (3d) 363 (O.H.C.); *Unterreiner v. Wilson et al.*, [reflex](#), (1982) 142 D.L.R. (3d) 588, affirmed [1983 CanLII 1968 \(ON CA\)](#), (1983) 146 D.L.R. (3d) 322 (Ont. C.A.).

⁴ 4th ed. (1971), pp. 547 and 548.

⁵ *Grainger v. Hill*, (1838) 132 E.R. 769; *D.K. Investments Ltd. v. S.W.S. Investments Ltd.*, [1984 CanLII 398 \(BC SC\)](#), (1984) 59 B.C.L.R. 333 (S.C.), affirmed [1986 CanLII 920 \(BC CA\)](#), (1986) 6 B.C.L.R. (2d) 291 (C.A.); *Hedley v. Air Canada*, (1994) 23 C.P.C. (3d) 352 (Ont. Gen. Div.); *Canada Metal Col. v. Heap*, [1975 CanLII 675 \(ON CA\)](#), (1975) 7 O.R. (2d) 185 (C.A.); *Norman v. Soule et al.*, (1990) 7 C.C.L.T. (2d) 16 (B.C.S.C.); *R. Cholkani & Co. v. Brinker*, [1990 CanLII 6865 \(ON SC\)](#), (1990) 71 O.R. (2d) 381 (H.C.). See also L. Klar, *Tort Law*, 1st ed. (Toronto: Carswell, 1991), pp. 50-51; G. Fridman, *The Law of Torts in Canada*, Vol. 2 (1990), pp. 250-251; G. Fridman, *Fridman on Torts*, (1990) pp. 587-589; Solomon & Feldthusen, *Cases and Materials on the Law of Torts*, 3rd ed. (1991), p. 70; J. Irvine, *The Resurrection of Tortious Abuse of Process*, (1989), 47 *C.C.L.T.* 217.

⁶ *Grainger v. Hill*, *supra*.

⁷ *R. v. Curragh Inc.*, [1997 CanLII 381 \(SCC\)](#), [1997] 1 S.C.R. 537; *R. v. O'Connor*, [1995 CanLII 51 \(SCC\)](#), [1995] 4 S.C.R. 411; *R. v. Keyowski* [1988 CanLII 74 \(SCC\)](#), [1988] 1 S.C.R. 657; *R. v. Power*, [1994 CanLII 126 \(SCC\)](#), [1994] 1 S.C.R. 601.

⁸ See for example *General Food Ltd. v. Struthers Scientific & International Corp.*, [1971 CanLII 189 \(SCC\)](#), [1974] S.C.R. 98 where Pigeon J. said that patent owners and their attorneys are expected to avoid unnecessary costs and that the unreasonable multiplication of proceedings is an abuse of the worst kind; *Borley v. Fraser River Harbour Commission*, [reflex](#), (1995) 92 F.T.R. 275 (F.C.T.D.) where an action was struck out as an abuse of process where it sought to raise issues that had been or could have been litigated in proceedings that had been finally determined in the Superior Court of the Province; *Kastner v. Painblanc* (1994), 176 N.R. 68 (Fed. C.A.) where it is an abuse of the Court's process for a plaintiff to start proceedings in the hope that something will turn up; *Oak Bay Marine Group v. Jackson*, [1994 CanLII 3474 \(FC\)](#), [1994] 3 F.C. 177 (T.D.) where an action which arose out of the same facts as an action instituted four years earlier involving repetitious evidence and argument from the earlier case was struck out as an abuse of process; *Musqueam Indian Band v. Canada (Min. of Indian & Northern Affairs)*, [reflex](#), [1990] 2 F.C. 351 (T.D.) where it is an abuse of process to relitigate an issue based on facts which were decided on by the

Supreme Court of Canada; *Favor v. Winnipeg (City)*, [reflex](#), [1989] 3 W.W.R. 374 (C.A.) where the plaintiff's action was dismissed as an abuse of process since the validity of the expropriation had already been decided in an earlier proceeding); *Crown Trust Co. v. Rosenberg* (1983), 38 C.P.C. 109 (Ont. H.C.) where a request for information [on an examination carried out pursuant to a subpoena to be used on a motion] was an abuse of process; *Brand v. College of Physicians and Surgeons (Saskatchewan)*, [reflex](#), [1989] 5 W.W.R. 516 (Q.B.) where a delay in the institution of proceedings may constitute an abuse of process.

FEDERAL COURT OF APPEAL

NAMES OF COUNSEL AND SOLICITORS OF RECORD

COURT FILE NO.: A-240-97

APPEAL FROM AN ORDER OF THE TRIAL DIVISION DATED MARCH 6, 1997 IN T-2529-96.

STYLE OF CAUSE:

Levi Strauss & Co. et al. v.

Roadrunner Apparel Inc.

PLACE OF HEARING:

Ottawa, Ontario

DATE OF HEARING:

Wednesday, October 15, 1997

REASONS FOR JUDGMENT BY:

Létourneau J. A.

CONCURRED IN BY:

Strayer J. A.

Desjardins J.A.

DATED:

Monday, October 27, 1997

APPEARANCES:

Mr. David A. Morrow

Ms. Catherine Eckenswiler

for the Appellants

Mr. Glenn Sheskay

for the Respondent

SOLICITORS OF RECORD:

Smart & Biggar

Ottawa, Ontario

for the Appellants

Yegendorf, Brazeau, Seller

Ottawa, Ontario

for the Respondent

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Indexed as:

Harper v. Harper

**Hazel Maggie Jennie Harper (Plaintiff), Appellant; and
Eldon Stewart Harper (Defendant), Respondent.**

[1980] 1 S.C.R. 2

Supreme Court of Canada

1979: May 10 / 1979: June 28.

**Present: Laskin C.J. and Martland, Ritchie, Pigeon, Dickson,
Beetz, Estey, Pratte and McIntyre JJ.**

ON APPEAL FROM THE COURT OF APPEAL FOR BRITISH COLUMBIA

Husband and wife -- Divorce -- Interest of divorced wife in matrimonial home -- Discretionary jurisdiction of trial judge -- Review of trial judge's discretion -- Family Relations Act, 1972 (B.C.), c. 20, s. 8.

Evidence -- Court of Appeal misled by wrongful assertion in notice of appeal as to title to property -- Motion for leave to adduce new evidence -- Motion granted -- Party not disclosing true facts -- Candour expected from counsel and solicitors.

The appellant, the divorced wife of the respondent, brought an action claiming an undivided one-half interest in what was their matrimonial home. The action proceeded through trial and to the British Columbia Court of Appeal on the footing that the title to the property was, as between the respondent and the Director of the Veterans' Land Act in the Director who was shown as the registered owner under the British Columbia Land Registry Act. The house on the property had been constructed through financing arrangements under the veterans' Land Act, now R.S.C. 1970, c. V-4, as amended, and title was put in the name of the Director pursuant to that Act.

The appellant brought her action under the Family Relations Act, 1972 (B.C.), c. 20, on May 9, 1975. Prior to the enactment of this statute, she had commenced a so-called trust action in 1971 when she was still formally married to the respondent, and a *lis pendens* was registered against the property in that action. It, however, remained dormant and she later sought relief under s. 8 of the Family Relations Act.

In her statement of claim, dated August 8, 1975, the appellant asserted, which was a fact, that the property in question was occupied by the respondent and was registered in the name of the Director of the Veterans' Land Act. The appellant alleged that the "lands and premises were purchased by the Plaintiff and Defendant on or about May 8th, 1962 with funds borrowed jointly from the Port Alberni Credit Union and were transferred into the name of the Director of the Veterans' Land Act on the 13th of August

1962". She also alleged that the "lands and premises were used as the matrimonial home by the Plaintiff and Defendant from the date of the completion of the construction of the premises on or about June 1st, 1963 until the 21st day of December 1968, when the Plaintiff left the matrimonial home, fearing for her mental health".

Alleging, further, that the ownership of the land and premises had always been considered a joint venture, the appellant claimed an undivided half interest in the property "as a result of her contributions towards the economic wealth of the family as a whole". The respondent denied the aforementioned allegations, and the case went to trial accordingly. The trial judge concluded, on the evidence and notwithstanding that the registered title was in the Director of the Veterans' Land Act, that the appellant should have a one-quarter interest in the net value of the property. He noted that the respondent had remarried and that the appellant planned to remarry.

On appeal, the British Columbia Court of Appeal allowed the appeal on the ground that the now respondent had no interest in the property which was entirely in the Director of the Veterans' Land Act.

Leave to appeal to this Court was given principally to consider the validity and applicability of the Veterans' Land Act and, in the result, both the Attorney General of British Columbia and the Attorney General of Canada intervened.

A motion by the appellant in this Court, returnable at the hearing of the appeal, to adduce fresh evidence by way of an affidavit sworn by Douglas E. Humphrey, Director, Property and Securities Division, in the Veterans' Land Act Administration, was granted, with reasons to be delivered later. The affidavit disclosed that on July 29, 1974, the respondent applied to the Regional Director, Veterans' Land Act for a conveyance to him of the property in which title had theretofore been in the Director of the Veterans' Land Act. A conveyance dated July 31, 1974, was executed in the respondent's favour and, pursuant to a letter from the Royal Bank of Canada which had advanced \$5,916.69 to discharge the respondent's indebtedness under the Veterans' Land Act, the conveyance was sent to the bank to be held as security.

Held (Pigeon, Estey, Pratte and McIntyre JJ. dissenting in part): The appeal should be allowed and a one-third interest awarded to the appellant in the property, the calculation of the value of the appellant's interest to be subject to the prior claim of the Royal Bank of Canada for the sum of \$5,916.69 advanced by it to discharge the respondent's indebtedness on the property and the respondent to register his title thereto forthwith in the appropriate Land Registry Office.

Per Laskin C.J. and Martland, Ritchie, Dickson and Beetz JJ.: The special grounds for the admission of new evidence by this Court under the proviso to s. 67 of the Supreme Court Act include a situation where there has been a failure of an officer of the Court, e.g. a trustee in bankruptcy, to bring all the relevant matters to the Court's attention, although the matters were not newly discovered but existed before trial. Equally, they will yield to a situation where a solicitor as an officer of the Court has not brought to the Court's attention pre-existing matters of which he had knowledge or where a party to the proceedings has misled the Court as to facts in issue or has misled his own solicitor or counsel, with the result that the action has proceeded on an erroneous factual basis.

The Court of Appeal was misled by the assertion in the now respondent's notice of appeal that "legal title" to the property was in the Director of the Veteran's Land Act. In fact, as between the respondent and the Director it was in the respondent long before the action was begun. The transfer of title to the respondent did not become known to appellant's counsel until the leave to appeal to this Court was granted.

There was no justification for the resistance of counsel for the respondent to the admission of the evidence contained in the Humphrey affidavit. Its admission would mean only that the constitutional issue could be put to one side and the claim of the appellant determined on a proper factual basis as

between her and the respondent. Refuge in the pleadings at trial and in the record at trial, as sought by counsel for the respondent, irrespective of the wrongful assertion as to title by the respondent on appeal to the Court of Appeal and, again, in his affidavit on taxation of costs after the appeal was determined in his favour, would mean insistence on a state of facts which were untrue and which would involve this Court in a constitutional exercise which would be unnecessary if the truth had been told.

The new evidence sought to be adduced would not have involved any change in the cause of action, but bespoke a failure of candour by the respondent in order to take advantage of the appellant if he could. No Court can condone attempts to mislead it; and if the respondent put his counsel in an unenviable position, the Court was entitled to have their co-operation in clarifying the record once they became aware of the true state of the title.

As to the merits of the appellant's claim, the question was whether the trial judge's award of a one-quarter interest in the property should be affirmed and the appeal allowed accordingly, or whether a larger interest should be awarded. Although an appellate Court, and especially an ultimate Court, should ordinarily refrain from interfering with the exercise by a trial judge of the type of broad discretionary jurisdiction conferred by s. 8 of the Family Relations Act, there was the fact that the trial judge acted on certain irrelevant considerations and ignored relevant ones and that the Court of appeal was misled as to the legal title and thus did not address itself to the exercise of the discretionary authority of the trial judge. In all the circumstances, it would be equitable and just that the appellant be awarded a one-third interest in the property, and that it be based on the present value of the property, less the sum of \$5,916.69 advanced by the Royal Bank to discharge the respondent's indebtedness to the Director of the Veterans' Land act.

Per Pigeon, Estey, Pratte and McIntyre JJ., dissenting in part: The fundamental question raised in this Court was narrow and simple. Should this Court, on the record of this appeal, review the exercise of the discretion of the trial judge under s. 8 of the Family Relations Act? An appellate Court should be extremely reluctant to interfere with the exercise of a discretionary power by a trial judge. However, there are cases where justice demands that the exercise of discretion be reviewed. This was one such case because the trial judge had proceeded on the basis of certain irrelevant and erroneous considerations. Also, the new evidence adduced in this Court raised serious questions as to the credibility of the respondent, and it was not at all clear that the trial judge would have reached the conclusion that he did had he been made aware of the true facts.

It was impossible to weigh the relative contributions of the spouses to the joint venture, and it would require a very extensive and elaborate hearing to thrash out in detail all the admissible evidence that could be garnered in support of their competing claims with respect to the acquisition of this home. Family law as it has evolved in this country has not found it necessary or indeed in the public interest to require parties to these differences to so litigate their disputes.

A court exercising its discretion under s. 8 of the Family Relations Act is not in any way bound by the line of cases in this Court and in England which have limited the discretion of a trial judge under the various Married Women's Property Act statutes. Also, as was the view of Hinkson J.A. in *Deleeuw v. Deleeuw* (1977), 5 B.C.L.R. 106, it is not a necessary prerequisite to obtaining relief pursuant to the provisions of s. 8 that an applicant "show that he or she has in some real way contributed to the acquisition of the property in question or has done something to enhance or maintain its value..."

It has become a reality of life and indeed of family law, at least in the common law provinces of this country, that trial judges in all levels of the courts have recognized as a general principle that the husband and wife divide up family properties on a 50/50 basis unless the circumstances otherwise require. There may be a great number of instances where the general rule of 50/50 is moderated or adjusted by reason of

the origin of specific assets or by reason of unusual contributions.

While it might be said that the recognition of the one-half interest in the wife is judicial legislation bringing about a community of property without expressly so stating and without deferring on such a policy matter to the Legislature, such was not the case, even though in many provinces such a result has been reached by legislation. The realities of life today require a recognition in the courts that the parties enter into not the marital contract but the ensuing social joint venture on the basis that each spouse will play his or her assigned role without deliberate and final agreement, and certainly without daily or periodic accounting. The common and basic intent is clearly a sharing of the good with the bad, the debts and the assets.

In this proceeding it was clear that the wife was not forced to found her claim to an interest in the husband's property on the fact of marriage alone. The process of valuation of contribution has its economic limits when applied to an interspousal dispute. Here the record revealed sufficient of their respective contributions to allow allocation by approximation. The trial judge had misdirected himself and thereby the exercise of discretion became reviewable. A proper exercise of discretion would find the wife entitled to a one-half interest in the matrimonial home.

The appeal should be allowed and an order directed that the lands and premises be valued at the date of judgment either by agreement between the parties or in a manner as provided, and that there be deducted from such valuation (a) the sum of \$5,916.69 being the moneys paid by the respondent to the Director, Veterans' Land Act, and (b) the sum of \$3,786 being the contribution by the husband to the premises, and that the net remaining value be divided one-half to the appellant and one-half to the respondent; and that the respondent register his title to the lands forthwith in the appropriate Land Registry Office.

Cases Cited

Dormuth and Ursel v. Untereiner and Muskovitch, [1964] S.C.R. 122; Brown v. Gentleman, [1971] S.C.R. 501; Rathwell v. Rathwell, [1978] 2 S.C.R. 436, referred to.

APPEAL by the plaintiff from a judgment of the Court of Appeal for British Columbia, reversing a judgment of Stewart L.J.S.C., in an action taken pursuant to s. 8 of the Family Relations Act, 1972 (B.C.), c. 20. Appeal allowed and a one-third interest awarded to the appellant, Pigeon, Estey, Pratte and McIntyre JJ. dissenting in part.

Robert Doell and Miss Deborah Acheson, for the plaintiff, appellant.
John W. Horn, for the defendant, respondent.

Solicitors for the plaintiff, appellant: Stevenson, Doell & Co., Victoria.
Solicitors for the defendant, respondent: Badovinac, Scoffield & Mosley, Port Alberni.

The judgment of Laskin C.J. and Martland, Ritchie, Dickson and Beetz JJ. was delivered by

LASKIN C.J.:-- This appeal, which is here by leave of this Court granted on March 7, 1978, concerns the entitlement of the appellant, the divorced wife of the respondent, to an interest in what was their matrimonial home. The action proceeded through trial and to appeal to the British Columbia Court of Appeal on the footing that the title to the property was, as between the respondent Harper and the

Director of the Veterans' Land Act in the Director who was and is shown as the registered owner under the British Columbia Land Registry Act. The house on the property had been constructed through financing arrangements under the Veterans' Land Act, now R.S.C. 1970, c. V-4, as amended, and title was put in the name of the Director pursuant to that Act.

The appellant brought her action under the Family Relations Act, 1972 (B.C.), c. 20, on May 9, 1975. Prior to the enactment of this statute, she had commenced a so-called trust action in 1971 when she was still formally married to the respondent, and a *lis pendens* was registered against the property in that action. It has, however, remained dormant and she later sought relief under s. 8 of the Family Relations Act, which reads as follows:

8. (1) Where the court makes an order for dissolution of marriage or judicial separation, or declaring a marriage to be null and void, and it appears that a spouse is entitled to any property, it may, not more than two years from the date of the order, make any order that, in its opinion, should be made to provide for the application of all or part of the property, including settled property, for the benefit of either or both spouses or a child of a spouse or of the marriage.

(2) Where the court makes an order under subsection (1), it may order that the property be sold and direct the disposition of the proceeds.

In her statement of claim, dated August 8, 1975, the appellant asserted, which was a fact, that the property in question was occupied by the respondent and was registered in the name of the Director of the Veterans' Land Act. Paragraphs 6 and 7 of the statement of claim are as follows:

The aforesaid lands and premises were purchased by the Plaintiff and Defendant on or about May 8th, 1962 with funds borrowed jointly from the Port Alberni Credit Union and were transferred into the name of the Director of the Veterans' Land Act on the 13th of August 1962.

The aforesaid lands and premises were used as the matrimonial home by the Plaintiff and Defendant from the date of the completion of the construction of the premises on or about June 1st, 1963 until the 21st day of December 1968, when the Plaintiff left the matrimonial home, fearing for her mental health.

Alleging, further, that the ownership of the land and premises had always been considered a joint venture, the appellant claimed in para. 9 of her statement of claim an undivided half interest in the property "as a result of her contributions towards the economic wealth of the family as a whole". The respondent denied the allegations in paras. 6, 7 and 9 above mentioned, and the case went to trial accordingly. The trial judge, His Honour Judge Stewart, acting as a Local Judge of the Supreme Court of British Columbia, concluded, on the evidence and notwithstanding that the registered title was in the Director of the Veterans' Land Act, that the appellant should have a one-quarter interest in the net value of the property. He noted that the respondent had remarried and that the appellant planned to remarry. He said this in the concluding portion of his reasons:

As far as I can judge each party was as much to blame as the other for the breakdown of their marriage. No attempt at reconciliation was made by either. The defendant eventually obtained the divorce some five years after the separation and at that time the plaintiff made no effort to advance a claim to the home property. Thereafter the defendant started to build a new life for himself

around the home in which the plaintiff claims a half interest. His new wife has invested a substantial amount in improvements. He has one child of the marriage with him. He is contributing to the maintenance of those now with the plaintiff. I have concluded that an allocation equivalent to a one-quarter interest in the net value of the property would be fair.

If the parties are unable to agree on value and the steps required to give effect to this application of the property, I will deal with the matter after hearing counsel, who may also wish to speak to costs.

The respondent appealed on May 5, 1976, being represented on the hearing of the appeal by Mr. J.W. Horn. His counsel at the trial was R.A. Scoffield, who also signed the notice of appeal. That notice contained the following assertions in paras. 1 and 2 thereof:

1. The learned Judge erred in the law in holding that the Appellant is a spouse "entitled to property" the subject of the case at bar, where the legal title to such property is held by the Director, the Veterans' Land Act.
2. The learned Judge erred in law in holding that the Respondent is a spouse entitled to property" the subject of the case at bar, where the legal title to such property is held by the Director, the Veterans' Land Act.

In his factum on the appeal, counsel for the appellant, respondent on the appeal to the British Columbia Court of Appeal, said this in para. 7 of the factum:

The indebtedness of the Director was retired in 1974 but the husband has not exercised his right pursuant to s. 11 of the Veterans' Land Act to call for title to be placed in his name.

An affidavit produced in support of the now respondent Harper pointed out that there was nothing in the record to support the aforementioned statement.

The British Columbia Court of Appeal allowed the appeal on the ground that the now respondent had no interest in the property which was entirely in the Director of the Veterans' Land Act. In the course of his reasons for the Court, Farris C.J.B.C. said this:

... The title to the land has remained in the Director ever since the conveyance to him. At the trial, no evidence apparently was led to show ... the present state of the account between the veteran husband and the Director.

Mr. Doell, Counsel for the wife Respondent, was unable to point to any evidence in the Appeal Book to support his statement in the factum, paragraph 7, that the indebtedness of the Director was retired in 1974. So that is the factual situation. It is clear to me, from an examination of the documents, that the arrangements with the Director of Veterans' Land Act, were made pursuant to Part II of the Veterans' Land Act.

Section 59(1) provides for a reconveyance by the Director to the veteran, when all the necessary payments have been made. We do not know from the evidence here, whether all the necessary payments have been made.

Section 60, subsection 2 of the Act provides:

"Nothing in this Part, and nothing in any contract or collateral agreement entered into under section 55 or 57 shall be construed as conferring upon or vesting in any veteran, prior to the conveyance to that veteran by the Director under subsection 59(1) of the land in respect of which the contract or agreement was entered into, any right, title, interest or estate in that land."

So, at the time of trial, no conveyance having been made to the veteran, by the Director, the veteran had no right, title, interest or estate in the land.

This application is brought under Section 8 of the Family Relations Act, which provides, as has been noted above: "it appears that a spouse is entitled to any property."

At the time of the trial, he was not entitled to any property, because the conveyance, the title was in the Director, and Section 60, subsection 2, expressly says he is not.

Now this was not an action where an application was made, or where it was alleged in the pleadings that all the money had been paid, that the husband veteran had the right to acquire title, and for an application that an injunction be granted ordering him to apply and obtain title. That was not the basis upon which this case was presented. It was on the basis of a claim under Section 8, for an order in relation to the land, and as I have said, the husband at that stage had no entitlement to it.

Then there is the further difficulty in this case, that there was no evidence as to the present value of the property in question.

It seems to me that in exercising the discretion that is given under Section 8, it can only be properly exercised if you know what you are dividing, and its value.

...

Now those proceedings, take place after the exercise of the discretion by the Trial Judge, and in my view, he had no material before him upon which he could exercise a judicial discretion, which is required under Section 8 of the Family Relations Act.

Leave to appeal to this Court was given principally to consider the validity and applicability of the Veterans' Land Act and, in the result, both the Attorney General of British Columbia and the Attorney General of Canada intervened.

I have enlarged on the pleadings and on the position taken on appeal to the provincial Court of Appeal because of a motion by the appellant in this Court, returnable at the hearing of her appeal, to adduce fresh evidence by way of an affidavit sworn by Douglas E. Humphrey, Director, Property and Securities Division, in the Veterans' Land Act Administration. The affidavit discloses that on July 29, 1974, the respondent applied to the Regional Director, Veterans' Land Act for a conveyance to him of the property in which title had theretofore been in the Director of the Veterans' Land Act. A conveyance

dated July 31, 1974, was executed in the respondent's favour and, pursuant to a letter from the Royal Bank of Canada which had advanced \$5,916.69 to discharge the respondent's indebtedness under the Veterans' Land Act, the conveyance was sent to the bank to be held as security.

The general principles which govern the admission of new evidence in this Court were stated in *Dormuth and Ursel v. Untereiner and Muskovitch* [[1964] S.C.R. 122], at p. 131, where Ritchie J., speaking for the majority, referred to an earlier case in this Court concerning the admission of evidence discovered after trial and sought to be admitted in a provincial Court of Appeal. He then continued as follows:

The above statements were made with respect to the role of a court of first appeal in relation to evidence discovered after the trial but, in my view the same considerations apply when evidence is tendered for the first time before this Court on appeal from a provincial Court of Appeal. The special grounds required in an application made under the proviso to s. 67 include, in my opinion, being able to show that the evidence could not have been discovered by reasonable diligence before the conclusion of the hearing in the Court of Appeal and being able also to satisfy this Court that the evidence, if accepted, would be practically conclusive.

It is clear that Justice Ritchie did not lay down an exhaustive test for the admissibility of fresh evidence in the Supreme Court, saying only what the special grounds under the proviso to s. 67 include. In my opinion, they also include a situation where there has been a failure of an officer of the Court, e.g. a trustee in bankruptcy, to bring all the relevant matters to the Court's attention, although the matters were not newly discovered but existed before trial: see *Brown v. Gentleman* [[1971] S.C.R. 501]. Equally, in my opinion, they will yield to a situation where a solicitor as an officer of the Court has not brought to the Court's attention pre-existing matters of which he had knowledge or where a party to the proceedings has misled the Court as to facts in issue or has misled his own solicitor or counsel, with the result that the action has proceeded on an erroneous factual basis.

In view of the disposition of the appeal by the British Columbia Court of Appeal (the appeal was heard on November 15, 1977 and disposed of on that day in oral reasons for judgment), it is clear that that Court was misled by the assertion in the now respondent's notice of appeal that "legal title" to the property was in the Director of the Veterans' Land Act. In fact, as between the respondent and the Director it was in the respondent long before the action was begun. In his affidavit in support of the motion to adduce new evidence, counsel who appeared for the appellant in the Courts below made the following assertions in paras. 21, 22, 23, 25 and 26:

21. THAT I became aware that the indebtedness of the Director had been retired in 1974 in the fall of 1977 prior to the hearing before the British Columbia Court of Appeal, by reason of a telephone call placed to a Mr. Birrell at the Office of the Director, Department of Veterans' Affairs, Victoria, British Columbia, on or about the 9th day of September, 1977.
22. THAT I was not advised that legal title had been delivered to the Defendant Eldon Stewart Harper during that conversation.
23. THAT the factum of the Appellant, Eldon Stewart Harper, was filed on May 24, 1977. The following is alleged in the statement of facts of that factum:
 - "8. The Defendant applied to the Director of Veterans' Land Act for financing to build a home and the application was granted. (A.B. p. 179, 1.24)
 9. A contract was entered into with the Director on the 13th day of

- September, 1962, (A.B. p. 163, Exhibit 7) and the property was conveyed to the Director on the 3rd day of August, 1962. (A.B. p. 174, Exhibit 8)
10. The Title remained in the Director at the time of action. (A.B. p. 153, Exhibit 3)."

The aforementioned facts of factum are annexed hereto and marked as Exhibit "II" to this my Affidavit.

...

25. THAT in the taxation of the Defendant's bill of costs in the Family Relations Act action a further Affidavit of Eldon Stewart Harper was sworn the 5th day of January, 1978 and filed January 9, 1978. THAT annexed and marked as Exhibit "I" hereto is a copy of the aforementioned Affidavit which reads, in paragraph 2:

"THAT I am purchaser by unregistered agreement for the sale of land where The Director, The Veterans' Land Act, is Vendor of lands and premises situate in the Alberni Assessment District, Beaver Creek Improvement District, Province of British Columbia, more particularly known and described as:

Lot 24, District Lot 166, Alberni District, Plan 1474,

(hereinafter referred to as the "Premises")."

26. THAT on or about the 11th day of July, 1978, I received an anonymous telephone call from a male person who disclosed that he was calling from Ottawa. That person advised me that legal title to the said matrimonial property had been reconveyed to the veteran in 1974.

It appears, therefore, that the transfer of title to the respondent did not become known to appellant's counsel until the leave to appeal to this Court was granted.

Counsel for the respondent in this Court said that he became aware in late 1977 that respondent's debt to the Director of the Veterans' Land Act had been satisfied but he did not know of any transfer of title to the respondent. This Court does not have any affidavit from Mr. Horn's instructing solicitor, Mr. R.A. Scoffield, who represented the respondent at the trial and who signed the notice of appeal to the British Columbia Court of Appeal, as to what he knew or whether his client the respondent had omitted to tell him about the conveyance from the Director of the Veterans' Land Act. Certainly, if there was any knowledge of the conveyance, the proper course would be to disclose it (in answer to the usual notice to produce relevant documents) or to refuse to continue acting for the respondent.

Before this Court, counsel for the respondent took a technical position on the motion to adduce fresh evidence, contending that he was under no obligation to assist the appellant in her action and that he was entitled to stand by the record of the proceedings before and at trial. It is evident, however, from the material that I have canvassed that the respondent could not properly rest on those proceedings, certainly not after the matter went to appeal and certainly not in the light of what was included in the affidavit of Mr. Humphrey and of Mr. Doell, the appellant's counsel. (I should say here that Mr. Doell did not argue the motion for leave to adduce new evidence.) There are the further relevant facts that we are concerned with a claim to an interest in the matrimonial home, a family issue to be judged equitably, and that by

reason of the non-disclosure of the conveyance, a serious constitutional issue was necessarily raised which brought interventions from the provincial and federal Attorneys-General.

I am bound to say--all members of this Court reacted the same way--that I was unable to understand the resistance of counsel for the respondent to the admission of the evidence contained in the Humphrey affidavit. Its admission would mean only that the constitutional issue could be put to one side and the claim of the appellant determined on a proper factual basis as between her and the respondent. Refuge in the pleadings at trial and in the record at trial, as sought by counsel for the respondent, irrespective of the wrongful assertion as to title by the respondent on appeal to the Court of Appeal and, again, in his affidavit on taxation of costs after the appeal was determined in his favour, would mean insistence on a state of facts which were untrue and which would involve this Court in a constitutional exercise which would be unnecessary if the truth had been told.

The new evidence sought to be adduced would not involve any change in the cause of action, but bespeaks a failure of candour by the respondent in order to take advantage of the appellant if he could. No Court can condone attempts to mislead it; and if the respondent put his counsel, be he Mr. Scoffield or Mr. Horn, in an unenviable position, the Court is entitled to have their cooperation in clarifying the record once they have become aware of the true state of the title.

At the conclusion of the hearing of the motion for leave to adduce new evidence, the Court was unanimously of the opinion that the motion should be granted, with costs of the motion to the successful appellant and with reasons to be delivered later. The reasons have been set out in what has gone before, and I turn now to the merits in the light of the newly admitted evidence.

The constitutional question has now disappeared and counsel for the respective Attorneys-General asked to withdraw, having no submissions to make on the merits. They were, accordingly, excused and, although they felt they should have some costs in view of the unnecessary trouble to which they were put, a not unreasonable position for them to take, I think it best to follow this Court's general rule that no costs are awarded to or against any intervenant.

On the merits of the appellant's claim, the question is whether the trial judge's award of a one-quarter interest in the property should be affirmed and the appeal allowed accordingly, or whether a larger interest should be awarded. Counsel for both parties expressed the wish that this case be finally resolved here and not be sent back for retrial and, in my opinion, this wish should be accommodated.

Section 8(2) of the Family Relations Act leaves a large discretion to the trial judge. In my view, the observations of the British Columbia Court of Appeal that there was no proper basis for the exercise of a judicial discretion must be taken in the light of its concern with the application of the Veterans' Land Act. I am of the same view in respect of the Court of Appeal's statement that there was a further difficulty in the case because of the absence of evidence as to the present value of the property. Since title is now in the respondent, I do not think that the question of lack of evidence as to value of the property can militate against the making of an order in the appellant's favour.

I have already quoted the considerations that moved the trial judge to his conclusion that the wife should be allowed a one-quarter interest in the property. There are a number of comments to be made on the considerations on which the trial judge appears to have acted. Whether or not attempts at reconciliation were made, the appellant's claim cannot be discounted on the ground that no such attempts were made by either spouse. Again, it was wrong to suggest a failure by the appellant to advance a claim to the matrimonial property at the time of the divorce when it is clear that since the institution of her trust action in 1971 she had asserted an interest in the matrimonial home. Furthermore, the fact that the husband had started to build a new life for himself in the home and was contributing to the maintenance

of the children residing with the appellant are not grounds for affecting her claim to a property settlement; see *Rathwell v. Rathwell* [[1978] 2 S.C.R. 436], per Dickson J., at p. 462.

In my opinion, the trial judge ought to have also considered as a factor in the appellant's favour that the respondent has had the use and occupation of the subject property for some ten years since the parties separated. I do not think that this can be discounted by reason of the respondent's remarriage and of the fact that his new wife has paid for some improvements to the property by an outlay of about \$5,000.

Although an appellate Court, and especially an ultimate Court, should ordinarily refrain from interfering with the exercise by a trial judge of the type of broad discretionary jurisdiction conferred by s. 8 of the Family Relations Act, there is the fact that the trial judge acted on certain irrelevant considerations and ignored relevant ones and that the British Columbia Court of Appeal was misled as to the legal title and thus did not address itself to the exercise of the discretionary authority of the trial judge. In all the circumstances, it would be equitable and just that the appellant be awarded a one-third interest in the property, and that it be based on the present value of the property, less the sum of \$5,916.69 advanced by the Royal Bank to discharge the respondent's indebtedness to the Director of the Veterans' Land Act.

The proper order to make is that this appeal be allowed, that the judgments on appeal and at trial be set aside and that a one-third interest be awarded to the appellant in the property, that the calculation of the value of the appellant's interest be subject to the prior claim of the Royal Bank of Canada for the sum of \$5,916.69 advanced by it to discharge the respondent's indebtedness on the property and that the respondent register his title thereto forthwith in the appropriate Land Registry Office. If the parties cannot agree on the sum of money representing the interest herein accorded to the appellant, the question should be referred either to the trial judge or to another Local Judge of the Supreme Court of British Columbia for determination upon such appraisal evidence as may be brought before him. The respondent shall pay to the appellant the sum agreed upon or determined by the Local Judge, and the property shall be charged therewith until payment, with interest at five per cent per annum from the date of this judgment, or the Local Judge may order a sale of the property to realize the appellant's interest.

The appellant is entitled to costs throughout as well as to costs of the motion to adduce new evidence.

The reasons of Pigeon, Estey, Pratte and McIntyre JJ. were delivered by

ESTEY J. (dissenting in part):-- This appeal concerns the award of an interest to the wife in the family home pursuant to an action brought under s. 8 of the Family Relations Act, 1972 (B.C.), c. 20. The trial judge awarded an undivided one-quarter interest in the wife with a reference to the Registrar of the Court to determine the value thereof in the event the parties cannot agree. The Court of Appeal set aside the award and dismissed the wife's action. This Court is invited to restore the trial judgment but revise the allocation to the wife upwards from a 1/4 to a 1/2 interest.

A preliminary matter of some importance arose with reference to the conduct of the husband's case, particularly in the Court of Appeal. These circumstances are reviewed by the Chief Justice and need not be repeated for my purposes here. I am concerned with the disposition of the basic appeal after the new evidence has been admitted by this Court.

The evidence introduced by and on behalf of the two spouses is typical in a matrimonial dispute where, after the divorce, proceedings are launched under provincial legislation to divide up the family assets. Unfortunately, this has been done in this action in a very expensive manner. A short chronology of events is all that is required to set the stage. The parties were married in 1949. Neither brought any assets into the marriage. There are seven children of the marriage. The family lived in rented accommodation

until 1962 when the property which is the subject-matter of this dispute was purchased. The parties separated in 1968. The wife and the three infant children lived separate and apart in the City of Victoria. One of these children is now living with the respondent. In 1971 she brought an action in the Supreme Court of British Columbia for a declaration that the husband held an undivided one-half interest in the matrimonial home in trust for and on behalf of the appellant. At that time, it is now clear that the title to the matrimonial home was in fact and in law in The Director, Veterans' Land Act. The Family Relations Act, *supra*, was proclaimed in force on July 1, 1972. After the commencement of this Act, the trust action was held in abeyance.

The respondent brought an application for divorce on the basis of three years separation, and a Decree Absolute was issued in 1973. The appellant has been receiving \$45 monthly for her own maintenance and \$35 monthly for each child residing with her.

By an action commenced in May 1975, under the Family Relations Act, *supra*, the wife sought a one-half interest in the family home. Counsel for the wife explained the delay in the bringing of these proceedings under the provincial legislation as being due to the impecuniosity of the wife, and it is obvious from the state of affairs of the family as revealed on the record that this is true. It is this action which is the basis of this appeal.

In the statement of claim the wife pleaded that the matrimonial home was "registered in the name of the Director of the Veterans' Land Act ..." and at the date of the statement of claim, and indeed today, this is true. In the meantime, but only in response to a motion brought in this Court by the wife, it is learned that the husband paid off the Director in August 1974 and received a deed to the land from the Director of the Veterans' Land Act transferring title to the husband. The husband had directed the Director to deliver the deed to the Royal Bank of Canada as security for a loan, the proceeds of which may indeed have been paid over in whole or in part to the Director in order to support the deed conveying the land to the husband. In any case it is clear that when the action was commenced by the wife, the husband had received a deed from the Director, Veterans' Land Act and therefore the Director at that time had no interest in the land whatsoever.

The husband, in his statement of defence and in his position throughout the trial, simply agreed that the land was in fact registered in the name of the Director, Veterans' Land Act and apparently chose, in response to a notice to produce, not to confess to the receipt of the deed from the Director, Veterans' Land Act. Hence the matter proceeded through trial to judgment on the assumption by the wife and indeed the trial judge that title was in law and in fact still in the Director, Veterans' Land Act.

From the judgment at trial awarding a one-quarter interest in the wife, the husband appealed asserting in the Notice of Appeal as the first two grounds that:

1. The learned Judge erred in the law in holding that the Appellant [husband] is a spouse "entitled to ... property" the subject of the case at bar, where the legal title to such property is held by the Director, the Veterans' Land Act.
2. The learned Judge erred in law in holding that the Respondent [wife] is a spouse "entitled to ... property" the subject of the case at bar, where the legal title to such property is held by the Director, the Veterans' Land Act.

In the Court of Appeal the question as to the state of the title arose, apparently, by reason of an assertion in the factum of the wife that the Director, Veterans' Land Act had been paid off by the husband, but as the counsel for the wife was unable to point to anything on the record to substantiate this submission, the Chief Justice of the Court stated, in giving oral judgment:

So, at the time, no conveyance having been made to the veteran by the Director, the veteran had no right, title, estate, interest in the land.

Counsel for the husband in this Court stated that he made no response in the Court of Appeal when this statement was made by the Chief Justice in giving oral judgment. It may be that counsel was unaware of the facts at that time and, in any case, the matter only came to light by reason of an anonymous telephone call from someone in Ottawa to the wife advising her that the husband had received long ago a deed of the land from the Director. The wife by that time had appealed these proceedings to this Court and consequently made application for the admission of new evidence to establish the ownership of the land throughout all these proceedings. For reasons that entirely escape my understanding, the husband opposed the admission of this new evidence.

The fundamental question raised in this Court is narrow and simple. Should this Court, on the record of this appeal, review the exercise of the discretion of the learned trial judge under s. 8 of the British Columbia statute? Section 8 provides as follows:

8. (1) Where the court makes an order for dissolution of marriage or judicial separation, or declaring a marriage to be null and void, and it appears that a spouse is entitled to any property, it may, not more than two years from the date of the order, make any order that, in its opinion, should be made to provide for the application of all or part of the property, including settled property, for the benefit of either or both spouses or a child of a spouse or of the marriage.
- (2) Where the court makes an order under subsection (1), it may order that the property be sold and direct the disposition of the proceeds.

In my view, it is a proper case for this Court to review the trial judge's discretion because the trial judge proceeded on the basis of irrelevant and erroneous considerations. The learned trial judge concluded that the wife has a one-quarter interest in the property after stating the following:

As far as I can judge each party was as much to blame as the other for the breakdown of their marriage. No attempt at reconciliation was made by either. The defendant eventually obtained the divorce some five years after the separation and at that time the plaintiff made no effort to advance a claim to the home property. Thereafter the defendant started to build a new life for himself around the home in which the plaintiff claims a half interest. His new wife has invested a substantial amount in improvements. He has one child of the marriage with him. He is contributing to the maintenance of those now with the plaintiff. I have concluded that an allocation equivalent to a one-quarter interest in the net value of the property would be fair.

The appellant began the trust action, discussed earlier, in 1971 and therefore it is incorrect to state that "... The defendant eventually obtained the divorce some five years after the separation and at that time the plaintiff made no effort to advance a claim to the home property." The appellant has at all times maintained that she has an interest in the matrimonial home.

It can also be seen that the trial court revealed a consideration of at least three irrelevant elements:

- (a) that no attempt at reconciliation had been made;
- (b) the defendant (the husband) had started to build a new life for himself around the home in which the plaintiff claims a one-half interest;

- (c) the bare fact that the husband has been contributing to the maintenance of the wife and of the children residing with her. (This may on a later consideration of future entitlements be reflected in the inter-spousal account.) In the case of *Garratt v. Garratt* [(1974), 16 R.F.L. 168 (B.C.S.C.)], Hutcheon L.J.S.C., quite correctly in my view, stated that "... the question of maintenance whether by a lump sum or by periodic payment, ought not to be confused with the question of property settlement." (p. 170) In the case of *Rathwell v. Rathwell* [[1978] 2 S.C.R. 436], Dickson J. stated:

It was argued that Mrs. Rathwell should be denied a proprietary interest because she was awarded \$250 per month maintenance. I agree with the Saskatchewan Court of Appeal in the present case that an order for alimony and maintenance in her favour does not bar a wife from seeking a further order declaring that she has an equitable proprietary interest. The two forms of relief are obtained in separate actions based on different legal rights. They are related only to the extent that the wife's success in the latter proceeding may permit the husband to seek a change in the award of alimony and maintenance in the earlier proceeding. (p. 462)

It should also be noted that the new evidence adduced in this Court raises serious questions as to the credibility of the respondent, and it is not at all clear that the trial judge would have reached the conclusion he did had he been made aware of the true facts.

An appellate Court should be extremely reluctant to interfere with the exercise of a discretionary power by a trial judge. However, there are cases, and for the reasons given above I believe this is one, where justice demands that the exercise of discretion be reviewed.

If a judge proceeds on principle properly applicable to the facts of a case and makes a decision judicially, in the exercise of his discretion, this Court will not interfere. But, if it appears that a judge has misdirected himself, or that his decision is so clearly wrong as to amount to an injustice, the Court can and should review the facts upon which the judgment ought to be given. (*Re Hull Estate* [[1943] O.R. 778 (C.A.)] per Laidlaw J.A. p. 785)

I note also that in the case of *Deleeuw v. Deleeuw* [(1977), 5 B.C.L.R. 106], the Court of Appeal reviewed the trial judge's discretionary exercise of the s. 8 power and concluded that "the learned trial judge had applied a wrong test to the interpretation of s. 8 ..." (p. 113). In this case, because of the respondent's success before the Court of Appeal, that Court did not review the trial judge's application of s. 8.

The evidence, as I have stated at the outset, is typical of the unfortunate circumstances attendant upon the breakup of a family. It is impossible to weigh the relative contributions of the spouses to the joint venture, if I may use that term without intending to thereby attribute unusual legal consequences to the marital union. The husband made his contribution by the direct investment of time, effort and money. The wife made her contribution less directly, but no less importantly, through the management of the family so as to release the husband for sufficient time to make his contribution to the construction of the house built by the family on the lands in question. She did more than that. The evidence is clear that she fed, and in at least one instance housed, persons who helped with the carpentry and other physical elements in the construction of the home. She also executed a chattel mortgage securing the funds which enabled the husband to acquire the property which he then conveyed to the Director, Veterans' Land Act

so as to obtain the funds with which the house was built. This loan was secured in part against the household goods of the family and there is no evidence that the wife did not own at least a part of or have an interest in those goods.

The learned trial judge stated in a summary way his conclusions with reference to the ultimate ownership of this property:

There was at no time any discussion between the parties on the question of ultimate ownership of the property, nor would one expect there to have been any. The defendant now says that throughout it was his clear intention to retain ownership himself giving as a reason the instability of his marriage. He may have convinced himself that this was the case but I have no faith in that testimony. I am satisfied no thought was given to the question at the time. The parties wanted a better home. This was the only way it could be financed and it was well understood that the defendant alone could be a party to the arrangement with the Director.

The plaintiff was at pains to describe her contribution to outside work around the home in the care of the few animals and fowl and care of the garden. She also made much of her efforts in preserving fruits, vegetables and some meat and fowl. The defendant depreciated these efforts. The only conclusion I can draw from the evidence is that both parties were kept fully occupied in the creation, operation and maintenance of the two homes I have described. There was never any extra money and their responsibilities prevented joint holidays of significance. During all this time the defendant was employed and the plaintiff's duties included the catering to the needs of a number of boarders from time [sic].

It would require a very extensive and elaborate hearing to thrash out in detail all the admissible evidence that could be garnered in support of the competing claims of husband and wife with respect to the acquisition of this home. Family law as we have seen it evolve in this country has not found it necessary or indeed in the public interest to require the parties to these differences to so litigate their disputes. It may be stated with accuracy as well as fairness that in the division of the family assets upon the destruction of the marital union, the courts have sought to do justice as expeditiously as can fairly be done because it is the single, disintegrating family unit which bears the legal costs of both sides of the contest. Hence it has not been necessary in the ordinary case to demonstrate values of the properties being divided except in those instances where sale is not a realistic alternative in the event of disagreement, or where it is in the interest of the parties to divide property in specie. Such is not the case here.

It should be noted that a court exercising its discretion under s. 8 of the Family Relations Act is not in any way bound by the line of cases in this Court and in England which have limited the discretion of a trial judge under the various Married Women's Property Act statutes. I am here referring to such cases as *Murdoch v. Murdoch* [[1975] 1 S.C.R. 423] and *Thompson v. Thompson* [[1961] S.C.R. 3]. I agree entirely with the following description of the effect of s. 8 given by Munroe J. in the case of *Stevenson v. Stevenson* [(1974), 15 R.F.L. 248 (B.C.S.C.)], at p. 250:

It is the submission of counsel for Mr. Stevenson that s. 8 has made no change in the substantive law and that accordingly the law as enunciated by the Supreme Court of Canada in such cases as *Thompson v. Thompson*, [1961] S.C.R. 3, 26 D.L.R. (2d) 1, and *Murdoch v. Murdoch*, 1 R.F.L. 185, [1974] 1 W.W.R. 361, 41 D.L.R. (3d) 367, must govern my disposition of the claims

made herein by the wife. I do not agree. If that is so, s. 8 need not have been enacted and is superfluous. In my respectful opinion, s. 8 confers upon the Court a discretion which it did not previously have—a discretion to make an order that allocates property held in the name of either or both spouses between them and their children in a just and equitable way according to all the circumstances. Section 8 thereby altered the rigours of the common law as it existed prior to its enactment, when determining the property rights of members of a family following dissolution of the marriage of the spouses.

The oft-quoted remarks of Romer L.J. in *Rimmer v. Rimmer* [[1952] 2 All E.R. 863] at p. 866, that "... cases between husband and wife ought not to be governed by the same strict considerations, both at law and in equity, as are commonly applied to the ascertainment of the respective rights of strangers" are applicable to s. 8 cases.

I also agree with Hinkson J.A. in the case of *Deleeuw v. Deleeuw*, *supra*, wherein he states:

A consideration of the provisions of s. 8 of The Family Relations Act does not lead me to conclude that a necessary prerequisite to obtaining relief pursuant to the provisions of that section requires the applicant to show that he or she has in some real way contributed to the acquisition of the property in question or has done something to enhance or maintain its value. Those matters are some of the factors which the judge hearing the application may take into consideration in determining whether or not to exercise his discretion, and in the event it is exercised in favour of the applicant, in further determining the extent to which the applicant is entitled to share in the property. Thus, I think that the learned trial judge was in error in concluding that Mrs. Deleeuw must fail in her application for relief pursuant to the provisions of The Family Relations Act because she had done nothing more than what might naturally be expected of her as a wife and mother. A wife may not be able to show that she played a part in the acquisition of a particular property, yet her frugality and ability to manage may have enabled her husband to enjoy savings which he has shrewdly invested and which have resulted in the acquisition of a particular property. Such a wife is entitled to seek a share in the property so acquired. In a given set of circumstances the court may decide to exercise the discretion in favour of an applicant where the applicant can show no more than the fact that she was a good wife and mother and in that way should be regarded as having contributed to the acquisition of property now registered in the name of the husband.

It has also become a reality of life and indeed of family law, at least in the common law provinces of this country, that trial judges in all levels of the courts have recognized as a general principle that the husband and wife divide up family properties on a 50/50 basis unless the circumstances otherwise require. There may be a great number of instances where the general rule of 50/50 is moderated or adjusted by reason of the origin of specific assets or by reason of unusual contributions.

Many of the British Columbia decisions indicate the division of matrimonial property on a 50/50 basis. (Vide *Shehousky v. Shehousky* [(1974), 17 R.F.L. 269 (B.C.S.C.)]; *Stevenson v. Stevenson* [(1974), 15 R.F.L. 248 (B.C.S.C.)]; *Wiley v. Wiley* [(1971), 6 R.F.L. 36 (B.C.S.C.)]) In the 1975 unreported decision in the case of *MacLoed v. MacLoed*, Meredith J. stated:

What I do consider relevant is the fact that although the plaintiff [husband] brought into the marriage some property from which the assets ultimately

acquired to some extent derived, in the main the creation of those assets must be taken to have been by virtue of the joint efforts of the plaintiff and the defendant: the plaintiff for the most part earned the money, and he worked hard at his improvement of both properties; the defendant devoted her efforts in large part to the five children, joint assets, as it were, of incomparable value.

So I think little or no rational distinction can be drawn between the respective contributions of the husband and the wife to the acquisition of the two properties. I

think their contribution should be regarded as equal and that the assets should, so far as is possible, be divided equally.

In the Manitoba case of *Atamanchuk v. Atamanchuk* [(1955), 15 W.W.R. 301], Duval J. described the "joint purse" approach to the division of assets under the Manitoba statute:

Where there is a joint purse between husband and wife and a common pool into which they put all their resources, it is not consistent that the assets should thereafter be divided with reference to their respective contributions, crediting the husband with the whole of his earnings and the wife with the whole of her earnings. It would be impossible to make any such calculation. It is also clear that when a husband and wife, by agreement, work together in operating a farm and the properties are in the husband's name, he will be held to hold title thereto as a trustee for her to the extent of one-half. See *Jones v. Maynard* [1951] 1 TLR 700, [1951] 1 All ER 802; *Sywack v. Sywack* (1942) 51 Man R 108; *Kropielnicki v. Kropielnicki* [1935] 1 WWR 249; *S. v. S.* (1952) 5 WWR (NS) 523; *Mitchelson v. Mitchelson* (1953) 9 WWR (NS) 316 (p. 305).

(Underlining added.)

It may be said that the recognition of this interest in the wife is judicial legislation bringing about a community of property without expressly so stating and without deferring on such a policy matter to the Legislature. In my view, such is not the case, even though in many provinces (for example, British Columbia and Ontario) such a result has been reached by legislation. As we have seen in *Pettitt v. Pettitt* [1970] A.C. 777, and in *Gissing v. Gissing* [[1971] A.C. 886], the realities of life today require a recognition in the courts that the parties enter into not the marital contract but the ensuing social joint venture on the basis that each spouse will play his or her assigned role without deliberate and finite agreement, and certainly without daily or periodic accounting. The common and basic intent is clearly a sharing of the good with the bad, the debts and the assets. In stating this, I am also quick to agree with that which was said by my colleague, Dickson J., in *Rathwell v. Rathwell*, supra, at p. 448.

A third limit: Although equity is said to favour equality, it is not every contribution which will entitle a spouse to a one-half interest in the matrimonial property. The extent of the interest will be proportionate to the contribution, direct or indirect, of the spouse. Where the contributions are unequal, the shares will be unequal. A spouse who fails to make a contribution has no claim in justice to assets acquired wholly by the efforts of the other spouse.

Canadian common law does not recognize the concept of community of property resulting from the sole fact of marriage. In the absence of legislative provision to that effect, it is not proper for a court to upset current matrimonial

property practice by acting as if such an institution existed. This is a point of great importance and needs re-emphasis here. See *Pettitt v. Pettitt*, supra, at p. 803. But it must also be noted that there is a considerable distinction between judicial legislation of community of property and judicial enforcement of the equitable doctrines of resulting and constructive trust. It is understandable that confusion between the two should arise in matrimonial property disputes for the apparent net effect of each is normally a divestiture of property, or an interest in it, and transfer from the titled to the non-titled spouse. The essential difference, however, is that the divestiture from community of property has as its source the fact of marriage; the divestiture in trust arises out of a common intention (resulting trust), or out of inequitable withholding resulting in an unjust enrichment (constructive trust).

In this proceeding it is clear that the wife is not forced to found her claim to an interest in the husband's property on the fact of marriage alone. The finding by the trial judge, if anything were needed, makes this abundantly clear. The process of valuation of contribution has its economic limits when applied to an inter-spousal dispute. Here the record reveals sufficient of their respective contributions to allow allocation by approximation, which I observe to be the *modus operandi* of the courts of the country engaged in family law, by reason of the process followed by the learned trial judge in discretion under s. 8 of the British Columbia statute. I conclude that the learned trial judge misdirected himself and thereby the exercise of discretion becomes reviewable, and I conclude that a proper exercise of discretion would find the wife entitled to a one-half interest in the matrimonial home.

The actual formal order issued after trial provided:

AND THIS COURT DOTH ORDER AND ADJUDGE that in the event the parties cannot agree on the value of the Plaintiff's one-quarter (1/4) interest in the aforesaid property as of the date of this Order, then in that event, an enquiry shall be held by the Registrar of this Honourable Court to determine the said value which shall be determined by having the said lands and premises appraised and from the appraisal value, deducting the balance owing by the Defendant to the Director of Veterans' Land Act, and then determining the Plaintiff's one-quarter (1/4) interest on that said amount.

AND THIS COURT DOTH FURTHER ORDER AND ADJUDGE that Judgment herein be lodged with the Director of Veterans' Land Act for the purpose of having the Defendant honour the Plaintiff's interest as determined herein upon sale or disposition of the said property.

As we now know the husband did not make any payment to the Director by reason of that Court Order and the Director did not have any interest in the lands in question at any time throughout these lengthy proceedings. A series of questions must, however, be answered in order to establish the appropriate order at this time. I say at once that in the field of family law, the concept of retrial is abhorrent. Neither the parties nor the community can afford such luxury. This may thrust a burden upon the appellate tribunals, but better the burden be so reposed than placed back on the parties. The husband is, of course, entitled in all fairness to a credit for that which he has paid to clear the title from any claim by the Director, Veterans' Land Act.

This must be so notwithstanding the fact that he co-operated, to put it mildly, in causing this defective provision in the order of the trial court. We know that this payment amounted to \$5,916.69, and in any final accounting the husband should receive a credit for this contribution before the division of the

proceeds of any sale or other dividing processes are determined. As for the contribution said to have been made by the "new wife", may it be observed at the outset that this was made not before some date in 1975, that being the time of the husband's second marriage. By this time the property had been subject to a *lis pendens* filed by the wife for four years. The evidence as to the details of this contribution are extremely brief and for our purposes, very unsatisfactory. Unhappily, no cross-examination occurred with respect to this evidence. There is no documentation of the claim which is stated to amount to \$5,050. Indeed, we do not even know how much, if any, of such contribution relates to real estate and fixtures and how much may relate to personal property which has added nothing to the value of the real estate. The evidence of the husband is that these contributions were "moneys towards the improvement of the house". For example, reference is made to "new drapes" and to carpets. The improvements were apparently brought about by the new wife providing money "for all the material" and the husband doing the work. The new wife is, of course, not a party to these proceedings, and at most these contributions can be attributed to the husband so as to increase entitlement. It is impossible to determine with any precision how much of the \$5,050 related to material and how much related to work performed by the husband. It is also impossible to determine how much of the materials and work related to the enhancement of the value of the real estate. As I have said above, the evidence required in a family law dispute does not approach the precision of a mercantile dispute, at least for the purpose of measuring precisely the contribution translated to financial terms of the competing spouses. A reference or a new trial to determine the amount and character of these "improvements" will entail expense on the part of the spouses out of all proportion to the worth of the result in the settlement of this family law matter. Therefore, under the circumstances of this case, in order to bring matters to a conclusion, and to reflect so far as possible the evidence introduced by the parties, I would attribute 75 per cent or \$3,786 of this contribution to the credit of the husband in the same manner as the husband is credited above with the final payment to the Director, Veterans' Land Act.

Then there is the question of the unilateral occupation of these premises by the husband for the 10 years which have passed since the wife vacated the premises, or eight years from the commencement of litigation between husband and wife. Whether the wife's interest in the property be ultimately determined to be 50 per cent or something less, the husband has arrogated to himself considerable value in the form of use and occupation of the former family home. It is clear beyond debate that this unilateral occupation was extended by the husband's filing of the notice of appeal to the Court of Appeal in May 1976. Again we are faced with the economic limitation beyond which judicial exploration cannot proceed in the field of family dispute. To determine the value of use and occupation over a decade would require a reference, more evidence, more argument, and perhaps further appeal. Therefore, placing, as the modern tradition in my view does, more emphasis on expeditious justice than finite justice, I would consider the husband's unilateral and extra-legal gain to be swallowed up in the ultimate division of the property between the spouses on a 50/50 basis.

I turn then to the state of the title. So far as this Court can ascertain from the record and from submissions of counsel, the deed from the Director, Veterans' Land Act to the husband was transmitted by the Director on the direction of the husband to the Royal Bank of Canada presumably as security for a loan or loans by the husband and perhaps now by the husband and his new wife. The state or balance of this indebtedness is, of course, unknown to us. It may be that the Royal Bank asserts a possessory lien on the deed as collateral security to the personal indebtedness of the husband and/or the new wife. It may be therefore that the only effective disposition that can now be made of this family asset is to direct the sale thereof with an accounting before the appropriate official of the Supreme Court of British Columbia so as to protect the possessory lien of the Royal Bank of Canada, but not at the wife's expense beyond those credits already accorded above to the husband with respect to moneys paid by the husband to the Director, Veterans' Land Act in discharging the agreement and recovering the deed to the premises, and the aforementioned improvements to the house made by the husband. Therefore, in implementation of the division of this real estate between husband and wife on the basis already indicated, failing agreement

between the parties on the payment of the wife's interest, I would direct a sale of these premises by the Court and a division of the net proceeds of sale in the manner herein provided for. Unless there be some prohibitory British Columbia legislation, such an order would in my view include a term entitling either spouse to bid in the resulting sale process.

I would therefore allow the appeal with costs to the appellant-wife throughout, set aside the judgment of the Court of Appeal and at trial, and direct that the said lands and premises be valued at the date hereof either by agreement between the parties or in the manner hereinafter provided, and that there be deducted from such valuation of the said lands and premises (a) the sum of \$5,916.69 being the moneys paid by the respondent to the Director, Veterans' Land Act, and (b) the sum of \$3,786 being the contribution by the husband to the premises as described in these reasons, and that the net remaining value be divided one-half to the appellant-wife and one-half to the respondent husband; and that the respondent register his title to these lands forthwith in the appropriate Land Registry Office. In the event the parties cannot agree on the value of the said property, the question shall be referred either to the trial judge or to another local judge of the Supreme Court of British Columbia for determination upon such appraisal or other evidence as he may direct or as the parties may present. The interest of the appellant in the said lands determined in accordance with this order shall be a charge against the said lands and premises until paid with interest at the rate of 5 per cent per annum from the date hereof. In the discretion of the said local judge, an order may issue for the sale of the said lands and premises so as to realise the interest of the appellant therein on the basis herein set forth.

Appeal allowed with costs, PIGEON, ESTEY, PRATTE and McINTYRE JJ. dissenting in part.

Indexed as:

Reading & Bates Construction Co. v. Baker Energy Resources Corp.

**Between
Reading & Bates Construction Co. and Reading & Bates
Horizontal Drilling Ltd., Plaintiffs, and
Baker Energy Resources Corporation and Baker Marine
Corporation, Defendants**

[1988] F.C.J. No. 1025

[1988] A.C.F. no 1025

25 F.T.R. 226

22 C.I.P.R. 240

24 C.P.R. (3d) 66

13 A.C.W.S. (3d) 240

Court File No. T-1879-83

Federal Court of Canada - Trial Division
Toronto, Ontario

McNair J.

Heard: September 19, 1988
Judgment: November 9, 1988

Practice -- Appeal for prothonotary's decision -- Not trial de novo -- Discovery -- Examination for discovery -- Reference on accounting of profits in patent infringement action -- Only relevant questions need be answered -- Only relevant documents ordered produced.

This was an appeal by the defendants from a prothonotary's order requiring the defendants to answer questions and produce documentation regarding profits made by the defendants on an installation found to have infringed the plaintiff's patent. The plaintiffs successfully sued the defendants for patent infringement with respect to one particular installation of a gas pipeline. The plaintiffs elected an accounting of profits rather than damages. The defendants refused to answer questions or provide documentation respecting profits made from other installations of pipeline on the grounds that the plaintiffs were only entitled to the information respecting profits from the one pipeline installation found to infringe the plaintiff's patent. The prothonotary ordered, inter alia, the production of all financial

statements from 1980 until the date of the order and ordered that numerous question asked at discovery be answered. The defendants appealed the order.

HELD: The appeal was allowed. An appeal from a prothonotary's decision was not a trial de novo. The prothonotary's decision must be shown to be wrong on the facts or wrong in principle. The purpose of discovery was to assist the parties in proving facts necessary for a determination of the matters in issue. Documents should only be ordered produced where they were shown to be relevant. On a reference as to damages or an accounting of profits, the party being discovered should only be required to answer questions raised by the reference itself. The prothonotary erred in ordering the production of revenue breakdowns for contracts other than the job specifically in issue. Questions designed to elicit financial information which might assist the plaintiff in advancing its case or damaging the defendant's case should be answered provided they could be fairly seen as pointing to a productive train of inquiry. The aspect of the prothonotary's order respecting the production of all monthly financial statements was accordingly limited to production of those statements relevant, on the above test, to the reference.

S. Lane, for the Plaintiffs.

S. Anissimoff and E.M. McMahon, for the Defendants.

McNAIR J. (Reasons for Order):-- This is an appeal by the defendant, Baker Energy Resources Corporation, from an order of the Associate Senior Prothonotary made on September 8, 1988 compelling answers to certain questions put to the defendant's officer on his examination for discovery held on April 22, 1987. The appeal is from that part of the prothonotary's order which ordered the party being examined to answer the questions and to produce the documents comprehended by Questions 37, 77, 78, 414, 415, 411, 234, 237, 247 and 132. The grounds urged in support of the appeal are set out in the notice of motion, and read as follows:

(a) The Defendant infringed Canadian Patent No. 1,140,106 ("pull-back patent") in laying a pipe under the St. Lawrence River in 1983, and the parties are now engaged in a reference as to the profits made by the Defendant.

(b) The above questions relate to:
 (i) jobs other than the St. Lawrence River crossing; and
 (ii) the time period from 1980 to 1988.

(c) The Associate Senior Prothonotary erred in law in determining that answers to the above questions were relevant and in requiring the Defendant to answer the above questions.

The matter arises from actions brought by the plaintiffs for infringement of two patents relating to the installation of a gas pipe line under the St. Lawrence River near Trois Rivières, Quebec, in the summer of 1983. On March 20, 1986 the court ruled that the plaintiffs' follow liner patent was invalid, but held in the other action that the defendant was liable for infringement of the plaintiffs' pull back patent and indicated that there would be further directions as to the procedure on the reference as to damages or an accounting of profits as requested by counsel for the plaintiffs. The action against Baker Marine Corporation and Gaz Inter-Cité Quebec was dismissed with costs. On November 20, 1987 the Federal Court of Appeal dismissed an appeal and cross-appeal with costs. On June 2, 1986 the Associate Senior Prothonotary ordered the defendant, Baker Energy Resources Corporation, to make available for inspection and the

taxing of copies the following documents:

All documents and records relating to the crossing of the St. Lawrence River near Trois Rivières including forecasts of expenses and profits, bills of material, actual expenses incurred, all correspondence relating to this project, all books of account, accounting records and all management reports; and all financial statements, audited or otherwise, of the defendant, Baker Energy Resources Corporation, from 1980 to date.

The prothonotary also ordered that an officer of the defendant be presented for examination on discovery. On April 22, 1987 Billy Jack Greer was examined at Toronto, Ontario, on behalf of the defendant. On August 4, 1988 the plaintiffs brought a motion seeking an order that the defendant comply with the prothonotary's order of June 2, 1986 and answer certain questions objected to and provided written answers to undertakings given at the time. The prothonotary made an order on the same date requiring the defendant to provide answers in writing to all outstanding undertakings, and adjourned the matter over to September 8, 1988. The prothonotary made an order on that date requiring the defendant to provide answers in writing to certain questions put to its officer at the discovery on April 22, 1987. The defendant now appeals that part of the order relating to the questions set out in its notice of motion.

The present case raises two issues for determination, namely: (1) the recurring question of the principles applicable to prothonotary appeals; and (2) whether the propriety of the questions put on discovery is determinable on the basis of their relevance to the issues defined by the reference.

Rule 336(5) of the Federal Court Rules provides for appeals from an order or decision of a prothonotary, and it is unnecessary to set it out verbatim. Suffice it to say, the Rule has been the subject of some judicial consideration.

In my view, the law was correctly stated by Mr. Justice Collier in *Reading & Bates Construction Co. v. Baker Energy Resources Corporation* (1987), 12 C.I.P.R. 260 at pp. 261-262 as follows:

. . . an appeal from the decision of a Prothonotary is not a trial de novo

...

It is not the function of the Trial Division, sitting on appeal from Prothonotaries, to substitute its discretion for that of the Prothonotary. It must be shown the Prothonotary was wrong, in that he exercised his powers on a wrong principle, or on a complete misapprehension of the facts, or for some other compelling reason requiring interference by a Judge sitting in an appellate position.

Ample support for this principle may be found in the case of *Algonquin Mercantile Corporation v. Dart Industries Canada Ltd.* (1984), 5 C.I.P.R. 40 (F.C.A.) wherein the court held that the order under appeal, being discretionary, should be overruled only if the motions judge was clearly wrong on the facts, or proceeded on an erroneous principle of law, or his decision resulted in some injustice to the appellant. None of these circumstances were existent in the case on appeal. It seems to me that it is now authoritatively settled as a rule of practice that an appeal from a discretionary order, whether it be that of a prothonotary or a motions judge, should be treated as an appeal rather than a rehearing on the merits, and the order appealed from should be interfered with only when it can be demonstrated that such order was clearly wrong in law or on the facts. For a useful review of the comparable principle applicable to appeals from interlocutory orders of masters, see *Marleen Investments Ltd. v. McBride* (1979), 23 O.R.

(2d) 125 (Ont. H.C.).

The purpose of discovery, whether oral or by production of documents, is to obtain admissions to facilitate proof of the matters in issue between the parties. The prevailing trend today favours broadening the avenues of fair and full disclosure to enable the party to advance his own case or to damage the case of his adversary. Discovery can serve to bring the issues more clearly into focus, thus avoiding unnecessary proof and additional costs at trial. Discovery can also provide a very useful tool for purposes of cross-examination.

The broadening scope of discovery is reflected in Rule 465(15) which reads:

465.(15) Upon examination for discovery otherwise than under paragraph (5), the individual being questioned shall answer any question as to any fact within the knowledge or means of knowledge of the party being examined for discovery that may prove or tend to prove or disprove or tend to disprove any unadmitted allegation of fact in any pleading filed by the party being examined for discovery or the examining party.

Fox, *Canadian Patent Law and Practice*, 4th ed., makes the following accurate statement regarding production of documents at p. 456:

Production should be made of all documents that directly or indirectly enable the party seeking production to better his own case or destroy that of his adversary, or may fairly lead him to a train of inquiry that may have either of these consequences, or if generally the documents are such as to throw light on the case. In patent cases the court is more than ordinarily cautious in ordering the production of documents beyond what is necessary to prove a party's case. Documents dated after the inception of the action will not be required to be produced.

The case authorities afford some useful guidelines bearing on the issue of relevance vis-a-vis the determination of whether the learned prothonotary was clearly wrong in compelling answers to the questions enumerated in the defendant's notice of motion. I will endeavour to review briefly the ones I consider to be most applicable.

1. The test as to what documents are required to be produced is simply relevance. The test of relevance is not a matter for the exercise of the discretion. What documents parties are entitled to is a matter of law, not a matter of discretion. The principle for determining what document properly relates to the matters in issue is that it must be one which might reasonably be supposed to contain information which may directly or indirectly enable the party requiring production to advance his own case or to damage the case of his adversary, or which might fairly lead him to a train of inquiry that could have either of these consequences: *Trigg v. MI Movers International* (1987), 13 C.P.C. (2d) 150 (Ont. H.C.); *Canex Placer Ltd. v. A.-G. B.C.* (1976) 63 D.L.R. (3d) 282 (B.C.S.C.); and *Compagnie Financiere et Commerciale du Pacifique v. Peruvian Guano Co.* (1882), 11 Q.B.D. 55 (C.A.).
2. On an examination for discovery prior to the commencement of a reference that has been directed, the party being examined need only answer questions directed to the actual issues raised by the reference. Conversely, questions relating to information which has already been produced and questions which are too

- general or ask for an opinion or are outside the scope of the reference need not be answered by a witness: *Algonquin Mercantile Corp. v. Dart Industries Ltd.* (1984), 82 C.P.R. (2d) 36 (F.C.T.D.), *aff'd* (1984), 1 C.P.R. (3d) 242 (F.C.T.D.).
3. The propriety of any question on discovery must be determined on the basis of its relevance to the facts pleaded in the statement of claim as constituting the cause of action rather than on its relevance to facts which the plaintiff proposes to prove to establish the facts constituting the cause of action. Additionally, where a reference has been directed, the application of Rule 465(15) requires that the answers on discovery be restricted to questions as to facts that may prove or tend to prove or disprove or tend to disprove any unadmitted allegation of fact placed in issue on the reference: *Armstrong Cork Canada Ltd. v. Domco Industries Ltd.* (1983), 71 C.P.R. (2d) 5 (F.C.A.).
 4. The court should not compel answers to questions which, although they might be considered relevant, are not at all likely to advance in any way the questioning party's legal position: *Canex Placer Ltd. v. A.-G. B.C.*, *supra*; and *Smith, Kline & French Ltd. v. A.-G. Can.* (1982), 67 C.P.R. (2d) 103 (F.C.T.D.) at p. 108.
 5. Before compelling an answer to any question on an examination for discovery, the court must weigh the probability of the usefulness of the answer to the party seeking the information, with the time, trouble, expense and difficulty involved in obtaining it. Where on the one hand both the probative value and the usefulness of the answer to the examining party would appear to be, at the most, minimal and where, on the other hand, obtaining the answer would involve great difficulty and a considerable expenditure of time and effort to the party being examined, the court should not compel an answer. One must look at what is reasonable and fair under the circumstances: *Smith, Kline & French Ltd. v. A.-G. Can.*, *supra*, per Addy J. at p. 109.
 6. The ambit of questions on discovery must be restricted to unadmitted allegations of fact in the pleadings, and fishing expeditions by way of a vague, far-reaching or an irrelevant line of questioning are to be discouraged: *Carnation Foods Co. Ltd. v. Amfac Foods Inc.* (1982), 63 C.P.R. (2d) 203 (F.C.A.); and *Beloit Ltee/Ltd. v. Valmet Oy* (1981), 60 C.P.R. (2d) 145 (F.C.T.D.).

The following are the questions in issue, as enumerated in the defendant's notice of motion, viz:

Question Discovery
No. Page Question

37	8	Is Berco still using the method it used on the crossing of the St. Lawrence River in any of its operations including those outside Canada?
77	18	Provide a listing of all the jobs performed by Berco since its inception.
78	18	Provide a listing of all the jobs performed by Berco worldwide, as they relate to Berco's income and profits, for the period 1982 to 1984.

- 414 140 Provide the breakdown of revenue from the contract which is the subject of this action for the year ended December 31, 1983 and second, other contracts and, third, revenue not related to contracts specifying the nature of that revenue.
- 415 140 With respect to costs of the contracts for the year ended December 31, 1983, provide costs breakdown for the contract at issue and for other contracts. In addition, provide an analysis of the costs by type of expense, that is wages, supplies, subcontracts and other types of expenses on the Gaz job and on other contracts.
- 411 136 Advise if Berco was involved with any other companies in 1983 that carried on business activities relating to directionally controlled horizontal drilling.
- 234 63 Produce all monthly financial statements beginning in 1980 and up to the present.
- 237 65 Produce the monthly financial statements from mid-1984 to present, the period of Mr. Greer's employment with Berco.
- 247 69 Produce an unaudited financial statement for the period ending December 31, 1986 and monthly financial statements for 1987 to date.
- 132 35 Produce any promotional brochures or literature of Berco of any sort produced by Berco since 1983.

The principal objection taken by defendant's counsel is that the questions, or at least substantial portions of the same, are irrelevant to the issues raised by the reference. Mr. Anissimoff argues that these issues must necessarily be confined to taking an account of the actual profits made by the defendant on the St. Lawrence River crossing project, and resulting from the patent infringement. He contends strenuously that the appropriate avenue of inquiry open to the plaintiffs on the reference is simply to elicit information as to the defendant's direct and indirect costs in employing the infringing method on the so-called Gaz job, and that anything going beyond these specific terms of reference is irrelevant and in the nature of a fishing expedition.

Plaintiffs' counsel emphasizes the point that what is under appeal is the prothonotary's order of September 8, 1988 relating to the subject questions and he presses the argument that this discretionary order should not be reversed unless it can be demonstrated by the defendant that the prothonotary was clearly wrong. As to the questions themselves, he contends that the plaintiffs are entitled to all information pertaining to any expenses which might be offset against the profits earned from the Gaz job for which the defendant is liable to account. Mr. Lane acknowledges that what falls to be determined by the reference is an account of the profits made by the defendant on the Gaz project by reason of its infringement of the plaintiffs' pull back patent. Nonetheless, he urges that it becomes very important for the plaintiffs to know whether this pull back method was employed by Berco in other like jobs throughout the world.

The case of *Teledyne Industries Inc. v. Lido Industrial Products Ltd.* (1982), 68 C.P.R. (2d) 204 (F.C.T.D.), relied on by plaintiff's counsel, was an appeal from a report of the prothonotary relating to an accounting of profits in a patent infringement action. The case provides an extensive review of the authorities and distinguishes the principles governing an award of damages in a patent infringement action from those pertaining to the equitable remedy of an accounting for profits derived from the act of infringement. The plaintiff adduced expert accounting evidence for determining the nature of "net profits", which the prothonotary accepted. The court held, *inter alia*, that his decision to apply the differential accounting or direct costing method of accounting was correct under the circumstances.

Mr. Justice Addy stated the principle on this aspect of the case at p. 213:

... the infringer is entitled to deduct only those expenses, both variable and fixed, which actually contributed to the sums received and for which he is liable to account. It follows that no part or proportion of any expenditure which would have been incurred had the infringing operation not taken place, is to be considered as deductible.

In *Peter Pan Manufacturing Corporation v. Corsets Silhouette Ltd.*, [1963] R.P.C. 45, a patent infringement action alluded to by Addy J. in *Teledyne*, the successful plaintiff elected to take an account of profits and the issue went to the proper form of order to be made, which Pennycuick J. answered at p. 60 as follows:

... what the plaintiff who elects in favour of an account of profits is entitled to, is simply an account of profits in the sense which I have indicated, that is, what has the plaintiff [sic] expended upon manufacturing these goods? What is the price which he has received on their sale? and the difference is profit. That is what the plaintiffs claim in the order for an account as formulated by them; that is simply an account of the profits made by the defendants in the manufacture and sale of the brassieres U.15 and U.25.

Clearly, the questions must be judged by the legal test of their relevancy to the profits earned by the defendant from the patent infringement. In fairness to the learned prothonotary, it must be pointed out that he lacked the benefit of any expert accounting evidence which might have afforded some useful guidance in the determination of these profits, unlike the *Teledyne* case.

The main thrust of Questions 37, 77 and 78 is directed to other operations and other jobs performed by the defendant, Berco, regardless of any qualifying words of limitation. In the case of *Carnation Foods Co.*, *supra*, the Court of Appeal was unanimous in its view that the motions judge erred in law in ordering to be answered questions relating to a possible corporate connect on between the patent infringer and the U.S. company or any other corporations on the ground that such corporations were not parties to the proceedings and the questions were irrelevant to the unadmitted allegations of fact as pleaded.

In my opinion, the learned prothonotary erred in law in ruling that these questions were relevant to the determination of the profits made by the defendant on the St. Lawrence River crossing project and attributable to the patent infringement. I fail to see how they would be likely to throw any light on that topic. The questions are therefore disallowed.

In my view, Question 411 falls within the same category as the preceding questions. I find that the prothonotary erred in permitting this question inasmuch as it is irrelevant to the issues raised by the reference. Consequently, the question is disallowed.

It seems to me that the same result must obtain with respect to Question 132, namely, error in law. I fail to see what useful, probative value these documents could have in a reference for an accounting of profits resulting from the particular infringement complained of. The question is disallowed.

Questions 414 and 415 are something of a mixed bag from the standpoint of their relevancy.

Defendant's counsel submits that the second and third parts of Question 414 relating to other contracts and other revenue apart from contracts are totally irrelevant to the issue of the profits earned from the patent infringement. Plaintiffs' counsel asserts that these additional portions of the question are relevant to the reference issue, but fails to explain why. As indicated, the learned prothonotary did not have the benefit of any expert accounting evidence that would tend to support the plaintiff's position. In my view, he erred in law in allowing the second and third parts of this question relating to revenue breakdowns for other contracts and all sources of revenue generally by reason that these are much too general and far-reaching in terms of the scope of the reference. The first part of the question down to and including the words "the year ended December 31, 1983" is clearly relevant to the issue raised by the reference, and is allowable accordingly. The remainder of the question appearing thereafter must be disallowed on the ground of error as being irrelevant to and outside the scope of the reference.

Applying the same reasoning to Question 415, I consider that the prothonotary erred in law in requiring the defendant to provide cost breakdowns and analyses of expenses for other contracts, apart from the Gaz job. The additional portions comprehended by the words "and for other contracts" in the fourth line of the question and the words "and on other contracts" appearing at the end thereof are disallowed as being irrelevant to and outside the scope of the reference. The remainder of the question is allowed.

Questions 234, 237 and 247 come within the category of questions directed to obtaining financial information which might somehow assist the questioner in advancing his own case or aid in damaging the case of his adversary, or which might fairly lead to a train of inquiry that could have either of these consequences.

Defendant's counsel objects to the production of all monthly financial statements, whether limited to a particular time frame or otherwise, on the ground that these do not come within the category of documents and records relating to the St. Lawrence River crossing as envisaged by the order of June 2, 1986, and that the request for their production is nothing more than a blatant attempt to embark on an aimless fishing expedition. Plaintiffs' counsel rejoins by quoting the concluding portion of the said order in reference to all financial statements of the defendant generally from 1980 to date. Incidentally, this concluding portion is separated from what precedes it by a semicolon but, in my view, the punctuation mark is not particularly determinative. What is more significant, in my view, is the absence of any explanation as to how or why these monthly financial statements could fairly lead to a train of inquiry which might have some useful probative value in terms of relevancy.

Counsel referred repeatedly to the issues raised by the reference, but I can find no evidence of anything which would define and identify those issues beyond the plaintiffs' election for an accounting of profits from the patent infringement and the order of June 2, 1986 particularizing the documents to be produced by the defendant. The bottom line position of counsel for the defendant is simply that the monthly financial statements of Berco from 1980 up to the present time go far beyond the ambit of documents and records relating to the Gaz job, and are thus irrelevant and outside the scope of the reference.

Viewing Questions 234, 237 and 247 collectively, the test to be applied, as it seems to me, is whether they can be fairly seen as pointing to a productive train of inquiry which might directly or indirectly

advance the plaintiffs' case or damage the defendant's case. *Everest & Jennings Can. Ltd. v. Invacare Corp.*, [1984] 1 F.C. 856 (C.A.) approved the train of inquiry principle as the correct test of relevancy for purposes of discovery, and ordered the production of the whole file from which a particular letter had been produced.

In my view, it can hardly be said that the production of existent monthly financial statements is totally irrelevant to an accounting for the profits earned by the defendant from its infringement of the plaintiffs' patent. Conceivably, these could illustrate some cost expenditure or proportionate part thereof which is not so connected with the infringing activity as to be properly deductible. The difficulty here is compounded by the fact that the references to monthly financial statements are somewhat duplicitous and overlapping and there is no clear definition of what is meant by the words "the present". But for that, I am not prepared to go so far, as to rule that the prothonotary clearly erred in ordering the production of existing monthly financial statements from the standpoint of their relevancy to an accounting for profits. With respect, I consider that he did err in allowing Question 237 by reason that it is totally redundant when taken in context with Question 234. Question 237 is disallowed accordingly.

As to Question 247 I am of the opinion that the learned prothonotary erred in requiring production of monthly financial statements from January 1, 1987 to date. This area of inquiry represents, in my view, nothing more than a fishing expedition that would have little probative value in view of the extended time frame. There is also the factor of the burdensome inconvenience involved. I rule therefore that Question 247 is allowable as to the portion concluding with the words "ending December 31, 1986" with the remainder being deleted therefrom.

Coming back to Question 234, I am of the opinion that there is no patent error on the broad issue of its relevancy to the accounting for profits, provided the question is put in the following modified form:

Question 234: Produce all existent monthly financial statements beginning in 1980 and up to and including December 31, 1986.

In the result, the defendant's appeal is allowed, save only for Question 234 in the foregoing modified form. To that extent, the plaintiffs achieved a limited degree of success so there will be no order as to costs. An order will go accordingly.

McNAIR J.

Case Name:

Eli Lilly Canada Inc. v. Novopharm Ltd.

Between

**Eli Lilly Canada Inc., Eli Lilly and Company, Eli Lilly
Company Limited and Eli Lilly SA, Plaintiffs (Defendants
by Counterclaim), and
Novopharm Limited, Defendant (Plaintiff by Counterclaim)**

[2008] F.C.J. No. 407

[2008] A.C.F. no 407

2008 FC 281

65 C.P.R. (4th) 61

327 F.T.R. 266

164 A.C.W.S. (3d) 860

Docket T-1048-07

Federal Court
Toronto, Ontario

Lemieux J.

Heard: January 9, 2008.
Judgment: March 3, 2008.

(83 paras.)

Intellectual property law -- Patents -- Defences to infringement -- Invalidity of patent -- Procedure -- Case management -- Discovery -- Documents -- Appeal by the defendant from a production order dismissed -- The defendant sought disclosure of documents related to the side effects profile of a particular compound in order to establish the advantages claimed in a patent -- It submitted that the prothonotary should have ordered disclosure of a wider class of documents -- The court found that the order was not clearly wrong, nor resulted from a misuse of discretion -- The order did not endorse partial discovery or result from a misapplication of the test for relevance -- Federal Courts Rules, Rule 222(2).

Civil litigation -- Civil procedure -- Discovery -- Production and inspection of documents -- Affidavit or list of documents -- Sufficiency -- Relevancy -- Appeal by the defendant from a production order dismissed -- The defendant sought disclosure of documents related to the side effects profile of a particular compound in order to establish the advantages claimed in a patent -- It submitted that the

prothonotary should have ordered disclosure of a wider class of documents -- The court found that the order was not clearly wrong, nor resulted from a misuse of discretion -- The order did not endorse partial discovery or result from a misapplication of the test for relevance -- Federal Courts Rules, Rule 222(2).

Appeal by the defendant, Novopharm, from a decision of a prothonotary that allowed its motion in part -- The parties were involved in patent infringement and validity proceedings -- The defendant sought disclosure of documents related to the side effects profile of a particular compound in order to establish the advantages claimed in the patent -- It believed that the scope of disclosure omitted relevant documents -- The prothonotary ordered each of the plaintiffs, the Eli Lilly companies, to provide a further and better affidavit of documents and other relief including cross-examination of the plaintiffs' affiants -- The defendant believed that a wider class of documents should have been ordered disclosed -- It submitted that the prothonotary erred in permitting oral discoveries to proceed before it had the full benefit of the documentary discovery process -- The defendant contended that the prothonotary misinterpreted the train of enquiry test by requiring it to prove the usefulness of un-produced documents never seen by the defendant -- The defendant further argued that the prothonotary erred in finding that production of relevant documents prior to oral discovery was a matter within her discretion -- HELD: Appeal dismissed -- The order was not vital to the final resolution of action and was thus reviewable on the standard of whether it was clearly wrong -- As case manager for the action, the prothonotary was entitled to an additional level of deference -- Her order did not endorse the concept of partial documentary discovery before oral discovery, as she expected production to be complete prior thereto -- The prothonotary correctly applied the proper test for relevance to each class of documents -- The burden on the defendant was not impermissibly high -- There were no palpable and overriding errors of fact that occurred -- The order was not clearly wrong and did not result from a misuse of discretion.

Statutes, Regulations and Rules Cited:

Federal Courts Rules, 1998, Rule 222, Rule 222(2), Rule 223, Rule 227, Rule 240, Rule 385, Rule 385(1) (a)

Patent Act, s. 55.1

Counsel:

Anthony G. Creber, for the plaintiffs (Defendants by Counterclaim).

Jonathan Stainsby and Neil Fineberg, for the Defendant (Plaintiff by Counterclaim).

REASONS FOR JUDGMENT AND JUDGMENT

LEMIEUX J.:--

I. Introduction and background

1 The defendant Novopharm Inc. (Novopharm) appeals Prothonotary Tabib's November 15, 2007 decision in which she granted part of the relief sought by Novopharm in a motion, pursuant to Rule 227 of the *Federal Courts Rules*, 1998 (the *Rules*) for a further and better affidavit of documents from each of the plaintiffs and other consequential relief including cross-examination with leave of the Court the

plaintiffs affiants.

2 Novopharm argues Prothonotary Tabib made three errors of law and several palpable and overriding errors of fact that necessitate a *de novo* examination of Novopharm's motion by this Court. The alleged errors of law are:

- (1) A first error by endorsing and adopting a piecemeal and partial approach to discovery under the Rules i.e. permitting oral discoveries to proceed before Novopharm has had the benefits of the full documentary discovery process through the affidavit of document provided for in the rules.
- (2) A second error by misinterpreting and misapplying the train of inquiry jurisprudence flowing from *Compagnie Financière et Commerciale du Pacifique v. Peruvian Guano Co.*, (1882), 11 Q.B.D. 55 (C.A.). In particular, while the Prothonotary correctly stated the test, it is argued she set the bar impermissibly high by requiring Novopharm to prove the contents and usefulness of documents that had not been produced and therefore never seen by Novopharm.
- (3) A third error relating to her treatment of relevance and her conclusion that whether relevant documents had to be produced before oral discovery was a matter within her discretion.

In terms of her factual errors, Novopharm asserts her findings were made in absence of evidence. Such findings included ones related to what documents had been produced and conclusions of fact that entire classes of documents could not contain relevant documents.

3 Rules 222 to 233 of the *Rules* deal with discovery of documents under the heading in the *Rules* "Discovery and Inspection". Subsection 222(2) of the *Rules* contains a definition of relevancy for the purposes of the preparation of an affidavit of documents while section 227 provides for sanctions where the Court is satisfied an affidavit of documents is inaccurate or deficient. Rule 223 compels the listing of all relevant documents in an affidavit of document which must be produced within 30 days after the close of pleadings. These three provisions read:

Interpretation

222(2) For the purposes of rules 223 to 232 and 295, a document of a party is relevant if the party intends to rely on it or if the document tends to adversely affect the party's case or to support another party's case.

Time for service of affidavit of documents

223. (1) Every party shall serve an affidavit of documents on every other party within 30 days after the close of pleadings.

Contents

(2) An affidavit of documents shall be in Form 223 and shall contain

- (a) separate lists and descriptions of all relevant documents that

...

Sanctions

227. On motion, where the Court is satisfied that an affidavit of documents is inaccurate or deficient, the Court may inspect any document that may be relevant and may order that

- (a) the deponent of the affidavit be cross-examined;
- (b) an accurate or complete affidavit be served and filed;
- (c) all or part of the pleadings of the party on behalf of whom the affidavit was made be struck out; or
- (d) that the party on behalf of whom the affidavit was made pay costs.

[Emphasis mine.]

* * *

Pertinence

222(2) Pour l'application des règles 223 à 232 et 295, un document d'une partie est pertinent si la partie entend l'invoquer ou si le document est susceptible d'être préjudiciable à sa cause ou d'appuyer la cause d'une autre partie.

Délai de signification de l'affidavit de documents

223. (1) Chaque partie signifie un affidavit de documents aux autres parties dans les 30 jours suivant la clôture des actes de procédure.

Contenu

(2) L'affidavit de documents est établi selon la formule 223 et contient :

- a) des listes séparées et des descriptions de tous les documents pertinents :

...

Sanctions

227. La Cour peut, sur requête, si elle est convaincue qu'un affidavit de documents est inexact ou insuffisant, examiner tout document susceptible d'être pertinent et ordonner :

- a) que l'auteur de l'affidavit soit contre-interrogé;
- b) qu'un affidavit exact ou complet soit signifié et déposé;
- c) que les actes de procédure de la partie pour le compte de laquelle l'affidavit a été établi soient radiés en totalité ou en partie;
- d) que la partie pour le compte de laquelle l'affidavit a été établi paie les dépens.

[Je souligne.]

4 The heart of Prothonotary Tabib's ruling is contained in paragraph 22 of her reasons for decision cited as [2007] F.C.J. No. 1556, 2007 FC 1195:

[22] Thus, I conclude that, whether on the wide "train of inquiry" test, or a narrower reading of Rule 222(2), Novopharm is not entitled to disclosure of every document in Lilly's possession, power or control that relate to the facts pleaded, whether or not they can directly or indirectly assist its case. Novopharm is not entitled to disclosure of every document in Lilly's possession so that it might itself consider whether they might be useful. Unless it can establish that Lilly's vetting process was inadequate, Novopharm must be satisfied by the sworn statements appearing in Lilly's affidavits of documents, to the effect that the affiant has diligently caused the records to be searched and has made appropriate inquiries and disclosed, to the full extent of his or her knowledge, information and belief, the documents that would tend to adversely affect Lilly's case or advance Novopharm's. [Emphasis mine.]

5 Counsel for Novopharm and Lilly both agree the essence of motion before Prothonotary Tabib was properly characterized by her at paragraph 4 of her decision where she wrote:

[4] All of the documents Novopharm alleges exist and have not been produced ultimately relate to the issue of the side effects profile of olanzapine. All of Novopharm's arguments as to the relevance or usefulness of these documents were to the effect that these documents would establish, one way or the other, or would lead to a train of enquiry that would have the effect of establishing, one way or the other:

- (a) whether olanzapine had, as of the priority date, the filing date or the date of issuance of the patent, the advantages claimed in the patent;
- (b) whether, as an objective fact as of the present date, olanzapine in fact has those advantages; or
- (c) whether up to and until the issuance of the patent, Lilly knew of facts going to those issues that it failed to disclose to the Patent Examiner. [Emphasis mine.]

6 In other words, the issue before the Prothonotary was a single issue centered on the advantages or disadvantages of olanzapine as claimed in the '113 Patent and did not touch upon the numerous other grounds of invalidity asserted by Novopharm against the '113 Patent in this proceeding.

7 On the issue of relevance, counsel for Lilly before the Prothonotary limited his opposition to Novopharm's motion for further production arguing that, *inter alia*, the existence of the advantages or disadvantages claimed for olanzapine in the '113 Patent could only be measured on the basis of the state of knowledge of persons skilled in the art at the very latest at the laid open date and any knowledge gained after that date can simply not be considered by the Court and was therefore not relevant. On this point, the Prothonotary ruled against Lilly finding she could not conclude it was plain and obvious Novopharm's position that the advantages of olanzapine disclosed in the Patent could be assessed as of the date of the trial was devoid of success. Lilly did not appeal the Prothonotary's determination that relevant documents could encompass those relevant to whether the advantages or disadvantages in fact exist in accordance with the state of the art after the laid open date.

8 This action was commenced on June 6, 2007 by the plaintiffs claiming Novopharm had infringed certain claims in Canadian Letters Patent No. 2,041,113 (the '113 Patent) covering the medicine olanzapine marketed by Eli Lilly Canada Inc. (Lilly Canada) under the brand name ZYPREXA in tablet and other forms. In its defence and counterclaim, Novopharm pleads the invalidity of '113 Patent on a number of grounds including the lack of the advantages claimed for the '113 Patent.

9 The other plaintiffs are Eli Lilly and Company Limited (Lilly UK) the United Kingdom affiliate of Eli Lilly and Company (Lilly US). Lilly U.K. is the owner of the '113 Patent; it manufactures, distributes and sells ZYPREXA products including to Lilly Canada. The plaintiff Eli Lilly SA (Lilly SA), is a company incorporated under the laws of Switzerland. It manufactures and distributes pharmaceutical products including the manufacture and sale of bulk olanzapine to Lilly U.K. Lilly U.S. has a licence under the '113 Patent from Lilly U.K. to manufacture, distribute and sell products under this patent in, *inter alia*, Canada with the right to permit other companies to distribute in Canada. In this regard, Lilly U.S. has consented to the manufacture, distribution and sale of ZYPREXA products by Lilly Canada in Canada. Collectively the plaintiffs are referred to as Lilly.

10 The application for '113 Patent was filed by Lilly in Canada on April 24, 1991 and was issued by the Canadian Patent Office on July 14, 1998. It is a selection patent which means it is based on a selection from related compounds derived from an original compound. The claimed compound olanzapine is said to be useful in the treatment of disorders of the central nervous system such as schizophrenia, schizophrenic form diseases, acute mania and mild anxiety disorders. The plaintiffs claim olanzapine has atypical anti-psychotic properties and an improved side effect profile over previously used anti-psychotic medicines and is a new product within the meaning of section 55.1 of the *Patent Act*.

11 Lilly Canada was involved as the first person in two NOC proceedings before this Court on the '113 Patent. On April 27, 2007, my colleague Justice Gauthier in a decision cited [2007] F.C.J. No. 617, 2007 FC 455 granted Lilly Canada an order prohibiting the Minister of Health from issuing a Notice of Compliance (NOC) which would have enabled Apotex Inc. to market in Canada its olanzapine product. Apotex had alleged the invalidity of the '113 Patent on grounds of selection, anticipation, obviousness and double-patenting. Justice Gauthier found none of Apotex's allegations were justified.

12 On June 5, 2007 my colleague Justice Hughes, in a decision cited [2007] F.C.J. No. 800, 2007 FC 596 dealing with the same patent but connected to a Notice of Allegation (NOA) by Novopharm, refused to prohibit the Minister of Health from issuing a NOC to Novopharm for its Novo-olanzapine product. Novopharm's olanzapine product has been on the market since the issuance of the NOC. Justice Hughes found the '113 Patent invalid on a ground not raised by Apotex -- the sufficiency of disclosure in the '113 Patent.

13 The plaintiffs allege Novopharm developed a generic version of olanzapine and on or about 2004 filed an abbreviated new drug submission (NDS) with the Minister of Health to obtain its NOC to enable it to sell its version of olanzapine which infringes the '113 Patent.

14 Novopharm filed its statement of defence and counterclaim on July 6, 2007. As noted, it alleged the '113 Patent was invalid on a number of grounds including that its advantages had been overplayed and its side effects have been underplayed making reference to the fact ZYPREXA has been the subject of product liability lawsuits in the United States in which the claim is that ZYPREXA does not have the asserted advantages of: "marked superiority" and a "better side effects profile" but instead causes a number of specified dangerous side effects.

15 Very early on in the action, upon the plaintiffs' motion, Prothonotary Tabib ordered on June 20, 2007 it to be a specially managed proceeding and, subject to any direction or order of the case

management judge or prothonotary, set forth a schedule of further steps to be taken in the action. The schedule fixed dates for the filing and the service of Novopharm's statement of defence and counterclaim, the plaintiffs' reply and defence to counterclaim and, in particular, set September 14, 2007 as the date for serving and filing of respective affidavits of documents with the ability of each party to serve on the other party a request for production of documents which they believe exists, are in the possession, power or control of the other party and should have been listed in their opponent's affidavit of documents but were not with a requirement that the other party respond to such request within twenty one days following the service of such request. [Emphasis mine.] Examinations for discovery of a representative of the defendant was ordered to be conducted by the plaintiffs during the week of October 15, 2007 for a duration of one day. Discovery of the representatives of the plaintiffs was contemplated for November or December 2007. The plaintiffs served their affidavit of documents in late August 2007.

16 The feature in the Prothonotary's initial case management order whereby the parties were obliged to request from one another the correction of deficiencies in the document discovery process was described to the Court as being "novel". After Lilly served its affidavit of documents, Novopharm's counsel served on Lilly two requests for additional productions which were, in part, positively responded to by Lilly's counsel resulting in the productions of:

- Lilly's NDS to Health Canada and the availability of Lilly's new drug application (NDA) to the FDA in the United States. In particular, Lilly's NDS is a 90,000 page document (not including the clinical trial data) and included data on 89 animal studies using olanzapine and 50 human clinical trial studies).
- The production of the communications between Lilly and its Canadian patent agent.
- The statement of claim filed by plaintiffs in the product liability litigation.

17 Remaining unsatisfied, Novopharm then brought a motion for an order compelling the plaintiffs to file a better affidavit of documents and other consequential relief, a motion heard by the Prothonotary on October 15, 2007.

II. The construction of the plaintiffs' affidavit of documents

18 Central to an understanding of Novopharm's motion for the production of a further and better affidavit of documents is how Lilly constructed its affidavit of documents in this action. Prothonotary Tabib had from both sides several affidavits and cross-examinations thereon before her on this issue. The main affidavit of documents was filed jointly by Lilly U.K. and Lilly U.S. [Emphasis mine.]

19 This joint affidavit was based on documents produced in a proceeding in the U.S. District Court commenced by Lilly in April 2001, based on U.S. Patent No. 5,229,382 (the U.S. Patent) issued in 1993, equivalent of the '113 Patent, in order to prohibit the entry onto the market of generic olanzapine products to be manufactured and marketed by three U.S. generic companies, Zenith Goldline Pharmaceuticals Inc. (Zenith), Dr. Reddy's Laboratories Ltd. (Dr. Reddy) and Teva Pharmaceuticals U.S.A. Inc. (Teva) (hereafter the U.S. action). The validity of Lilly's U.S. Patent was put in issue by the U.S. generics.

20 The U.S. action was heard in early 2004; it took less than a month; judgment was rendered in favour of Lilly in the spring of 2005 upholding the validity of its U.S. Patent, a decision upheld by the U.S. Court of Appeal in 2006 with the leave recently denied by the Supreme Court of the United States.

21 In the U.S. action, there were three levels of discovery productions:

- Discovery pursuant to Notice Pleadings. Allegations in Notice Pleadings, unlike in Canada, do not limit the scope of discovery and are not confined to relevant documents because parties can request and conduct discovery on issues that are broader than those in the pleadings and are not tied to relevance such as are found in Rule 222 of the *Rules*. In the U.S. action, according to the affidavit of Mark Feldstein, a U.S. attorney acting for Lilly and responsible for the production of Lilly documents in the U.S. action, informs us that extensive discovery took place in which the defendant generic companies sought wide ranging discovery from Lilly. Lilly produced close to one million pages of documents pursuant to the Notice Pleadings process. Mr. Feldstein instructs us if, in the U.S. action, the Canadian relevance rule applied to affidavit of documents, the volume of documents produced would have been "greatly reduced";
- The second level of production in the U.S. action was production pursuant to the Unified Trial List (the UTL). This process yielded 522 Lilly documents representing 300,000 pages. The UTL represents a compilation of all documents that any of the parties to the U.S. action might seek to rely upon at trial. Mr. Feldstein says at trial, any of the parties could have objected to the admissibility of documents on the UTL including on the basis such documents were not relevant. He stated Lilly U.S. specifically filed pre-trial objections based on the relevance of certain documents on the UTL it had produced in response to the broad ranging discovery requests of the defence;
- The third level of documents are the Admitted Trial List exhibits (ATL). This list of documents, as its name connotes, is made up of those documents which each of the parties to the U.S. action agreed could be entered and marked as an exhibit at trial.

22 David Stemerick is in-house counsel at Lilly US. He deposed two affidavits describing how Lilly U.S. constructed its affidavit of documents for the purposes of the Canadian action. He deposed Lilly's approach was to start with the "extensive production" which had already taken place in the U.S. action where "on many of the same issues, such anticipation, obviousness, fraud based on the dog study, etc., arose in both pleadings." He continues stating: "In the U.S., however, the volume of documents produced was very extensive, even though at the end of the day nearly all of the documents that had been produced were of no value to either party at trial."

23 At paragraph 8 of his reply affidavit sworn in response to Novopharm's motion for the production of a further and better affidavit of documents, he deposed as follows (plaintiffs' motion record, volume 1 page 305):

- "8. Knowing that nearly all of the U.S. production was not relied upon at trial, it was decided that the best approach to comply with Rule 222 of the *Federal Court Rules* would be to determine:
- (a) What documents each of the plaintiffs had that it wanted to rely upon; and
 - (b) What documents in the productions would be of assistance to support Novopharm's case or affect Lilly's case."

24 On August 24, 2007, in this action, it was David Stemerick who swore the joint affidavit of documents for Lilly U.S. and Lilly UK. He referred to Schedule 1 of his affidavit which lists schedules A,

B and C as being all of the documents, or bundles of documents, that are in Lilly's possession, power or control and for which no privilege is claimed. Schedule A contain the Lilly documents in the ATL in the U.S. action; Schedule B headed -- confidential -- are documents from the UTL and Schedule C are eight documents including a certified copy of the '113 Patent, the file history of the '113 Patent, three agreements between Lilly companies, sample invoices and copies of the two decisions in the U.S. action. [Emphasis mine.]

25 In his reply affidavit, Mr. Stemerick deposed the Schedule A documents to Lilly's affidavit of documents were Lilly's documents listed in the ATL on the basis that they were documents that could possibly be of assistance to support Novopharm, either to prove their case or to challenge Lilly's case or affect Lilly's case and at paragraphs 11 to 15 he continued:

- "11. In an abundance of caution, it was decided to go beyond the documents of Schedule A and include all Lilly originating documents in the U.S. Unified Trial Exhibit List. These documents were provided to Novopharm as Schedule B to the extent that they were not part of Schedule A. The Unified Trial Exhibit List is a subset of the documents produced as part of the discovery process. This subset was a compilation of every document that any party to the U.S. proceeding may rely on at trial.
12. It is my belief that Schedule A and B includes all possibly relevant documents in this proceeding. My belief in this regard is based on the fact that many experienced trial attorneys, including attorneys representing companies that are related to Novopharm, had carefully reviewed all of Lilly's productions and the U.S. Defendant's productions, and based on the extensive oral discovery of Lilly witnesses in the U.S. proceeding, concluded that every document that they might rely on at trial was included in the UTL. [Emphasis mine.]
13. It can be readily understood that Schedules A and B do not include every document from the U.S. Unified Trial Exhibit List. Omitted from Schedule B are documents that do not originate at Lilly. For instance, while the Unified Trial List includes documents produced by Dr. Reddy's, Lilly did and could not include Dr. Reddy's documents as:
 - (a) These are not Lilly documents; and
 - (b) Any production in this case would be contrary to the provisions of the protective order under which Lilly was provided these documents.
14. Further, a large number of the documents in the Unified Trial List are articles from the public scientific literature, some of which were previously produced in the s. 55.2 proceeding [The Lilly Novopharm NOC proceeding in this Court previously referred to]. I am advised by my Canadian Counsel and verily believe that prior art is Canada has to be specifically pleaded in the Defence. As such I did not see the need for Lilly to produce these documents. Finally, as discussed below expert reports prepared for the U.S. case were also omitted. [Emphasis mine.]
15. While there is a very large volume of additional documents that were produced in the U.S. litigation, I see no value in producing them in Canada considering that not a single one of these documents excited enough interest to be included by any of the U.S. attorneys on the Unified Trial List. Thus while they may relate to olanzapine, they neither support Novopharm's case nor affect Lilly's case. [Emphasis mine.]"

26 Mr. Stemerick's reply affidavit was largely in response to the affidavit deposed to by Jeffrey Ward who was lead counsel for Zenith in the U.S. action. He had been asked to review the joint affidavit of documents of Lilly U.S. and Lilly U.K., as provided by Mr. Stemerick, to assess whether all documents relevant to the pleadings in Lilly's possession, power or control had been identified and disclosed in this action. He was of the view they were not. As I understand Mr. Ward's affidavit he holds this view based on the following features of the U.S. action:

- It commenced in April 2001 with Lilly U.S. complaint; the discovery phase began in earnest in February 2002 and took 18 months. The trial commenced on January 26, 2004 and was completed in February 2004 with a decision rendered in the spring 2005 and subsequent appeals;
- The U.S. Patent No. 5,229,382, the '382 Patent issued in 1993 whereas the Canadian Patent '113 issued in 1998;
- While the two actions have many of the same issues, Novopharm raised additional issues which would not be covered by any production in the U.S. action. In particular, Novopharm's emphasis in its pleadings on the advantages and disadvantages of olanzapine were substantially different in the way this issue was raised because of the timing of the filing of the Canadian Patent and the fact the Canadian Patent was issued much later than the U.S. one; [Emphasis mine.]
- Mr. Ward gave examples of Lilly's production deficiencies based on different strategies, the timing of the U.S. and the Canadian action and the fact the U.S. action was prosecuted much earlier such that the trial lists in the U.S. action were prepared in late 2003 and early 2004;
- Mr. Ward did not understand why Lilly U.S. had not listed in its Schedule 1B in the Canadian action all documents on the UTL because the parties in the U.S. action considered them relevant noting that many expert reports were on the UTL and since some of these experts would appear in the Canadian action, the production of these expert reports were relevant. He referred to the fact a vast number of pages of production was produced in the U.S. action which were not listed in the Canadian action. He stated Lilly U.S. had not produced relevant clinical trial data mentioning a 1997 Lilly paper entitled "Safety of Olanzapine" involving 2,500 patients on file, data which was important to Novopharm because the Canadian Patent was still in prosecution whereas the U.S. Patent had issued. He was of the view that Novopharm, because it had pleaded that olanzapine does not have the characteristics asserted in the '113 Patent, a fact which he said was substantiated by data contained in Lilly's clinical and toxicological databases making all Lilly clinical trial data on the 2,500 patients relevant.

27 Mr. Ward's conclusions were as follows:

- "43. In sum, the *Zenith* case and the case against Novopharm are not the same. The case against Novopharm raises many of the same issues, though in different ways, than the *Zenith* case argued almost four years ago. Novopharm's defence and grounds of invalidity seem to incorporate many of the grounds asserted in the *Zenith* case but also raises new grounds that were not part of the *Zenith* case and that would require further disclosure.
- 44. Even if the *Zenith* case were an appropriate starting point for disclosure in this

case, it is plain that Eli Lilly has not produced all of the relevant documents in its possession, power and control, nor even lists of those documents. If Eli Lilly here claims only to have 20 boxes of relevant documents, they are about 286 boxes short as compared to the *Zenith* case productions. I believe that all of the documents produced in the *Zenith* case are relevant and should have been produced in the Novopharm case.

45. Lastly, Eli Lilly's statements that they have produced the raw clinical data on 2,500 patients is, as far as I know, not accurate. I do not see any document described in any of the affidavits provided that would incorporate that raw data." [Emphasis mine.]

III. Prothonotary Tabib's November 15, 2007 decision

28 Prothonotary Tabib, who is case managing this action from the very start, rendered a considered, thorough and nuanced decision which may be summarized as follows.

29 First, after noting Novopharm had brought this motion for a further and better affidavit of documents prior to any oral examination for discovery having been held, she stated Novopharm: "has the burden of establishing that documents in the possession, power or control of Lilly exist, are relevant and have not been listed in Lilly's affidavits of documents or subsequently produced pursuant to the request for further production the parties had been required to exchange by a previous scheduling order." [Emphasis mine.]

30 She then engaged in a lengthy review of the jurisprudence whether "relevance" as newly defined in Rule 222 of the *Rules* in 1998 for the purposes of Lilly's document disclosure obligations was more narrow than under the previous rules which had adopted the test set out by the U.K. Court of Appeal in *Compagnie Financière et Commerciale du Pacifique v. Peruvian Guano Co.*, (1882), 11 Q.B.D. 55 in which the words "a document relating to any matter in question in the action" were interpreted to encompass every document which not only would be evidence upon any issue but also which, it is reasonable to suppose, contains information which may -- not which must -- either directly or indirectly enable the party requiring the affidavit either to advance his own case or to damage the case of his adversary" with the reference to the words "either directly or indirectly because a document can properly be said to contain information which may enable the party requiring the affidavit either to advance his own case or to damage the case of his adversary, if it is a document which may fairly lead him to a train of inquiry, which may have either of these two consequences." [Emphasis mine.]

31 She canvassed the jurisprudence developed by Prothonotary Hargrave under new Rule 222 ultimately who had concluded that the *Peruvian Guano* test had not been changed with the enactment of the new rules insofar as what must be covered by an affidavit of documents. Prothonotary Tabib left for another day whether she would have come to the same conclusion as Prothonotary Hargrave whether or not Rule 222(2) "effectively narrows the definition of relevance set out in *Peruvian Guano* notably, by somewhat narrowing the "train of inquiry" test".

32 She did agree with Prothonotary Hargrave's assessment the concept of advancing an opponent's case or defeating one's own is central to relevance both on the *Peruvian Guano* test and on the wording of Rule 222(2). For the purposes of the motion before her, she formulated the test as follows:

"Unless the party producing the affidavit intends to rely on a document at trial, it is not obliged to disclose it unless "it is reasonable to suppose" that the document would undermine its own case, advance its opponent's, or would "fairly lead him to a train of inquiry, which may have either of these consequences".

33 As noted Prothonotary Tabib expressed her conclusions which were reproduced at paragraph 4 of these reasons. Counsel for Novopharm position on the test was that it was correctly framed but that ultimately Prothonotary Tabib did not apply it correctly. Counsel for Lilly thought that the train of inquiry element of the test had been dropped under the new rules but he stated this had no consequence for the motion at hand and accepted for the purposes of this case it had been correctly applied by the Prothonotary.

34 She then stated the question which arose is whether Lilly's approach in determining which of a wider class of documents should be disclosed was reasonable and sufficient. She described the three levels of disclosure previously discussed in these reasons and noted Lilly's affidavit evidence was that, having considered the issues in the U.S. and in the present proceeding, its affiants were satisfied all documents that might possibly relate to the issues in this action had been part of the initial U.S. disclosure and that it was reasonable to assume any document which might undermine its case or assist an opponent's case on these same issues had been selected by Lilly's opponents and included in the UTL and in the ATL.

35 She then said Novopharm's position was as a matter of legal principle, Lilly's disclosure had to include all documents relating to the issues pleaded, thus all of the documents in the initial U.S. production. She observed Novopharm did not argue, other than through the specific categories discussed later in her reasons, that the basis upon which Lilly proceeded was unreasonable or that applying that method resulted in relevant documents being omitted. She was satisfied, in the circumstances of this case, Lilly's affiants did not proceed unreasonably and referring to Mr. Stemerick's affidavit in which he stated he was satisfied a diligence search had already been conducted for the purpose of the U.S. litigation and that he made inquiries, which she found appear on their face to be reasonable and appropriate, to determine which of those documents corresponded to Rule 222(2) definition concluding: "I can find no fault with this approach generally." [Emphasis mine.]

36 However, she cautioned it may be this approach proved in practice unreliable or insufficient in that it failed to "catch" relevant documents and stated a review of the documents which Novopharm contends are missing would be indicative of whether, despite an apparently reasonable method of identifying documents, Lilly missed relevant documents and should therefore be required to conduct a reassessment of its documents. She then proceeded to consider the specific categories of documents which Novopharm contends are missing. They were:

- Clinical trial documents;
- Internal memos and documents relating to clinical trials;
- Correspondence between Lilly and Health Regulators in Canada and in the US;
- Certain documents from product liability litigation related to olanzapine where Lilly was a defendant;
- Expert reports from other litigation; and
- Prior art produced in the U.S. action.

She went on, in the balance of her reasons, to consider each of those categories. I discuss her findings separately for each.

i) Clinical trial documents

37 These documents she ruled is relevant and said Lilly had identified and produced them up to and until 2001. Beyond 2001, Prothonotary Tabib was satisfied such documents existed and likely related to side effects profiles that may tend to advance Novopharm's position. She ordered their production in the following terms: "Lilly has the continuing obligation, and will in any event be specifically ordered, to

review its records to determine whether clinical trial documents created after 2001 exist and have not been disclosed, and if so, to include them in a further and better affidavit of documents." [Emphasis mine.]

ii) Internal memos and documents relating to clinical trials

38 On the basis of the record before her, she was satisfied such documents created prior to 2001 "would have been included in the initial documentary productions in the U.S. litigation and have already been considered for relevance and included as necessary in Lilly's affidavit of documents" but not those created post 2001. She was of the opinion: "the only fact in issue to which post-2001 internal comments or communications might relate is the objective existence or non-existence of the advantages disclosed or claimed in the patent." She stated this issue was clearly a matter of objective scientific fact, to be established by expert evidence on the basis of the data which Lilly has or will disclose." She was of the view "what Lilly or its employees think or believe as to the conclusions to be drawn from the data is irrelevant and cannot advance Novopharm's case unless Lilly has made on those issues corporate statements amounting to admissions" but she considered internal communications between employees cannot be reasonably supposed to include corporate statements." She could not see how internal documents of Lilly commenting on the clinical trial data be reasonably supposed to lead to a train of inquiry that would advance Novopharm's case or hurt Lilly's. She so felt because Novopharm's motion record did not suggest how that might be and because such documents would lead back to the original data to which they relate and as this data has or will be provided: "a document that has no use but to refer to it can have no discernable benefit to Novopharm." She stated: "Even if these internal memoranda could be construed as technically included in the definition of Rule 222(2) because they lead back to the clinical trial data, I would exercise my discretion to relieve Lilly from their disclosure." [Emphasis mine.]

39 However she noted Novopharm argued such communications might contain statements damaging to Lilly such as admitting that certain information was known to Lilly at the time of the prosecution of the patent, but not disclosed to the Patent Examiner. She ruled: "Obviously, if any internal documents of Lilly contain such statements, the particular documents are relevant and have to be disclosed." and ordered: "It should therefore, as part of its continuing obligation of disclosure, Lilly to make reasonable inquiries or take reasonable steps to ensure that internal documents that might contain such damaging admissions are reviewed and disclosed if they exist." [Emphasis mine.]

iii) Correspondence between Lilly and Health Regulators

40 The correspondence between Lilly and the Food and Drug Administration in the United States or Health Canada focuses on product monographs and labelling changes to include warnings as to the side effects of olanzapine. The evidence before her suggested such documents had been disclosed pre-2001 but not post-2001.

41 Such correspondence was not ordered to be disclosed since she was satisfied this class of documents would not advance Novopharm's case, undermine Lilly's or be susceptible of leading to a train of inquiry having either result because based on Novopharm's evidence: "this correspondence would squarely be based on and would merely interpret or discuss the clinical data which Lilly has already or will be disclosing." which led her to state: "It cannot reasonably be supposed that Lilly has, in this correspondence, admitted to any other side effects than those against which publicly available labels and product monograph warn and since the only information to which this correspondence might be supposed to lead is the same clinical data and reports which have or will be produced." [Emphasis mine.]

iv) Documents from products liability litigation

42 Novopharm identified eight documents which Lilly had not listed in its affidavits of documents which stem from product liability actions in relation to ZYPREXA which Lilly faces. These documents were covered by confidentiality orders in the U.S. but were leaked to the New York Times and posted on the internet. Three of these documents are post-2001 whereas five of the documents precede the issuance of the '113 Patent in 1998.

43 She ordered the disclosure of the pre-1998 documents (R to V) finding they contained information that may tend to advance Novopharm's case because they may directly or indirectly establish the state of Lilly's knowledge of side effects prior to the issuance of the patent and stated the fact: "that five relevant documents created before 2001 could be identified by Novopharm indicates that the process used by Lilly to search for and identify relevant documents may not have been adequate. Lilly will be required to review its documents with a view of ensuring that all relevant documents are disclosed." [Emphasis mine.]

44 She stressed that documents "R" to "V" were relevant because of the specific information they contain. She said: "Having specific regard to document "R", other documents that can be described as being in the same class of documents (i.e. correspondence) cannot reasonably be supposed to necessarily contain that type of information, and may be irrelevant." She added "Novopharm is only entitled to disclosure of the documents from this class of documents that are relevant; it is entitled to know that Lilly has reviewed its documents to identify and disclose any documents which may contain similarly relevant information." As mentioned before, Novopharm is not entitled to have disclosure of the entire class of documents to satisfy itself that relevant documents have not been overlooked."

45 She did not order the production of documents labelled "O", "P" and "Q" which post-dated the issuance of the '113 Patent. She stated that, "At best, they discuss what Lilly knew, as of their date, as to certain side effects of ZYPREXA; adding that Lilly's subjective knowledge after the issuance of the patent is not relevant." She stated: "To the extent the documents discuss objective facts, they can only lead back to the data discussed therein, which data has or will be provided." She stated: "Mainly, as well, the documents concern the perceptions of other persons on that matter and do not contain any information as to what Lilly knew up to and including the date of the issuance of the patent or what Lilly might have represented to the Patent Examiner." On this basis, she found these documents could not, directly or indirectly, advance Novopharm's case or undermine Lilly's, and that as a consequence, they do not have to be disclosed in Lilly's affidavit of documents.

v) Expert reports from other litigation

46 Prothonotary Tabib did not order the listing in Lilly's affidavit of documents expert reports prepared for the purpose of other litigation on the grounds they were not relevant.

47 She was of the view any such report would have been created after the date of the issuance of the patent and would only speak what a third party -- the independent expert in question -- thinks or believes of the issues in question as of the date they were created, and are therefore irrelevant. She did say, however, to the extent the reports discuss and therefore could lead to, relevant factual information, it is information that may be relevant and subject to disclosure. She ruled: "If that information is in Lilly's power, possession or control, it should already have been and should be disclosed."

vi) Prior art produced in the U.S. action

48 Prothonotary Tabib stated it was trite law: "that only that prior art which is specifically alleged in pleadings is relevant and that for the purpose of Novopharm's allegations of anticipation and obviousness, Lilly did not have to disclose any document as to prior art in its possession, power or control unless it

intends to rely upon it at trial or it is specifically alleged in Novopharm's pleadings." She nuanced this ruling by stating: "However, because Novopharm's pleadings raise, as an issue, the objective non-existence of the advantages claimed or disclosed in the patent and the invention's objective failure of utility, documents -- whether internal to Lilly or publicly available -- within the possession of Lilly which would advance Novopharm's case on that issue must be disclosed."

49 She concluded on this point that the evidence before her shows that Lilly automatically excluded from its disclosure all published documents not created by Lilly and not specifically alleged by Novopharm, on the basis that these were un-alleged, and therefore irrelevant prior art. She ruled that Lilly failed to consider whether these documents could be used to support Novopharm's assertion that olanzapine does not in fact have the asserted advantages or effects. She ordered that Lilly must conduct a review of these documents and disclose those that may tend to advance Novopharm's case or hurt its own on these issues.

IV. Analysis and conclusions

(a) The standard of review:

50 The standard of review, in this case, speaks to the deference owed by a judge of this Court to a decision by a case management Prothonotary on an appeal pursuant to section 51 of the *Federal Courts Rules, 1998*. In my view, two levels of deference are at play here: first, the usual deference owed to Prothonotaries and second, the deference owed to a Prothonotary exercising case management functions.

51 The normal deference owed to Prothonotaries has been settled by the Federal Court of Appeal in *Canada v. Aqua-Gem Investments Ltd.*, [1993] 2 F.C. 425 where Justice MacGuigan wrote at paragraph 95 the following:

Following [page463] in particular Lord Wright in *Evans v. Bartlam*, [1937] A.C. 473 (H.L.) at page 484, and *Lacourciere J.A. in Stoicevski v. Casement* (1983), 43 O.R. (2d) 436 (Div. Ct.), discretionary orders of prothonotaries ought not to be disturbed on appeal to a judge unless:

- (a) they are clearly wrong, in the sense that the exercise of discretion by the prothonotary was based upon a wrong principle or upon a misapprehension of the facts, or
- (b) they raise questions vital to the final issue of the case.

Where such discretionary orders are clearly wrong in that the prothonotary has fallen into error of law (a concept in which I include a discretion based upon a wrong principle or upon a misapprehension of the facts), or where they raise questions vital to the final issue of the case, a judge ought to exercise his own discretion de novo.

52 This test was inversed by Justice Décarý in *Merck & Co. v. Apotex Inc.*, (2003) 30 C.P.R. 4th 40 after a discussion as to what Justice MacGuigan meant by the phrase "questions vital to the final issue of the case" which Justice Décarý interpreted to mean vital to the final resolution of the case (for example an interlocutory motion to dismiss for want of prosecution). In *Merck*, above he wrote at paragraph 19:

[19] To avoid the confusion which we have seen from time to time arising from the wording used by MacGuigan J.A., I think it is appropriate to slightly reformulate the test for the standard of review. I will use the occasion to reverse

the sequence of the propositions as originally set out, for the practical reason that a judge should logically determine first whether the questions are vital to the final issue: it is only when they are not that the judge effectively needs to engage in the process of determining whether the orders are clearly wrong. The test would now read:

Discretionary orders of prothonotaries ought not be disturbed on appeal to a judge unless:

- a) the questions raised in the motion are vital to the final issue of the case, or
- b) the orders are clearly wrong, in the sense that the exercise of discretion by the prothonotary was based upon a wrong principle or upon a misapprehension of the facts.

53 In *Merck*, above, Justice Décary discussed the concept of "vital to the final issue of the case" in the context of the issue before him which was whether the judge failed to exercise his discretion *de novo* as to whether the Prothonotary erred in allowing an amendment to a statement of defence. He stated at paragraph 22 the test for vitality "is a stringent one" and "the use of the word "vital" is significant" characterizing the amendment before him as one which created entirely a new defence, a "dramatic departure" from a position previously advanced that would go to the heart of a claim and would require new expert evidence that could not have being contemplated at the discovery stage in view of the pleadings in contrast to routine amendments to pleadings.

54 It is important to note Justice Décary in that case cautioned "it would be imprudent to attempt any formal categorization" and "it would be preferable to determine the point on a case by case basis."

55 In the context of this case, I consider Prothonotary Tabib's November 15, 2007 order on Novopharm's motion for a further and better affidavit of document as an order not vital to the final resolution of the action taking into account the following factors: the procedural nature of the order -- the production of a further affidavit of documents; the unique feature of her first case management order compelling the parties to make to each other requests for additional productions which were responded positively in part by Lilly resulting in significant additional document. The intent of this requirement was to spur the parties' cooperation and avoid unnecessary motions or delays; the timing of the order -- which was effective prior to the oral discovery of the plaintiffs; its scope -- where Novopharm obtained substantive additional documentary production, an obligation imposed on Lilly to conduct additional documentary searches and production coupled with Lilly's continuing obligation to disclose under the Rules.

56 Justice Martineau in *Apotex Inc. v. Merck & Co.* (2004), 33 C.P.R. (4th) 387 came to a similar conclusion in identical circumstances where Apotex sought an order from a case management prothonotary that the plaintiff Merck & Co. file a further and better affidavit of document. His conclusion on this point was not disturbed on appeal (See *Apotex Inc. v. Merck & Co.* (2005), 38 C.P.R. (4th) 289). (See also Justice Hugessen's decision in *Sawridge Band v. Canada*, [2001] F.C.J. No. 1488, 2001 FCT 1089 where he refused the plaintiff's request for a further and better affidavit of documents.)

57 The result is that this Court will not review Prothonotary Tabib's order *de novo*. Novopharm must show Prothonotary Tabib's order was clearly wrong, i.e. her discretion was based upon a wrong principle or upon a misapprehension of the facts.

58 In the circumstances of this case, I am of the view, as a case manager, she is entitled to an additional level of deference as recognized by the Federal Court of Appeal in *Sawridge Band v. Canada*, [2002] 2

F.C. 346 where Justice Rothstein at paragraph 11 stated that case management judges [or prothonotaries] "must be given latitude to manage cases. This Court will interfere only in the clearest case of misuse of judicial discretion."

59 I am aware of the Federal Court of Appeal's finding in *Merck & Co. v. Apotex Inc.*, [2003] F.C.J. No. 1725, 2003 FCA 438 a case where the prothonotary fettered his discretion by failing to consider whether questions asked on discovery were relevant. Justice Strayer held that Rule 385 of the *Rules* dealing with the scope of case management did not authorize a prothonotary to deny a party the legal right to have questions answered on examination for discovery which are relevant to the issues in the pleadings, a right clearly spelled out in Rule 240. Justice Strayer said the general words of Rule 385(1)(a) or Rule 3 were not sufficient "to override that specific right". For reasons expressed below, I do not think this case has any application to the circumstances of this case.

(b) Was the Prothonotary's Order discretionary?

60 In its written representations, counsel for Novopharm writes at paragraph 51 the following:

51. Although Rule 227, one of the Rules under which the motion below was brought, is superficially framed in a way that suggests there is discretion in the decision whether to order any of the remedies provided, "relevance" is not a matter of discretion. Many of the holdings made by the Prothonotary related to the relevance of classes of documents and were not discretionary in nature. Similarly decisions made in the absence of evidence are jurisdictional errors and are not properly the subject of the standard of review applicable to discretionary decisions.

61 Counsel for Novopharm seems to accept that at one level the Prothonotary has a discretion, whether or not depending on the circumstances of the case, to order the production of a further and better affidavit of documents as one of the several remedies provided in Rule 227. The existence of such a discretion is clear from the wording of Rule 227 where the Court is given remedial options where it finds that an affidavit of documents is inaccurate or deficient. In the very case at hand, the Prothonotary did order Lilly to provide a further and better affidavit of documents in respect of some categories of documents which she found the affidavit of documents deficient.

62 Novopharm's real complaint is that the Prothonotary did not order Lilly to produce a further and better affidavit of documents in respect of the categories of documents she excluded and, in particular, the correspondence between Lilly and Health regulators, internal comments or communications on the existence or non-existence of the advantages disclosed or claimed in the patent except corporate statements amounting to admissions or internal documents containing statements damaging to Lilly such as that certain information was known at the time Lilly was prosecuting the patent but not disclosed to the Patent Examiner and certain documents in the product liability litigation.

63 There is ample authority which I accept, for counsel for Novopharm's basic proposition that the disclosure in an affidavit of documents is a matter of relevance and not discretion. Rule 222 is clear that "an affidavit of documents shall be in Form 223 and shall contain a separate list and description of all relevant document ...". Justice McNair in *Reading & Bates Construction Co. v. Baker Energy Resources Corp. et al* (1988), 24 C.P.R. (3d) 66 wrote as follows:

The test as to what documents are required to be produced is simply relevance. The test of relevance is not a matter for the exercise of the discretion. What documents parties are entitled to is a matter of law, not a matter of discretion.

The principle for determining what document properly relates to the matters in issue is that it must be one which might reasonably be supposed to contain information which may directly or indirectly enable the party requiring production to advance his own case or to damage the case of his adversary, or which might fairly lead him to a train of inquiry that could have either of these consequences. [Emphasis mine.]

64 This is not to say, however, the Court lacks jurisdiction not to compel the production of relevant documents in some circumstances. As Justice Hugessen put it in *Eli Lilly and Co. v. Apotex Inc.* (2000) 8 C.P.R. (4th) 413: "There is a discretion remaining in this Court to restrict the scope of discovery ...". In that case Justice Hugessen found that the relevant documents were of marginal relevance. (See also *Pharmacia S.p.A. v. Faulding (Canada) Inc.* (1999) 3 C.P.R. (4th) 126 where the Federal Court of Appeal held that: "Although there is a broad right of examination, this Court has held that there are limits on that right of discovery; the Court will not allow the discovery process to be used as a fishing expedition."

65 In *Reading & Bates*, above where McNair J. also stated: (1) "The court should not compel answers to questions which, although they might be considered relevant, are not at all likely to advance in any way the questioning party's legal position." and (2) "Before compelling an answer to any question on an examination for discovery, the court must weigh the probability of the usefulness of the answer ... with the time, trouble, expense and difficulty involved in obtaining it."

66 Finally on this point, I refer to Justice Strayer's decision in *Merck & Co. v. Apotex Inc.*, [2003] F.C.J. No. 1725, 2003 FCA 438, above, where he wrote the following in connection with a motion to compel answers to questions on examination for discovery:

The jurisprudence in this Court on the scope of discovery is well settled. For convenience it is summarized in *Reading & Bates Construction Co. et al v. Baker Energy Resources Corp. et al* (1988) 24 C.P.R. (3rd) 66 at 70-72 (F.C.T.D.). It is clear that the primary consideration is relevance. If a prothonotary or a judge does, however, find a question to be relevant he or she may still decline to order the question to be answered if it is not at all likely to advance the questioner's legal position, or if the answer to a question would require much time and effort and expense to obtain and its value would appear to be minimal, or where the question forms part of a "fishing expedition" of vague and far-reaching scope.

(c) Did Prothonotary Tabib err in law?

67 As noted Novopharm raises three errors of law which I discuss below. Before doing so, it is important to read the Prothonotary's decision as an integral whole and not microscopically isolating a concept here and there.

(1) The partial discovery issue

68 Counsel for Novopharm argues the Prothonotary erred in law by accepting that partial documentary discovery prior to the commencement of oral examinations for discovery was an acceptable practice. He points to her finding Lilly's process of searching for documents failed to catch relevant documents. He says that at paragraphs 11 and 61 of her reasons reflects her view that Novopharm's complaints ought to be dealt with through informal requests on examination for discovery. He argues many of the documents are very technical and counsel on discovery would need the assistance of experts.

69 It is well established the production of documents, before examination for discovery and trial is one of our most important procedures and that fairness dictates that each side should have full documentary discovery as well as proper preparation time before examination (see *Rhodia UK Ltd. v. Jarvis Imports* (2000) Ltd., [2005] F.C.J. No. 2003, 2005 FC 1628 at paragraphs 18 and 19 with Justice Tremblay-Lamer concluding at paragraph 48 that "production of documents is recognized as an essential cornerstone of the discovery process. In the absence of production of documents, the Plaintiffs cannot conduct effective examinations for discovery").

70 Based on this jurisprudence including Prothonotary Hargrave's decision in *Havana House Cigar & Tobacco Merchants Ltd. et al v. Naeini et al* (1998), 80 C.P.R. (3d) 132, at paragraph 23 if Prothonotary Tabib's perspective was as counsel for Novopharm suggests, she would have committed an error in law and this be clearly wrong.

71 However, as I read her decision there is no basis for counsel's argument for the following reasons:

- She expected the documentary production she ordered in her decision to be produced by December 15, 2007 well before the start of discoveries (see paragraphs 2 and 3 of her order).
- I do not read her paragraph 11 to endorse the concept of partial documentary discovery before oral discovery or the resolution of informal requests on oral examination.

(2) The misapplication of the test for relevance issue

72 Counsel for Novopharm states that "although the words of Rule 222(2) appear to provide a definition of relevance, the rule in *Peruvian Guano* applies in the Federal Court and serves to apply the "train of inquiry" test to discovery." He states "if a document contains information which may either directly or indirectly undermine the producing party's case, advance the receiving party's case or may fairly lead him to a train of inquiry which may have either of these consequences" then it is relevant and must be produced.

73 He then outlines the Prothonotary's error in the following terms at paragraphs 64, 65 and 66 of his written memorandum:

64. While the Prothonotary ultimately conceded that this test applies, she failed to apply it correctly. At paragraph 19 of her Reasons, the Prothonotary articulates her understanding of how the "train of inquiry" test ought to apply. She states that "if a document can only reasonably be construed as supporting the disclosing party's case, and cannot be **shown** to lead to information that would reasonably be supposed to be helpful to its opponent then it need not be disclosed" [Emphasis added]. She describes the inability to "show" these things as "precisely the type of fishing expedition which the jurisprudence of this Court consistently refused to sanction." This conclusion is directly in conflict with the binding decision of the Federal Court of Appeal in *Apotex Inc. v. Canada, supra*, that "all relevant documents must be included in an affidavit of documents irrespective of whether or not the party filing the affidavit intends to rely on that document".

Apotex Inc. v. Canada, supra, at paragraph 36

65. As highlighted, the Prothonotary was of the view that the party seeking

disclosure must **show** that a document that has not been produced would lead to information falling within the "train of inquiry" requirements. Documents which are only "neutral", whatever that might mean, are categorically not relevant according to the Prothonotary. The Prothonotary explains at paragraph 20 that the arbiter of "relevance and "neutrality" is the disclosing party who, it must be assumed, is acting in "good faith".

66. This finding is perverse. The party seeking disclosure could never "show" anything with respect to a document it has not seen and, similarly, could not demonstrate that an unseen document is not "neutral". How this might be accomplished was not explained by the Prothonotary. In Novopharm's submission, the Prothonotary's articulation of the "train of inquiry" test sets the bar impossibly high, particularly in a case such as this one where the documents being sought are highly technical and require **expert review** to fully appreciate and understand.

74 In her decision, Prothonotary Tabib set out the test for relevance in paragraphs 18 and 19 and explained the test in her own words. These sections read:

[18] I do, however, agree with Prothonotary Hargrave's assessment in *Seaspan*, [2004] F.C.J. No. 161, that the concept of advancing an opponent's case or defeating one's own is central to relevance, both on the *Peruvian Guano* test and on the strict wording of Rule 222(2). Unless the party producing the affidavit intends to rely on a document at trial, it is not obliged to disclose it unless "it is reasonable to suppose" that the document would undermine its own case, advance its opponent's, or would "fairly lead him to a train of inquiry, which may have either of these two consequences".

[19] In other words, it is not sufficient for a document to merely relate to the facts at issue. If, for example, a document can only reasonably be construed as supporting the disclosing party's case, and cannot be shown to lead to information that would reasonably be supposed to be helpful to its opponent, then it need not be disclosed in an affidavit of documents. A document which is neutral and can only reasonably be supposed to lead to other similarly neutral documents is not relevant for the purpose of an affidavit of documents. And on a motion for a further and better affidavit of documents, the reasonable possibility that a document can have or lead to one of the desired effects must be established by the moving party. To say that a document might conceivably lead to other documents, which, although not in themselves relevant, might then conceivably lead to useable information, is not enough. It is precisely the type of fishing expedition which the jurisprudence of this Court consistently refused to sanction. That is not to say that the moving party must establish that the document sought will necessarily lead to useable information: a reasonable likelihood will suffice; an outside chance will not.

75 I am satisfied there is no merit to Novopharm's argument on this point when the Prothonotary's reasons are read in their entirety as a whole. Such a review demonstrates she applied the test which Novopharm states is applicable in the matter as set out in paragraph 18 of her reasons which is based on section 222(2) of the *Rules* the use of which was not objected to by Lilly.

76 Prothonotary Tabib applied that same test when she considered each class of documents suggested by Novopharm. I need only to refer to paragraphs 37, 38, 41, 45, 48 and 49 of these reasons.

77 To the extent the example she gave cited at paragraph 19 of her reasons deviates from the test set out in Rule 222(2), a finding which I am not obliged to make, it was made in obiter and did not affect her correct application of the test as she expressed it in the previous paragraph.

78 Finally, in argument, counsel for Novopharm stated Prothonotary Tabib set the bar impermissibly high when she imposed the obligation on Novopharm to show that a document which had not been produced met the train of inquiry test. This is not the case in my view. A reading of her judgment in its entirety reveals that she focused on the concept "reasonable to suppose that a document may contain information directly or indirectly enabling a party seeking discovery ..." This concept is an integral part of the *Peruvian Guano* test. The Prothonotary equaled this concept with "a reasonable possibility that a document can have or lead to one of the desired effects." She held that to say a document might conceivably have that effect was not sufficient. In my view her finding on this point was correct.

(3) The relevance as a matter of discretion issue

79 These reasons have already discussed the scope of the discretionary power residing in the Court to require the filing of a further and better affidavit under Rule 227 as well as its discretionary power to dispense with the production of relevant documents. Novopharm's argument seems to focus on the Prothonotary's finding on the relevance of internal memoranda with respect to clinical trials and her statement at paragraph 31 of her reasons where she would "exercise my discretion to relieve Lilly from their disclosure" such internal documents "even if they would be construed as technically included in the definition of relevance because they lead back to the clinical trial data". As I see it, she exercised her residual discretion not to compel the production of technically relevant documents when such production would have no beneficial benefit to Novopharm. In my view, this is a proper exercise of her discretion (see Strayer J.A., *Merck & Co. v. Apotex Inc.*, above, at paragraph 66 of these reasons.)

80 In terms of errors of law, I find none based on the arguments submitted by Novopharm.

(d) Did Prothonotary Tabib err in fact?

81 The standard of review on these questions on an appeal from the Prothonotary is that Novopharm must show the error is palpable and overriding in order to overturn a factual finding.

82 I conclude Novopharm has failed to meet this standard and for this conclusion I rely upon Lilly's memorandum of fact and law at paragraphs 79 to 89.

83 For these reasons, Prothonotary Tabib was not clearly wrong in making her November 15, 2007 order nor was there a misuse of judicial discretion.

JUDGMENT

THIS COURT ORDERS AND ADJUDGES this appeal from Prothonotary Tabib's November 15, 2007 decision is dismissed with costs to the Plaintiffs in any event of the cause taxed at the upper scale of Column IV.

LEMIEUX J.

cp/e/qlaim/qlpxm/qltxp/qlcam/qltxp/qlrxg

Indexed as:

Liebmann v. Canada (Minister of National Defence)

Between

**Lieutenant (N) Andrew S. Liebmann Canadian Forces (Reserve),
plaintiff, and
Minister of National Defence and Chief of the Defence Staff and
Her Majesty the Queen, defendants, and
The League for Human Rights of B'Nai Brith Canada, intervenor**

[1994] F.C.J. No. 1955

[1994] A.C.F. no 1955

87 F.T.R. 154

52 A.C.W.S. (3d) 505

Action No. T-306-93

Federal Court of Canada - Trial Division
Vancouver, British Columbia

Hargrave, Prothonotary

Heard: December 8, 1994

Judgment: December 20, 1994

(9 pp.)

*Practice -- Discovery -- Production and inspection of documents -- Remedy for failure to produce --
Procedural issues -- Charter cases.*

Application to strike out the amended defence due to the failure on the part of the defence to supply complete disclosure of documents or, alternatively, for an order that three individuals submit to cross-examination on their affidavits of documents at the cost of the defendants. The plaintiff brought an action against the Minister of National Defence and others. He claimed that he was discriminated against by reason of religion when he was unsuccessful in his attempts to gain the position of executive assistant to the Commander in the Persian Gulf. Difficulties arose concerning production of documents by the defence.

HELD: Application allowed. A letter that did not refer to the nature of the plaintiff's grievance was not required to be produced as it was not relevant. The defence failed to search for documents in a satisfactory manner so that there were gaps in the documentation presented to the plaintiff. The onus was

on the defendant to show that they made reasonable searches and they failed to satisfy this onus. The defence also took too much time to produce the documentation that was given to the plaintiffs. It was inappropriate to strike out the defence over a procedural issue, particularly in a case that involved the Canadian Charter of Rights and Freedoms. Charter cases, particularly those involving section 1, required full evidentiary disclosure. The appropriate remedy was to order that the plaintiff have cross-examination of the three deponents of the affidavits of documents at the cost of the defendants.

Statutes, Regulations and Rules Cited:

Canadian Charter of Rights and Freedoms, 1982, s. 1.

Gerald S. Levey and Samuel D. Hyman, for the plaintiff.
Terrence Joyce, for the defendants.

1 HARGRAVE, PROTHONOTARY (Reasons for Order):-- This action arises out of the inability of the Plaintiff, an officer in the Canadian Naval Reserve, to obtain an advertised appointment to serve as an executive assistant to the Commander, Canadian Forces Middle East, in 1991 when Canadian Forces were placed on active service in the Persian Gulf.

2 The amended Statement of Claim sets out, among other things, that he was discriminated against by reason of his religious background. However, the importance of the proceedings go beyond Lieutenant Liebmann's situation for while he asks for a declaration that he has been deprived of constitutional rights, he also asks for an injunction to allow all Canadian Force members to be selected for any postings without regard to ethnic, racial or religious background. Indeed, counsel for the Plaintiff and counsel for the Defendants both stressed the importance of the issue at stake.

Relief Sought

3 Part of the relief sought by the Plaintiff was an Order that the Defendants provide nominees for examination for discovery, the Plaintiff having made that request some thirteen months ago. However, after the filing of the motion and several days before the motion was heard the Defendants nominated their candidates for discovery. While this may in part be explained by the Justice Department having to check the suitability of a number of candidates, there is also the appearance that it took this motion to galvanize the Defendants into making the nominations. That is a factor to consider in the context of costs.

4 Remaining to be dealt with is an application to strike out the entire amended defence by reason of a failure to supply complete disclosure of documents, or alternatively an Order that the deponents of the three affidavits of documents submit to cross-examination on their affidavits of documents, at the cost of the Defendants; an application that the Defendant, Her Majesty the Queen, reply to written questions in a letter from the Plaintiff's solicitor to the Defendants' solicitor dated March 15, 1994; and costs.

5 In addition counsel for the parties agreed I should look at a letter, delivered to the Court in a sealed envelope, from the Chief of Defence Staff to Mr. T. Hockin, dated September 30, 1991, and then rule on production of the letter.

6 The Defendants have raised a number of points, including the manner of production of documents by the Plaintiff. Those issues have either been resolved or are non-issues.

Production of the Hockin Letter

7 The Defendants have refused to produce a letter from the Chief of the Defence Staff to Tom Hockin, P.C., which is referred to in a produced National Defence memo of October 31, 1991, on the grounds of relevancy. Counsel have agreed I consider the letter and rule on production.

8 Generally, a court cannot at a early stage know exactly what is or is not relevant to the issues set out in the pleadings. However, I must keep in mind the basic purpose of our rules which is to insure open and complete discovery before trial both to facilitate settlement and if necessary, to make the trial process efficient and fair.

9 The test to apply is that if documents have some semblance of relevancy, they should be produced at this stage, leaving it to the trial judge to make the final determination of relevancy: see for example *Toronto Board of Education Staff Credit Union Ltd. v. Skinner et al.* (1984), 46 C.P.C. 292 at 296.

10 The Hockin letter is a very general document dealing superficially with armed force grievance procedure as applied to another officer. The letter does not refer in any way to the nature of the grievance. I do not see that it is relevant in these current proceedings.

Questions - 15 March 1994 Letter

11 Another aspect of the motion requires answers to what are termed written questions in a March 15, 1994 letter. Those items are not questions, but rather types of documents which the Plaintiff believes may have been omitted from the Defendants' affidavits of documents. There are no questions, as such, to answer. Rather these are areas to consider when looking at the Defendants' efforts, overall, to produce documents, to which I now turn.

Production of Documents

12 The Plaintiff asks that the amended defence be struck out entirely because the Defendants have not provided complete disclosure of documents, or in the alternative, asks leave to cross-examine the deponents on their affidavits of documents.

13 Counsel for the Plaintiff, on the basis both of affidavit material and of the affidavits of documents themselves, submits that there has been less than full discovery of documents. Counsel for the Crown relies on affidavit material which, he submits, shows that there has been full disclosure.

14 To begin, on an application for production of further documents, I may look at not only the affidavit material, but also the pleadings, the proceedings in the action and the affidavits of documents themselves: *Mark Fishing Co. Ltd. v. United Fishermen & Allied Workers' Union et al.* (1968), 68 D.L.R. (2d) 410 at 416 (B.C.C.A.).

15 I have also kept in mind that one of the most important procedures, before trial, is discovery of documents and particularly where it is the Defendant who knows what happened and who should have the larger number of documents, with the Plaintiff having minimal information and documents. Discovery of documents is one means of penetrating the military's operation. However, the party pressing for further documents, the Plaintiff in this instance, must have persuasive evidence that documents are available, but have not been produced, rather than speculation, intuition and guess work that other documents exist: for example *Bow Helicopters v. Textron Canada Limited et al.* (1981), 23 C.P.C. 212 at 215 (Ont. Master) and *Greymac Trust Co. et al. v. Burnett et al.* (1987), 59 O.R. (2d) 50 at 57 (Ont. H.C.).

16 If some specific documents had been overlooked, the Plaintiff is entitled to a remedy. Similarly, if

many documents have been withheld, although it may not be clear which documents or classes of documents have been withheld, the Plaintiff may have a remedy, for example cross-examination on the affidavits of documents, as was allowed in *Nelma Information Inc. et al. v. Holt et al.* (1985), 50 C.P.C. 116 (Ont. H.C.). We now turn to the evidence, beginning with the affidavits of documents.

17 The affidavits of documents sworn on behalf of the Minister of National Defence and Chief of Defence Staff, by Major Roger Strum, and the affidavit of documents sworn on behalf of Her Majesty the Queen, by Deborah MacCulloch, each set out that the deponent conducted a diligent search of the Department of National Defence records and has made appropriate enquiries of others, without specifying who the others might be. Interestingly, the lists of documents produced, in each of the three affidavits, are identical. That sameness could be explained by the fact that the deponent, in each case, has searched Department of National Defence records and perhaps has made the same enquiries of others. However, as Mr. Justice Muldoon pointed out in his June 23, 1994, reasons in this matter, requiring each of the Defendants to file an affidavit of documents:

There may be documents held in the offices of one defendant but not the other. The offices, files and computer records of each of the defendants could well have notional or real nooks and crannies different from those of their co-defendants. (p. 9)

18 By an affidavit of December 5, 1994, the Defendants add to the limited search and inquiry paragraph in the three affidavits of documents to the effect that a solicitor with the Judge Advocate General's office and the Department of Justice solicitors for the Department of Foreign Affairs have searched diligently, but have found no additional documents. The affidavit is short on specifics as to who searched and where they searched.

19 A reading of the affidavit sworn by Lieutenant Liebmann suggests that several specific documents are missing, however the Defendants, in their affidavit material, point to the specific documents, including a memorandum of October 31, 1991, which is document no. 94, C.F.A.O. 20-53, an employment policy for peace-keeping officers, which is document no. 30, and to the production of various documents referred to in a hand-written minute of October 31, 1991.

20 All or substantially all of the specific documents sought by the Plaintiff seem to have been produced. To the extent that there may be additional specific documents, their production (subject to any examination on the affidavits of documents) would best be dealt with on examination for discovery.

21 There are, however, general gaps in the production of documents and it may be that many documents have not yet been discovered and produced by the Defendants.

22 The Plaintiff submits that there are a number of categories of missing documents including

1. The general messages to all Naval Reserve Divisions asking for volunteers for service in the Persian Gulf generally, and particularly for an appointment as Executive Assistants to COMCANFORME;
2. All messages and documents between HMCS "Scotian" and COMARCOM and NDHQ, respecting Lieutenant Nisbet's application, including communications subsequent to his application on January 23, 1991;
3. Copies of any communications from Canadian diplomatic posts in Saudi Arabia, Kuwait, Bahrain, Qatar or the United Arab Emirates, regarding any restrictions they placed on the personnel make-up of allied forces

- proceeding to the Gulf;
4. Copies of any communications from the Governments of Saudi Arabia, Kuwait, Bahrain, Qatar or the United Arab Emirates, between August 2, 1990 to February 27, 1991, addressed to Canada or the Canadian Forces, placing restrictions on which members of the Canadian Forces they would permit to serve in the Persian Gulf area;
 5. Copies of written memoranda between any two of Commodores Johnson, Westroop, and Summers, concerning the selection of the Plaintiff for the posting he applied for, including the dates, time and manner that such communications were made;
 6. Back-up material and prior correspondence to form the basis of the letter of February 22, 1991, from the Associate Minister of National Defence to Lieutenant Liebmann; and
 7. Back-up material and prior correspondence to form the basis of the letter of November 24, 1992, from the Minister of Justice to Lieutenant Liebmann.

23 Counsel for the Plaintiff also makes the point that the searches deposed to in the Defendants' affidavits of documents are limited and further that as the Queen has been added as a party, there are many other documents to be searched for and produced, including those in the files of the Minister of Justice, the Minister of National Defence, the Minister of Foreign Affairs and the Privy Council Office.

24 If these gaps in the production of documents exist, without a reasonable explanation, this may well be a case where the Plaintiff should have a remedy as in *Nelma Information Inc. et al. v. Holt et al.* (supra).

25 The Defendants rely on the affidavit of Catherine Lystiuk, setting out additional enquiries as to documents. The affidavit is somewhat loose in that searches for documents, in addition to searches in the Department of National Defence are referred to, but not by whom the searches were made or when they were made. This affidavit evidence does not satisfactorily deal with the searches that ought to be made and the apparent gaps in the documentation.

26 Counsel for the Defendants points to a lack of affirmative evidence, on the part of the Plaintiff, to show that searches have not been made and says that any gaps which the Plaintiff feels exist in the documents produced is speculation.

27 The point to be made here is that the obligation is on the Defendants to produce documents: They have the onus of showing that reasonable searches have been made: It is not the other way around.

28 I have concluded on the basis of the material presented that the searches for documents have not been satisfactory, despite the amount of time that it has taken for the Defendants to make documents available to their counsel for production. The Plaintiff is entitled to a remedy.

29 To strike out the defence at this point, over a procedural breach, would be a Draconian remedy.

30 Given that this case involves the Charter, counsel for the Defendants makes the points that it is important for all pleadings to remain before the Court so that the factual underpinning can be properly established for the Charter issue; so that the Crown can plead section 1 of the Charter so that the Charter issues can be fully addressed; and so that the Crown can lead evidence bearing on section 1 of the Charter. In this regard counsel refers to a particular apt comment by Chief Justice Lamer in *R. v. Oakes*, [1986] 1 S.C.R. 103:

Where evidence is required in order to prove the constituent elements of a s. 1 inquiry, and this will generally be the case, it should be cogent and persuasive and make clear to the Court the consequences of imposing or not imposing the limit (p. 138).

31 Finally, Mr. Justice Muldoon, in the reasons for his Order of June 23, 1994, notes:

The principal matter in issue in this case poses an important justiciable question for resolution in the public interest of Canada. The resolution will add to the historic definition of Canada, whichever way it goes. One wonders why the parties simply do not get on with it instead of wasting their energies in interlocutory motions. (p. 15)

32 While the Defendants have taken much time so far to produce documents and have, as pointed out by Mr. Justice Muldoon, raised procedural obstacles and a motion, which Mr. Justice Muldoon felt "smacked of a smoke screen", I am not prepared to go so far as the Plaintiff would like and say that there has been an abuse of process to warrant the striking out of the defence. In this regard I note that there is new counsel for the Defendants. The Plaintiff ought, however, to have some remedy.

33 I have considered whether the exploration for additional documents might best be handled during examination for discovery, but have rejected that for various reasons including that it is fair that Plaintiff's counsel have a full set of documents to consider in preparation for examinations for discovery; that the Defendants' nominees for discovery may know little about the existence of further documents and what searches have been made; and that if the Plaintiff is successful in ferreting further Defendants' documents out of nooks and crannies, as a result of the discovery process, there would very likely be further subsequent examination for discovery on those documents, adding delay and expense. The Plaintiff will therefore have cross-examination of the deponents of the three affidavits of documents. If the parties are unable to arrange dates within a reasonable time, they may apply to have dates set.

34 As to the cost of the cross-examinations, the Defendants may either produce the deponents here in Vancouver, at their expense, or provide transportation and reasonable per diem to cover out-of-pocket for the Plaintiff's counsel if the Defendants elect to have cross-examination of Major Roger Strum take place in Edmonton, and that of Deborah MacCulloch take place in Ontario.

35 The Plaintiff will have his taxable costs of the motion at the end of the day.

36 I thank counsel for their excellent and helpful presentations.

HARGRAVE, PROTHONOTARY

qp/d/hbb/DRS/DRS/DRS

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Indexed as:

**Havana House Cigar & Tobacco Merchants Ltd. v. Naeini
(c.o.b. Pacific Tobacco, Pacific Region)**

Between

**Havana House Cigar & Tobacco Merchants Ltd., Empresa Cubana
Del Tabaco trading as Cubatabaco and Habanos S.A., plaintiffs,
and
Morino Naeini carrying on business as Pacific Tobacco, Pacific
Cigar and Pacific Tobacco & Cigars and Orex Communications
Ltd. carrying on business as Pacific Tobacco & Cigars, Pacific
Tobacco and Pacific Cigar, and Pacific Cigar and Tobacco
Corp., carrying on business as Pacific Cigar and Pacific
Tobacco and Farah Kashefi, carrying on business as Pacific
Tobacco and Pacific Tobacco & Cigars and ASA Cigar Connoisseur
Corp., carrying on business as Cigar Connoisseur, defendants**

[1998] F.C.J. No. 309

[1998] A.C.F. no 309

147 F.T.R. 189

80 C.P.R. (3d) 132

78 A.C.W.S. (3d) 691

Court File No. T-323-97

Federal Court of Canada - Trial Division
Vancouver, British Columbia

Hargrave, Prothonotary

Heard: March 3, 1998

Judgment: March 9, 1998

(13 pp.)

Practice -- Pleadings -- Striking out pleadings -- Grounds -- Particulars -- Particulars in specific

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proceedings -- Copyright infringement -- Discovery -- Affidavit or list of documents -- Cross-examination of deponent.

This was an application by the defendant to strike out portions of a statement of claim or for particulars of a copyright design in the alternative and for an order to cross-examine on the affidavit of documents. The plaintiffs were the Cuban state suppliers and exporters of cigars and a Canadian importer and distributor of tobacco products. The defendants were also in the business of importing and selling various brands of cigars. The plaintiffs claimed ownership of a dozen well known cigar trademarks and sought damages, and injunctive and declaratory relief for passing off and copyright and trademark infringement. The original defendants had already filed a statement of defence but subsequently the plaintiffs amended their claim to add a number of defendants who had not yet filed defences. During examinations for discovery, the plaintiff's representative contradicted the portion of the statement of claim dealing with the plea of copyright in the design works of the banding and packing of certain of the cigars. The affidavits of documents provided by the plaintiffs was incomplete.

HELD: The application was allowed in part. While in general parties could not move to strike out matters already pleaded to, given the contradiction in cross-examination on discovery and the amendment to add defendants, a motion to strike could be brought. However the defendants had not shown beyond doubt that the claim would not succeed. The new defendants were entitled to particulars to learn something of the way in which the plaintiffs acquired copyright rights in the cigar banding and packaging in question. The defendants were also entitled to cross-examine the deponents of the affidavits of documents filed by the plaintiffs given that there were missing documents.

Counsel:

Kenneth McKay, for the plaintiff.
Michael Manson, for the defendant.

1 HARGRAVE, PROTHONOTARY (Reasons for Order):-- These reasons arise out of the Defendants' Motion, heard and decided 3 March 1998, to strike out portions of the Statement of Claim, or alternatively for particulars of copyright design and transfer and for cross-examination of the deponents of the Plaintiffs' Affidavits of Documents.

BACKGROUND

2 The Plaintiffs, Empresa Cubana Del Tabaco, trading as Cubatabaco ("CUBATABACO") and Habanos S.A. ("HABANOS") are the Cuban state suppliers and exporters of cigars. The Plaintiff, Havana House Cigar & Tobacco Merchants Ltd. ("HAVANA HOUSE"), is a Canadian importer and distributor of tobacco products, particularly cigars. The Plaintiffs claim the ownership of a dozen well-known cigar trademarks, including Montecristo Habanos and Partagas. The Plaintiffs seek, among other things, injunctive and declaratory relief and damages, arising out of allegations of passing off and trademark and copyright infringement.

3 While the various brand names of cigars have been around for many years, indeed, well into the nineteenth century in some instances, HAVANA HOUSE is a relative newcomer, having been incorporated in Canada in

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1988. HAVANA HOUSE, as well as claiming Trade-marks Act rights to ten well-known brands of cigars, pursuant to registrations under the Act between 1993 and 1996, also claims rights under the Copyright Act in the artistic designs for the bands on and the packaging of Montecristo Habanas and of Partagas cigars. This claim of copyright is in part the focus of the Defendants' Motion and is set out in paragraphs 17 through 20 of the Amended Statement of Claim.

4 To go back a little, the Statement of Claim was filed 26 February 1997, naming as Defendants Morino Naeini and Pacific Tobacco & Cigars and Orex Communications Ltd. carrying on business as Pacific Tobacco & Cigars. Mr. Naeini has interests in those Defendants and has carried on the business of importing and selling various brands of cigars, said to include Montecristo Habanas and Partagas cigars, for a number of years. Those Defendants, with the assistance of their former lawyers, filed a Defence, 1 April 1997. The Statement of Claim was amended 27 October 1997, to add a number of new Defendants and to make several changes of substance. The new Defendants have not yet filed a defence.

CONSIDERATION

Striking Out Plea of Copyright:

5 The original Defendants, having filed a Defence, ought not, at this stage, to be able to obtain particulars for pleading. I also recognize that, as a general principle, parties may not move to strike out matters they have already pleaded to. Of course this does not prevent a motion, after a pleading, on the grounds that there is no reasonable cause of action. Nor does it preclude a motion to strike out on the basis of a response given by a plaintiff, on examination, which contradicts material allegations of fact in the statement of claim: see for example *Mayflower Transit Ltd. v. Marine Atlantic Inc.* (1989) 29 F.T.R. 30 at 33 - 34, a decision of Mr. Justice MacKay.

6 In this instance there are several factors which allow the Defendants to bring the present Motion to strike out at this stage in the action. First, the cross-examination of Mr. Abel Ortego, Marketing Director of HAVANA HOUSE, contradicts the portion of the Statement of Claim which the Defendants desire struck out. Second, the Plaintiffs substantially amended the Statement of Claim, 27 October 1997, including by adding a number of Defendants. The new law firm and counsel retained by the Defendants has not filed an amended defence on behalf of the original Defendants. Finally, and more important, new counsel has not filed any defence on behalf of the Defendants added by amendment.

7 Counsel for the Plaintiffs submits that all of the Defendants are substantially one and that the Defendant, Mr. Naeini, is their spokesman. However Mr. Naeini is not the owner of all of the corporate Defendants, but rather appears to be an owner or a person otherwise interested. I am not about to pierce corporate veils on this basis. By reason of these procedural facts the Defendants, certainly the newly added Defendants, may bring the present Motion to strike out, or alternatively, to obtain particulars.

8 Paragraphs 17 through 20 of the Statement of Claim set out, as I have said, a claim to copyright in the design works contained in two Schedules to the Statement of Claim, being banding and packaging for Montecristo Habanas and Partagas cigars:

"THE PLAINTIFF'S, HAVANA HOUSE RIGHTS UNDER THE COPYRIGHT
ACT

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17. HAVANA HOUSE is the owner of the copyright subsisting in Canada in the artistic design works shown in Schedules "O" and "P" hereto and all modifications, amendments and changes thereto.
18. The artistic design works referred to in paragraph 18 [sic] above and shown in Schedules "O" and "P" hereto are original works, originally authored by employees for hire of its predecessor-in-title. The employees who authored the works at all materials times were Spanish citizens.
19. Copyright subsists in Canada in the said artistic design works and HAVANA HOUSE is the owner thereof by the virtue of the provision of the Copyright Act and, in particular, in Sections 5, 6, and 13 thereof.
20. HAVANA HOUSE is the only person entitled, in Canada, to import or reproduce the said artistic design works, or a substantial taking thereof in any material form whatsoever."

Here I would note that the copyrights in question are not registered copyrights.

9 Critical to the claim of HAVANA HOUSE, under paragraphs 17 through 20 of the Statement of Claim, is Section 13(4) of the Copyright Act which invalidates any assignment or grant of a copyright unless it is in writing:

"13.(4) The owner of the copyright in any work may assign the right, either wholly or partially, and either generally or subject to territorial limitations, and either for the whole term of the copyright or for any other part thereof, and may grant any interest in the right by licence, but no assignment or grant is valid unless it is in writing signed by the owner of the right in respect of which the assignment or grant is made, or by his duly authorized agent." (emphasis added).

None of the Affidavits of Documents declare an assignment of copyright, or even that the document of assignment was but no longer is in the possession of any of the Plaintiffs, requirements under Rule 448(2).

10 The fact that a Plaintiff HAVANA HOUSE is unable to produce written assignments of the copyrights to which it lays claim is not necessarily fatal however the evidence must establish, on the balance of probabilities, that a written assignment existed. This principle is set out in *Motel 6, Inc. v. No. 6 Motel Limited* [1982] 1 F.C. 638. There the issue was a claim to copyright under what was then Section 12(4) of the Copyright Act, but is now Section 13(4) of the Act. Mr. Justice Addy sums this up at page 647:

"I quite accept the proposition of counsel for the plaintiff that section 12(4) is a substantial legal requirement and not a rule of evidence. Therefore, the assignment itself need not necessarily be produce if the evidence establishes that it existed and conformed to that section. The evidence, however, falls far short of establishing on a balance of probabilities that an assignment in writing ever existed, much less one that was signed by Greene or his agent or of establishing who the assignee might have been."

In the Motel 6 decision, Mr. Justice Addy found there was only speculation that a written assignment might have existed and thus, the plaintiff having failed to establish ownership, the claim for copyright infringement was dismissed.

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11 As I say the foundation of paragraphs 17 through 20 of the Statement of Claim must be a written assignment of the copyrights in the artistic designs for Montecristo Habanas and Partagas cigars, banding and boxing. That none of the Plaintiffs declared, in their Affidavits of Documents, either an existing written assignment or the existence of a lost assignment, that raises substantial doubt as to the validity of the claim of the Plaintiff, HAVANA HOUSE, to copyright rights in Montecristo Habanas and Partagas packaging.

12 The Defendants also point to the evidence of Mr. Abel Ortego, given on cross-examination on an Affidavit of 9 January 1998, in support of a motion for an interlocutory injunction. This evidence is to the effect that while HAVANA HOUSE claims as the owner of various registered trademarks, including Montecristo Habanas and Partagas, there was never any assignment of those trademarks, trademarks which go back many years, nor was Mr. Ortego familiar with any written or oral licence. This may be indicative of the general approach of HAVANA HOUSE to its business, but has no bearing on the present Motion.

13 To strike out a portion of a statement of claim is not easy. A defendant must show, beyond doubt, that the plea will not succeed. If it is not a futile plea, but rather one which has some chance of success, a motion to strike out fails. The claim of copyright, as pleaded, has a number of other difficulties, but at this point I am not prepared to say it is futile, for the Plaintiffs may yet be able to show written assignment or probability that written assignment existed, or given the decades which have gone by since the packaging in question was designed and the nationalization of the cigar industry in Cuba, a series of written assignments and grants.

Particulars of Acquisition of Copyright:

14 The Defendants, or at least those added by way of amendment and who have not pleaded to the Statement of Claim, are certainly entitled to know something of the way in which the Plaintiff acquired copyright rights in the Montecristo Habanas and Partagas cigars banding and packaging so they may plead intelligently.

15 Counsel for the Plaintiff referred me to case law to the effect that particulars of publication, authorship and the like need not be provided, being readily apparent and more appropriate as a subject matter for discovery: for example *Canadian Olympic Association v. National Gym Clothing Ltd.* (1985) 2 C.P.R. (3d) 145. That line of authority deals with registered copyrights where the particulars are readily obtained from the registration. In a situation such as the present, with unregistered copyrights, for which the Plaintiff must clearly establish a chain of title underlying its claim to copyright benefits, the Defendants are entitled to such particulars: see for example *Durand & Cie v. Lapatrie Publishing Co. Ltd.* (1952) 15 C.P.R. 86 at 90 - 92 (Ex. Crt.). The Plaintiffs will therefore provide the requested particulars including those of authorship, predecessors in title and assignments by which HAVANA HOUSE asserts ownership of those artistic design works. All parties are now pressing for a speedy resolution to the action. The written assignment is absolutely essential to the copyright claim of the Plaintiffs. The Defendants have sought the particulars for some time and thus the present Motion comes as no surprise. The Plaintiffs will provide the particulars within 15 days.

16 In the event that the Plaintiffs are not able to provide written assignments of the copyrights in the Montecristo Habanas and Partagas packaging, or show on the balance of probabilities that written assignments existed, they should keep in mind that an action is not a speculative exercise, to be launched, in whole or in part, where it is clear that the onus of proof rests upon the plaintiff and yet the plaintiff has no evidence or foundations of fact on which to support its claims. This sort of situation was dealt with by Mr. Justice Addy in *Caterpillar Tractor Co. v. Babcock Allatt Ltd.* (1983) 67 C.P.R. (2d) 135, in which the plaintiff brought a motion to strike out portions of the defence which merely restated or rephrased portions of the Patent Act, but which were grounded on no material facts. Now in *Caterpillar Tractor* the plaintiff, after receiving the defence, took a fresh

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step in the action and chose to examine for discovery, which had the effect of closing the pleadings. However it became clear, during discovery, that the defendant had made an unsupported plea. The defendant, faced with the motion to strike out, submitted that as pleadings were effectively closed the plaintiff was precluded from requesting particulars and was prevented from seeking to have the action struck out for lack of particulars. Mr. Justice Addy characterized the plaintiff's motion not as a question of sufficiency of pleadings, but rather of lack of evidence and pointed out that under Rule 419 the court might strike out a pleading, at any stage of an action, where it is frivolous, vexatious, prejudicial, embarrassing or might otherwise constitute an abuse:

"If a party has no grounds for making an allegation in a pleading, then, there is no basis for maintaining the allegation. It is not an answer to an application to strike out, for the party to say that, if he had unrestricted discovery of his opponent, he might then be in a position to sustain the allegation." (p. 138).

17 Mr. Justice Addy struck out the two offending paragraphs. In the present instance, particularly given the pressure to determine this matter, it is time for the Plaintiffs to either provide particulars or consider amending the Statement of Claim to withdraw the four paragraphs and ancillary relief provisions which the Defendants seek to have struck out for, as I have said, this action ought not to be a speculative exercise, for the onus of providing an assignment rests with the Plaintiffs and yet, to date, they have provided no evidence of such. This idea is neatly summed up in the Caterpillar Tractor case at p. 139:

"A court proceeding is not a speculative exercise and actions are not to be launched or continued nor are defences to be allowed to stand where it is clear that the person making the allegation has no evidence to support it and where the onus of proof rests on that person. It has, in my view, been fully established that the allegations in paras. 9(b) and 10(b) are frivolous and vexatious and may prejudice or embarrass a fair trial and constitute an abuse of the court. There is no real dispute on these issues and the plaintiff should not be put in the position of meeting allegations which have no foundation in fact. The paragraphs will be struck out. The result would have been the same if full particulars had in fact been given originally and then, on discovery, there had been an admission that the facts alleged were fictitious. It happens too frequently and especially in patent and other industrial property cases, that in attacking the validity of a patent or title to a trademark or copyright, all textbook grounds of attack are automatically inserted regardless of whether or not they are relevant or whether there is any possibility of any evidence existing to support them."

The disposition of the present Motion, which is merely for particulars, is without prejudice to the Defendants, should they view the particulars as deficient, bringing on a new motion to strike out.

Examination on Affidavits of Documents

18 Turning now to the request for cross-examination of the deponents of the Affidavits of Documents filed by each of the Plaintiffs, I would first note that while the Plaintiff HAVANA HOUSE has provided an Affidavit of Documents and a Supplemental Affidavit of Documents, together containing a total of 31 documents, much of the material declared consists of trademark registrations and copyright designs. In the case of HABANOS, its Affidavit of Documents sets out they have some privileged material, but nothing else. The Affidavit of Documents of CUBATABACO, declares three trademark registrations, a 1962 design for the H Upmann Habanas cigar

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and a distribution agreement between CUBATABACO and HAVANA HOUSE which, incidentally, has not been declared by HAVANA HOUSE in its Affidavit or Supplemental Affidavit of Documents. In each of the four Affidavits of Documents Schedule C, relevant documents no longer in the possession of a party, contains a nil entry.

19 In the present instance counsel for the Defendants, referring both to the Affidavits of Documents and to the Affidavits in support of this Motion, submits discovery of documents has been less than complete. On an application for cross-examination on an affidavit of documents I may look not only at the affidavits themselves, but also at the pleadings and proceedings. I have also in mind that discovery of documents, before examination for discovery and trial, is one of our most important procedures and that it ought to be for the Plaintiffs, who in this instance bring the claim and should know the background, to present more than just a minimal or even no production of documents as in the case here. However the Defendants, in pressing for further documents through cross-examination on Affidavits of Documents, must have some persuasive evidence that documents are available, but have not been produced, rather than mere speculation, intuition and guesswork.

20 If some specific documents have been overlooked, or if it appears that many documents have been withheld, although it may not be clear which documents or classes of documents have been withheld, the Plaintiff may have a remedy by way of cross-examination on Affidavits of Documents, a remedy allowed, for example, in *Nelma Information Inc. et al. v. Holt et al.* (1985) 50 C.P.C. 16 (Ont. H.C.).

21 The Affidavits of Documents of all three Plaintiffs and the Supplemental Affidavit of HAVANA HOUSE set out, in the usual wording, that the deponent has conducted a diligent search of corporate records, has made appropriate inquiries and has disclosed all of the documents relevant to the action, being unaware of any other relevant documents other than those that are listed. There are obviously specific documents missing and I have in mind here the assignments of copyright to HAVANA HOUSE, which ought to have been listed either as documents held by HAVANA HOUSE or documents held at one time by HAVANA HOUSE but which are, for some reason, no longer in the possession of HAVANA HOUSE. Counsel says the Plaintiffs do not know if they have written assignments and therefore could not refer to them on disclosure of documents. However the Plaintiffs have had over a year since commencement of this action and ought to have put their tackle in order long ago. There are also general gaps in the production of documents, being a total gap in the case of the Plaintiff, HABANOS, a near total gap in production in the case of CUBATABACO and a rather meagre production on the part of the Plaintiff, HAVANA HOUSE. There are also a number of apparent categories of missing documents including those dealing with distribution of the Plaintiffs' cigars into Canada, advertising as alleged by HAVANA HOUSE, sales in Canada, loss of profit, use of copyright and passing off.

22 Counsel for the Plaintiffs submits that his clients produced much material in past interlocutory motions and that such documents ought to be considered as produced. Further, counsel for the Plaintiffs suggests that if a document is declared by one party, or perhaps by one of several plaintiffs, it need not be listed by another party in its affidavit of documents. This is not within the spirit or the intent of the Rules. It overlooks the basic premise that disclosure of documents is a matter of relevance, not discretion: this is clearly required by Rule 448(2)(a) which provides that an affidavit of documents must contain various lists "... of all documents relevant to any matter in issue ..." which a party possesses. A party is obliged to list every relevant document in its possession, even those documents which do not have to be produced: see for example *Skoye v. Bailey* [1971] 1 W.W.R. 144 at 145 - 146 (Alta. C.A.) and *Re-Max Real Estate (Edmonton) Ltd. v. Border Credit Union Ltd.* [1988] 6 W.W.R. 146 (Master Funduk, Alta. Q.B.). Turning from listing documents to production, two distinct concepts, to say a document need not be produced because the other side already has it, from another source, is an

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inappropriate answer: see for example *Canada Southern Petroleum Ltd. v. Amoco Canada Petroleum Co. Ltd.* [1995] 5 W.W.R. 720 at 723 (Alta. Q.B.). Given the apparent gaps in the production of documents, without any reasonable explanation, this is an instance in which the Plaintiff should have a remedy.

23 I have considered whether the exploration for additional documents might be as well handled during examination for discovery, but have rejected that idea for various reasons. To mention just several reasons, it is only fair that counsel for the Defendants have a full set of documents to consider in preparing for examination for discovery. Further, the Plaintiffs' nominees for discovery may know little about the existence of further documents. Finally, if the Defendants are successful in ferreting out further documents, on examination for discovery, or the existence of further documents, there would very likely be additional examinations for discovery, adding delay and expense. The deponents of the Plaintiffs' Affidavits of Documents are therefore to be produced for cross-examination.

CONCLUSION

24 The Plaintiffs shall provide particulars of each of the authors of the Montecristo Habanas and Partagas cigar banding and packaging, including the relationship between each author and any predecessors in title to the banding and packaging designs, together with copies of any assignments of copyright.

25 The Defendants will have cross-examination at Toronto of the deponents of the Affidavits of Documents filed by the three Plaintiffs. If the parties are unable to set convenient dates, within the expedited timing of this action, they may apply to have dates set.

26 As to the cost of bringing the deponents to Toronto for cross-examinations, the Plaintiffs have, at least to some degree, brought the necessity of cross-examination upon themselves. Each side will bear half the cost of bringing the witnesses to Toronto.

27 The Defendants having been successful on this Motion they are entitled to costs in any event at the end of the day.

HARGRAVE, PROTHONOTARY

cp/d/hbb/DRS



Pacific Forest Products Ltd. v. Canadian Transport Co., 1998 CanLII 7326 (FC)

Date: 1998-01-28 (Docket: T-3030-94)

Other 152 FTR 165

citation:

Citation: Pacific Forest Products Ltd. v. Canadian Transport Co., 1998 CanLII 7326 (FC),
<<http://canlii.ca/t/4cpx>> retrieved on 2014-10-26

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Date: 19980128

Docket: T-3030-94

MONTREAL, QUEBEC, THIS 28th DAY OF JANUARY 1998

Present: RICHARD MORNEAU, PROTHONOTARY

ACTION *IN REM* AGAINST THE SHIP "CITY OF
NANAIMO" AND *IN PERSONAM* AGAINST CANADIAN
TRANSPORT COMPANY LIMITED, CARILLON
ENTERPRISES LTD., GOLDEN OCEAN (U.K.) LTD., AND
THE OWNERS AND CHARTERERS OF THE VESSEL
"CITY OF NANAIMO"

Between:

PACIFIC FOREST PRODUCTS LIMITED,

and

ALL THOSE CARGO INTERESTS AS ENUMERATED

IN ANNEX "A" ATTACHED HERETO,

Plaintiffs,

AND

CANADIAN TRANSPORT COMPANY LIMITED,

and

CARILLON ENTERPRISES LTD.,

and

GOLDEN OCEAN (U.K.) LTD.,

and

THE OWNERS AND CHARTERERS

OF THE VESSEL "CITY OF NANAIMO",

and

THE VESSEL "CITY OF NANAIMO",

Defendants.

ORDER

It is ordered that the defendants pay the following amounts within twenty days of the date of this order:

- the stenography expenses incurred by the plaintiffs in relation to the examination of the defendants' representatives on November 27, 1997, at Rotterdam, the amount of which will be determined by counsel for the parties;
- the sum of \$13,500, comprising \$7,500 plus \$6,000;
- the costs of this motion in accordance with column III of Tariff B.

Richard Morneau

Prothonotary

Certified true translation

C. Delon, LL.L.

Date: 19980128

Docket: T-3030-94

ACTION *IN REM* AGAINST THE SHIP "CITY OF
NANAIMO" AND *IN PERSONAM* AGAINST CANADIAN
TRANSPORT COMPANY LIMITED, CARILLON
ENTERPRISES LTD., GOLDEN OCEAN (U.K.) LTD., AND
THE OWNERS AND CHARTERERS OF THE VESSEL
"CITY OF NANAIMO"

Between:

PACIFIC FOREST PRODUCTS LIMITED,

and

ALL THOSE CARGO INTERESTS AS ENUMERATED
IN ANNEX "A" ATTACHED HERETO,

Plaintiffs,

AND

CANADIAN TRANSPORT COMPANY LIMITED,

and

CARILLON ENTERPRISES LTD.,

and

GOLDEN OCEAN (U.K.) LTD.,

and

THE OWNERS AND CHARTERERS
OF THE VESSEL "CITY OF NANAIMO",

and

THE VESSEL "CITY OF NANAIMO",

Defendants.



REASONS FOR ORDER

RICHARD MORNEAU, PROTHONOTARY:

[1] This is a motion by the plaintiffs under rule 344 of the *Federal Court Rules* asking that the Court award them the costs they claim to have incurred in respect of the re-examination of two of the defendants' representatives which they had to conduct in Rotterdam, in the Netherlands, on November 27, 1997.

[2] According to the plaintiffs, this re-examination was necessary since they had not been provided with two reports central to their case (the reports) in time for them to be able to question the representatives in question concerning those reports at their examinations, which were held on December 12, 1996 and January 30, 1997, respectively. The plaintiffs argued forcefully that the defendants had deliberately concealed these reports from them, the reports apparently being of great assistance to them in their case.

[3] Accordingly, the plaintiffs are now claiming the expenses they incurred in relation to the re-examination held on November 27, 1997, without the entire matter being referred to the judge who will preside at the trial to begin on February 23; they are claiming:

- stenography expenses;
- travel and lodging expenses for one lawyer, and
- \$22,500 representing the cost of the hours for preparing and conducting the examination.

[4] The defendants acknowledge that the reports are material but argue that their failure to disclose and deliver the reports on time was purely inadvertent. According to them, they delivered the reports as soon as they remembered them. In addition, they contend that the re-examination held on November 27, 1997 had little to do with the actual content of the reports. Lastly, they submit that the matter of costs should be referred to the trial judge.

[5] I do not believe that the possibility of awarding costs must be left to be decided by the judge who will preside at the upcoming trial. I therefore intend to decide it now.

[6] Generally, and without concluding that the defendants acted in bad faith as the plaintiffs contend, I am nonetheless of the opinion that having regard to all of the evidence in the record the defendants' failure to disclose the existence of the reports in their affidavits of documents, or in the period immediately surrounding the examinations held on December 12, 1996 and January 30, 1997, was the result of a certain amount of negligence on their part. Accordingly, I find that they violated rules 448(2)(a)(i), 449(2) and (3) and 460(1), which essentially provide that there is an obligation to disclose all relevant documents. Those provisions read as follows:

448.(2) An affidavit of documents (Form 19) shall contain

(a) separate lists and sufficient descriptions of all documents relevant to any matter in issue that

(i) are in the possession, power or control of the party and for which no privilege is claimed,

...

449.(2) The deponent of an affidavit of documents shall, prior to making the affidavit, become informed by making all reasonable inquiries of any present or former officer, servant, agent and employee of the party, including any who are outside Canada, who might reasonably be expected to have knowledge relating to any matter in question in the action.

(3) The solicitor on the record for the party shall

(a) explain to the deponent of an affidavit of documents the necessity of making full disclosure under Rule 448 and the possible consequences of failing to do so; and

(b) certify on the affidavit of documents or on a document attached to the affidavit that those explanations have been given.

...

460.(1) A party who was examined for discovery and who discovers that the answer to a question in the examination was inaccurate or deficient when given shall, without delay, correct the inaccuracy or deficiency in writing.

(Emphasis mine)

[7] Based on that conclusion, I believe that it is appropriate under rule 344 to award the plaintiffs certain costs.

[8] With respect to the stenography expenses, I believe that they must be paid by the defendants. There is no direct evidence as to the cost of that service, but counsel for the parties assured me that they would agree as to the precise amount of those costs.

[9] With respect to the travel and lodging expenses of one lawyer for the plaintiffs, I also think that the plaintiffs must be allowed a reasonable amount to cover those costs. However, the parties are not in agreement as to the amount to be awarded. The defendants suggest a figure of \$4,000 while the plaintiffs are claiming \$11,000. It seems to me that \$7,500 would be reasonable in the circumstances, and that will also be ordered.

[10] With respect to the \$22,500 claimed by the plaintiffs for the time spent preparing and conducting the examination in Rotterdam, it seems to me that something must be awarded. In my view, however, the amount must be lower than the amount claimed by the plaintiffs.

[11] It must be acknowledged, to start with, that part of the preparation time would have come about at some point or another, even if the reports had been delivered on time. However, we can agree with counsel for the plaintiffs that in order to prepare for November 27, 1997, they had to review much of the documentation a second time that had been gone over at the initial examinations .

[12] On the other hand, it appears that not all of the examination (that apparently lasted between four and seven hours) dealt with the direct content of the reports.

[13] Lastly, the evidence is quite lacking in details as to the hours spent by either

counsel.

[14] Having regard to all these factors, it seems to me that \$6,000 for this item is more than satisfactory.

[15] The costs of this motion will be awarded to the plaintiffs under column III of Tariff B.

[16] An order will issue accordingly.

Richard Morneau

Prothonotary

MONTREAL, QUEBEC

January 28, 1998

Certified true translation

C. Delon, LL.L.

Federal Court of Canada

T-3030-94

BETWEEN

PACIFIC FOREST PRODUCTS LIMITED,

and

ALL THOSE CARGO INTERESTS AS ENUMERATED IN ANNEX "A"
ATTACHED HERETO,

Plaintiffs,

" AND "

CANADIAN TRANSPORT COMPANY LIMITED and

CARILLON ENTERPRISES LTD. and

GOLDEN OCEAN (U.K.) LTD. and

THE OWNERS AND CHARTERERS OF THE VESSEL "CITY OF NANAIMO" and

THE VESSEL "CITY OF NANAIMO",

Defendants.

REASONS FOR ORDER**FEDERAL COURT OF CANADA****NAMES OF COUNSEL AND SOLICITORS OF RECORD****COURT FILE NO:** T-3030-94**STYLE OF CAUSE:** PACIFIC FOREST PRODUCTS LIMITED,
andALL THOSE CARGO INTERESTS AS ENUMERATED IN ANNEX "A"
ATTACHED HERETO,

Plaintiffs,

" *AND* "CANADIAN TRANSPORT COMPANY LIMITED and
CARILLON ENTERPRISES LTD. and
GOLDEN OCEAN (U.K.) LTD. and
THE OWNERS AND CHARTERERS OF THE VESSEL "CITY OF NANAIMO" and
THE VESSEL "CITY OF NANAIMO",

Defendants.

PLACE OF HEARING: Montréal, Quebec**DATE OF HEARING:** January 26, 1998**REASONS FOR ORDER BY RICHARD MORNEAU, PROTHONOTARY****DATE OF REASONS FOR ORDER:** January 28, 1998**APPEARANCES:**

Francis Rouleau for the plaintiffs

Darren McGuire for the defendants

SOLICITORS OF RECORD:

Francis Rouleau for the plaintiffs

Sproule, Castonguay, Pollack

Montréal, Quebec

Darren McGuire for the defendants

McMaster Meighen

Montréal, Quebec

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